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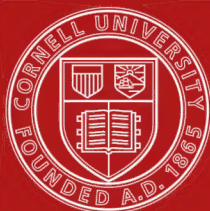
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American trade-mark cases decided by the



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A M E R I C A N
TRADE-MARK CASES

DECIDED BY

The Courts of the United States, both
State and Federal, and by the
Commissioner of Patents,

AND REPORTED BETWEEN

1879 and 1887.

WITH AN

Index Digest of the Cases Published.

BY

BENJAMIN PRICE AND ARTHUR STEUART,

OF THE BALTIMORE BAR.

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1887.

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PREFACE.

THIS book contains a collection of cases covering a period of ten years within which the law relating to trade-marks has received much attention from the Courts, and the principles thereof have been simplified. We may venture to express a hope that this collection of the late cases arranged as nearly as practicable in the order of their date, and containing learned discussions upon the law relative to trade-marks in nearly all its branches, may assist the profession and the Courts in working out the problems submitted to them.

The cases have been gathered from over one hundred and fifty volumes, many of them inaccessible to the practitioner. Much care has been taken to prepare and arrange head notes to make them full and further to assist the readers, the numerals placed in front of the notes refer to corresponding numerals in the body of the decision where the subject-matter of the head note will be found. The book has been prepared during active practice and at such spare times

as could be given to it, we request therefore the indulgence of the profession for errors and omissions.

This volume forms a link in the chain of collected decisions upon trade-marks of the Court of the United States, two volumes of which have been published by Mr. Rowland Cox, *Cox's American Trade-Mark Cases* and *Cox's Manual of Trade-Mark Cases*. The last one was published in 1879. We take up the cases where he left off. A digest of trade-mark cases was also published in 1879 by Mr. Coddington. The digest attached to this volume covers the period from the date of that publication to the present time.

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AMERICAN TRADE-MARK CASES,

1879 to 1887,

WITH A FEW CASES DECIDED BEFORE 1879
BUT NOT REPORTED UNTIL AFTERWARDS.

1

NEW YORK SUPERIOR COURT,

*SPECIAL TERM. —MARCH, 1873. IN EQUITY.

ROYAL BAKING POWDER COMPANY

vs.

ROYAL CHEMICAL COMPANY.

Royal Baking Powder.

APPLICATION TO RESTRAIN INFRINGEMENT OF
TRADE-MARK.

Defendants used the words Royal London Baking Powder. HELD:

- . That the plaintiffs are entitled to the exclusive use of the term "Royal," as their trade-mark, on labels attached to Baking Powder manufactured by them, and in connection with the words "Baking Powder."

* Not reported.

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2. That the use by the defendants of the word "Royal," on labels affixed to Baking Powder, made by the defendants, or printed or written on boxes, labels, or otherwise however, in connection with Baking Powder made by them, is a violation of the plaintiffs' rights.
3. That the plaintiffs are entitled to a perpetual injunction against the defendants, as demanded by them in their complaint.
4. That the plaintiffs are entitled to the costs of this act.

THIS cause was to restrain the use by defendants of a label alleged to be an infringement upon the trade-mark of complainant. The facts are stated in the opinion.

VAN VORST, J.:

This cause having been tried at the Special Term of this Court, before me, without a jury, and the proofs and allegations of the parties having been heard, I find the following facts:

That the plaintiffs commenced to manufacture and sell a compound, to be used for leavening bread and cake, and for other culinary purposes, known to dealers in, and consumers of, said compound, as Baking Powder, and that, in order to distinguish the said Baking Powder, manufactured and sold by them, from all other baking powders, they gave it the name of ROYAL BAKING POWDER, and adopted said term "Royal" as their trade-mark.

That before the adoption of the term "Royal" as a trade-mark by the plaintiffs, no baking powder had been manufactured or sold to which the name "Royal Baking Powder" had been given, or to which it had been in any way attached.

That from the time of the adoption of said name or trade-mark by the plaintiffs, they have affixed, prior to the sale thereof, on every can, box, and package of Baking Powder manufactured and sold by them, in conspicuous letters, the said name or trade-mark, "Royal Baking Powder."

That from July, one thousand eight hundred and sixty-six, up to the present time, the plaintiffs have been continuously engaged in manufacturing and selling in cans, boxes and packages, Baking Powder, with their said trade-mark affixed thereto, and ever since the adoption of said trade-mark by them, Baking Powder of their

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manufacture has been well known to the public throughout the United States, by the name or trade-mark "Royal Baking Powder," so that dealers in and consumers of Baking Powder well know that the said term "Royal," prefixed to the words "Baking Powder," indicates that the article to which the name is given, or to which it is attached, is manufactured and sold by the plaintiffs, and the said trade-mark was well known to the defendants long prior to their infringement on the same, as hereinafter mentioned, as the trade-mark of the plaintiffs.

That in or about the month of May, one thousand eight hundred and seventy-one, the defendants, so imitating the labels and trade-marks of the plaintiffs, and especially by the use of the term "Royal," on labels affixed to packages of baking powder, organized a corporation, purporting to be formed under the statutes of the State of New York, to which they gave the name of "Royal Chemical Co.," and thereupon commenced to manufacture Baking Powder, and put the same up in tin cans, boxes, and packages, and to sell the same, and they affixed to every can, box, or package of Baking Powder, manufactured and sold by them, prior to the sale thereof, a label containing the word "Royal," in connection with the words "Baking Powder," with the words "Chemical Company," between, and that the term "Royal" was so used by the defendants that the public, in purchasing the Baking Powder manufactured and sold by the defendants, were led to believe that they were purchasing Baking Powder manufactured by the plaintiffs, and the name "Royal Chemical Company" was adopted for the purpose of enabling them to accomplish that purpose, if possible, with impunity.

That the use by the defendants of the term "Royal," on their cans, boxes, and packages of Baking Powder, manufactured by them, and the use by them of the term "Royal," in any manner, in connection with Baking Powder, was and is calculated to deceive purchasers and consumers of Baking Powder into the belief that they were and are purchasing the Baking Powder manufactured by the plaintiffs, and is an infringement of the plaintiffs' trade-mark.

That the use of the name "Royal London Baking Powder," on labels affixed to packages, as in the answer alleged, was not adopted

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prior to, but after the use of the term, "Royal" was adopted by the plaintiffs as their trade-mark, and was not used until the month of August, in the year one thousand eight hundred and sixty-seven; that the Baking Powder to which said labels were affixed, was not manufactured in England, but was manufactured in the City of New York, and not as thereon alleged, by Austin, Marshal, Hall & Co., of London, but by a person in New York, who used their name; that the labels which purport to be printed by "GEORGE BARWOOD & Co., Printers, 402 Oxford Street," were in fact printed in the City of New York.

That the use of the "Royal" by the defendants, on labels affixed to Baking Powder manufactured by them, has not been by the privity, consent, or acquiescence of the plaintiffs, and the plaintiffs have used due diligence in giving public notice of their rights to their trade-mark, and in preventing infringements thereof.

I do, therefore, find and declare the following conclusions of law:

First.—That the plaintiffs are entitled to the exclusive use of the term "Royal," as their trade-mark, on labels attached to Baking Powder, manufactured by them, and in connection with the words "Baking Powder."

Second.—That the use by the defendants of the word "Royal," on labels affixed to Baking Powder, made by the defendants, or printed or written on boxes, labels, or otherwise however, in connection with Baking Powder made by them, is a violation of the plaintiffs' rights.

Third.—That the plaintiffs are entitled to a perpetual injunction against the defendants, as demanded by them in their complaint.

Fourth.—That the plaintiffs are entitled to the costs of this act.

DECREE.

This cause having been tried at a Special Term of this Court, before the Hon. HOOPER C. VAN VORST, one of the Justices thereof, without a jury, and the proofs and allegations of the parties having been heard, the said Court gave its decision in writing in favor of

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the plaintiffs, and against the defendants, with costs; which decision has been filed with the Clerk of this Court.

Now, in pursuance thereof, it is hereby adjudged that the plaintiffs are entitled to judgment on all the issues, and judgment is hereby rendered in favor of the plaintiffs, and against the defendants thereon, and it is hereby also adjudged that the plaintiffs are entitled to the exclusive use of the term "Royal," as their trademark, on labels attached to Baking Powder, manufactured by them, and in connection with the words "Baking Powder." And it is further adjudged, that the use by the defendants, of the word "Royal" on labels affixed to Baking Powder, made by the defendants, or printed or written on boxes, labels or otherwise howsoever, in connection with Baking Powder made by them, was in violation of the plaintiffs' rights.

And it is further adjudged, that the defendants, their agents, clerks, workmen, servants, and attorneys, perpetually refrain, and they are hereby perpetually enjoined and restrained, from using the term or designation "Royal," on or around or in connection with any cans, boxes, or other packages, of any nature or kind whatever, containing Baking Powder, or in any sign, invoice, billhead, card, circular, advertisement, in connection with Baking Powder, and from using the name "Royal Baking Powder," and from selling and disposing of any Baking Powder with the word "Royal" attached thereto, except on such Baking Powder as is obtained from the plaintiffs.

And it is further adjudged, that the plaintiffs recover of the defendants their costs and disbursements in this action.

McNair, et al. *vs.* Cleave, et al.

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IN THE COURT OF COMMON PLEAS, PHILADELPHIA. IN EQUITY.

MCNAIR, ET AL.
GALAXY PUBLISHING COMPANY,• *vs.*CLEAVE, ET AL.
THE GALAXY PUBLISHING COMPANY, (LIMITED).

DECIDED 27 JUNE, 1874.

REPORTED 10 PHILA., 155.

*Galaxy Case.*BILL FOR INJUNCTION TO RESTRAIN INFRINGEMENT OF
TRADE-NAME.

Plaintiffs alleged that they were co-partners trading as the Galaxy Publishing Company.

There was no corporation, merely a co-partnership. **Held:**

1. That the name which they adopted with their manner of using it, was a fraud on the public.
2. Even if no actual fraud was intended, it does not help their case, a Court of Equity will assist no one in carrying on such a scheme as this.

Thomas J. Ashton, Esq., for the plaintiff.

OPINION DELIVERED JUNE 27, 1874.

PAXSON, J.,

The plaintiffs allege that they are co-partners, trading as the "Galaxy Publishing Company;" that they are entitled to the exclusive use of the said name as a trade-mark; that the defendants are also co-partners under an agreement duly recorded, in which they style themselves "The Galaxy Publishing Company, limited." The plaintiffs claim that the use of this name by the defendants is an infringement of their rights, and seriously interferes with their business.

The application is for a preliminary injunction to restrain the defendants from the further use of said trade-mark.

1. The plaintiffs are not in a position to invoke the aid of a Court of Equity. The name which they have adopted, with their manner of using it, is a fraud upon the public. The words "Galaxy Publishing Company," implies that they are incorporated. As if purposely to strengthen this impression, the plaintiffs add to the name just cited the words "William McNair, president, and Charles Robson, secretary and treasurer." This appears printed upon their envelopes, bills, letter heads, etc. President of what? Treasurer of what? It would seem difficult to understand, from the sounding title and official display of names, that there was nothing behind it all but two gentlemen doing business as co-partners.

2. It may be that no actual fraud was intended, and that the adoption of the name, and designation of officers was regarded by the plaintiffs as a mere device which would harm no one and might benefit them.

I give them the benefit of this doubt. It does not, however, help their case. A Court of Equity will assist no one in carrying on such a scheme as this.

The familiar rule that he who seeks equity must do so with clean hands, is decisive of this motion.

Injunction refused.

Morse *vs.* Worrell.

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COURT OF COMMON PLEAS, PHILADELPHIA.
IN EQUITY.

MORSE

vs.

WORRELL.

DECIDED 21 NOVEMBER, 1874.

REPORTED 10 PHILA., 168.

Rising Sun vs. Rising Moon.

Plaintiff's trade-mark was "The Rising Sun" Stove Polish, with vignette of the sun.

HELD, on motion for preliminary injunction, that defendants would not be restrained from using the words "Rising Moon," with vignette of the moon.

SUR MOTION FOR SPECIAL INJUNCTION.

W. W. Montgomery, Samuel Wagner, Jr., Esqs., and Hon. F. Carroll Brewster, for complainants.

Victor Quillon, Esq., for defendant.

PAXSON, J.:

The rules of law governing trade-marks are now well settled.

The difficulty lies in the application of those principles to the facts of a particular case. Thus it is well understood that a man may have a property in a trade-mark, and that a Court of Equity will interfere by injunctions to prevent a piracy of such trade-mark. Yet what constitutes an infringement is a mixed question of law and fact, often difficult to determine. In such investigations we may be aided to some extent by experts. Much, however, must depend upon an actual inspection of the trade-mark, and of the alleged imitation.

The plaintiffs claim to be the manufacturers of an article known as "The Rising Sun Stove Polish." It is put up in packages of the form known as parallelopipedons, about four inches in length by an inch and a quarter in diameter, and covered with a wrapper of red paper, upon which is printed certain letters, and a device of a rising sun, which it is claimed, constitutes the plaintiffs' trade-mark. When his wrapper is folded, so as to enclose one of the blocks of stove polish, it presents upon one side thereof a device evidently intended to resemble the sun rising over or beyond two hills, the one on the right lying in deep shadow; the one on the left lighter, but shaded, while the sun is a semi-circle, surrounded by wide divergent rays, printed in black on the plain color of the paper. Over this device are the words "The Rising Sun," printed in bold letters upon a curved line, and surrounded by scroll work. Under the device are the words "Stove Polish," also in a curved line, and a small portion of which only is visible upon this side of the block.

The other three sides are covered with printed matter, in smaller type, of various sizes, descriptive of the article, laudatory of its many virtues, with cautions against imitations, a statement of the price, and directions for its use. Then follows, upon the fourth side of the block, the name of the manufacturers, "Morse Bros., Sole Proprietors, Canton, Mass.," also the words, "Entered according to Act of Congress, in the year 1870, by Morse Bros., in the office of the Librarian of Congress, at Washington," followed by the words "A patent granted us for the words 'sun' as applied

to prepared plumbago by United States, October 20, 1872, with or without prefix or affix, and any violation or infringements of any of the copyrights or trade-marks we shall immediately prosecute to the extent of the law." It is proper to say, in this connection, that the words, "this trade-mark patented," are printed in dim letters immediately under the vignette of the rising sun.

The plaintiffs produced a certificate from the United States Patent Office, showing that their trade-mark had been registered under the Act of Congress. In said certificate the following appears as the plaintiffs' description of their said trade-mark:

"This trade-mark is composed of the word 'Sun,' either preceded or not by an adjective, such as the word 'Rising,' as shown in the drawing, or 'Morning,' 'Evening,' 'Setting,' 'Shining,' or 'Radiant,' or other adjective, to qualify or express the quality of, or some circumstances respecting the sun. This word 'Sun,' when thus used in connection with prepared plumbago or black lead, is to be either stamped upon each separate cake, bar or stick of the plumbago, or by printing or stamping indicated upon the box or case containing it, or upon a wrapper or label to be used with the same; it being best, as well as so intended, to add to the same a word or words sufficient to designate the purpose for which the prepared plumbago or black lead is to be used—as, for instance, 'Stove Polish,' 'Lumber Pencil,' 'Lubricator,' etc.

"In the said illustration of my trade-mark there is also a design showing a sun as rising from and beyond hills; the words 'The Rising Sun,' and the words 'Stove Polish,' being placed respectively above and below the said design, and relieved by scroll lines."

"It is not intended to limit this trade-mark to the design hereinbefore described and shown, as said design is, in many instances, not employed, and when employed, is for effect, taste and appearance, the trade-mark consisting in the adaptation of the word 'sun' to prepared plumbago or black lead."

The defendant's preparation of plumbago is put up in packages of the same size and shape as those of the plaintiff's, and covered with wrappers of a similar color. On one side of the parallel-opipedon there is a vignette of a moon rising out of the ocean, or

a large sheet of water. Immediately over the moon are the words "Rising Moon," printed on a curved line; to the left, and on a line with the moon, is the word "Stove," and on the right the word "Polish." On the second and third sides are directions for use, etc., and on the fourth side the words "Manufactured of Pure Carburet of Iron, at the Eagle Black Lead Works, Nos. 244, 246 and 248 North Front street, Philadelphia," and in smaller type at the bottom the additional words, "Entered according to Act of Congress, in the year 1871, by Howard Worrell, in the office of the Librarian of Congress, at Washington."

Over seventy-four affidavits were submitted on behalf of the plaintiffs by persons claiming to be experts and dealers in almost every State in the Union, alleging that the plaintiff's article was widely known to the trade and has a large sale. Most of the affidavits say that, in their judgment, the label of the defendant was an imitation of the plaintiff's trade-mark, and calculated to deceive purchasers; that in some instances parties had actually been misled.

On the other hand, the affidavits submitted on behalf of the defendant, though far less numerous, are equally strong, and allege that there is no imitation, and that the difference between the two labels is so radical that no person of ordinary intelligence could be deceived, or mistake the "Rising Sun" for the "Rising Moon Stove Polish."

In determining a question of this kind some regard must be had to the character of the article, its price, and the average intelligence of the persons who are likely to be its chief purchasers and consumers. When an article is costly, is used principally by persons above the ordinary standard of intelligence, and is likely to be inspected closely, the danger of deception would necessarily be less than in the case of an article of stove polish, sold at retail for ten cents, and used chiefly by the humbler and more ignorant classes.

The large number of affidavits submitted in this case has led me to consider the weight that ought to be attached to the opinions of persons professing to be experts. The conclusion to which I have arrived is, that while we will regard such affidavits so far as they

aid us, and throw light upon the case, the Court must at last exercise its independent judgment upon actual inspection of the trade-mark and its alleged imitation. As before observed, this is a mixed question of law and fact. Many of the professed experts may have but crude notions of what in law constitutes a trade-mark, or its violation. It does not follow as a matter of law that because one label resembles another in many respects it is necessarily such an imitation as a Court of Equity would declare an infringement of a trade-mark.

A careful examination of the two articles in question certainly discloses a strong general resemblance. Placed side by side upon the shelf of a country store, and viewed at some little distance, the similarity is striking. But when we come to analyze this general resemblance, it will be found to consist mainly of the color of the wrapper and the shape and size of the article. It is almost needless to say that the plaintiffs cannot have a trade-mark in red paper or parallelopipedons. I do not mean to say that even the color of the paper and the shape and size of the package are not to be considered in any case in settling the question of the imitation of a trade-mark. Where there is an imitation with any colorable differences, the fact of the use of a similar wrapper, and the same size and shape for the article itself, may add great strength to the charge of an intent to deceive. But of themselves they are not enough to constitute an infringement.

Leaving out these two points of resemblance, what else is there? It is not pretended that upon the second, third and fourth sides of the parallelopipedon there is any imitation. They are distinctly and radically different. Both the style and the matter of the printing are dissimilar. If there is any infringement at all, it must be upon the first side, containing the vignette.

We will consider first the lettering. The words "Stove Polish" are clearly no part of the trade-mark. They constitute the name by which the article is known to commerce, it is a principle too well settled to need the citation of authorities, that no one can appropriate as a trade-mark, the commercial name of any article known to trade. Nor do the plaintiffs claim a trade-mark in the word "Rising," except in its application to the word "Sun," and,

that is not used by the defendant in his label. He uses the word "Moon," which is of entirely different sound and signification.

The real point in the case is the vignette. The plaintiffs allege that the defendant's moon is an imitation of their sun. Yet the defendant's device resembles the moon quite as much as the plaintiffs' device resembles the sun. Neither is executed in the highest style of art. There is, however, a marked difference between them, and when it is considered that the one is appropriately labelled a moon and the other is appropriately labelled a sun, there ought not to be any serious difficulty in distinguishing the one from the other. The embarrassment of this branch of the plaintiffs' case consists in the fact that they have taken for a device one of the heavenly bodies which in shape closely resembles another of the heavenly bodies. They may, perhaps, be entitled to use the "Sun" as a device or symbol for their trade-mark, but it does not follow that they may in the same manner appropriate the entire planetary system, with its attendant moons, rings and comets.

It is unnecessary to refer at length to the plaintiffs' description of their trade-mark filed in the Patent Office. It may be that they are not absolutely restricted in this proceeding to the claim there made, as it is not instituted under the Act of Congress authorizing the registration of trade-marks and providing penalties for its violation. We are not called upon to decide this question, as the claim now made does not vary materially from what is claimed in the description filed in the Patent Office. The latter is certainly evidence, as being the statement of the plaintiffs themselves as to what they consider their trade-mark.

Nor do I attach any importance to the use of the word "Patented" upon the plaintiffs' label. It must be borne in mind that it is the trade-mark, not the manufactured article, that they claim to be patented. But it may be registered in the Patent Office, and a certificate granted therefor, which was done in this case, and was probably what the plaintiffs really meant when they stamped their label with the words "this trade-mark patented." When a manufactured article is stamped as "patented," when in point of fact no patent has been obtained for it, the law regards such a

transaction as deceptive, and a Court of Equity would refuse to enjoin for an infringement of a trade-mark for this reason alone.

The plaintiffs' device of a sun rising over and beyond hills is almost a fac-simile of the one at the head of the editorial columns of the New York *Daily Sun*. It does not appear in this proceeding who is entitled to the credit of originating it, nor is it, perhaps, material.

I have referred to the points of difference between the trade-marks of the plaintiffs and the alleged imitation for the purpose of showing that the case as now presented is not clear enough to justify the Court in interfering by a preliminary injunction. This is the extent of our present decision. It is quite possible that the general resemblance between the two labels before alluded to is not the result of accident. There may be a case in which differences are designedly introduced, yet such a combination produced with the aid of the color of the wrapper and size and shape of the article as to amount to an infringement. In such cases the line of distinction between the genuine and the simulated trade-mark is a very nice one. The defendant's label, in my judgment, lies very close upon the border. We will determine upon which side of the line it is after the plaintiffs shall have established their right at law, or upon final hearing.

The injunction is refused.

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COURT OF COMMON PLEAS OF NEW YORK.
(CITY). IN EQUITY.

JAMES C. AYERS, ET AL., RESPONDENTS,

vs.

FREDERICK V RUSHTON, APPELLANT.

DECIDED 5 FEBRUARY, 1877.

REPORTED 7 DALY'S REP. 9.

*Cherry Pectoral Case.**Common Descriptive Words cannot be subject of trade-mark.*

1. Words in common use as descriptive of medicines for particular diseases, or which merely indicate by its common name, an ingredient of a medicine, cannot be appropriated by a manufacturer of such medicines as a trade-mark, nor can a combination of such words be so appropriated. *Caswell v. Davis*, 58 N. Y., 223, followed as controlling.
2. Plaintiffs invented and prepared a medicine for chest diseases, to which they gave the name of "Cherry Pectoral," and which was extensively known and sold as "Ayers' Cherry Pectoral;" one of the ingredients was extract of wild cherry, and the word "pectoral" had been, before the invention of plaintiffs' medicine, applied to medicines for chest diseases. HELD:

That the plaintiffs could not claim the exclusive use of the words "Cherry Pectoral," as a trade-mark.

Everet P. Wheeler, for appellant.

John Sherwood, for respondents.

Appeal by the defendant from a judgment in favor of the plaintiffs, granting a perpetual injunction against manufacturing a compound called "cherry pectoral," and using that name upon bottles, labels, or wrappers, and selling any compound by that name, and against imitating the plaintiffs' trade-mark "cherry pectoral." The defendants appealed upon the judgment roll including the findings of fact and law made at special term.

JOSEPH F. DALY, J.:

The findings of the learned Judge at special term that "the articles put up, advertised and offered for sale, and sold by defendants under the title and name 'Cherry Pectoral' is well calculated to deceive and mislead purchasers and induce them to believe that the said article of defendant is that of the plaintiffs;" and that "the defendant, with the wrongful intent to induce purchasers to believe that the articles sold by him was the same as that of the plaintiffs, and with the wrongful intention of securing to himself the benefit of the plaintiffs' trade-mark, has imitated the trade-mark of the plaintiffs so closely as to mislead and deceive purchasers;" and that "the use by defendant of the words, name and title 'Cherry Pectoral' is a wrongful and unlawful imitation of the words, name and title 'Ayer's Cherry Pectoral,' the plaintiffs' trade-mark:" are not, in my opinion, sustained by the sixth and ninth findings in which the several compounds, packages, labels and wrappers of the plaintiffs' and defendant's preparations are set forth, and in which the defendant's acts in presenting his compound to the public and endeavoring to make sales of it, are minutely described. From these findings it appears that both preparations are nearly alike in color, taste and smell, although defendant has lately altered his compound slightly, in these particulars; that they are both put up in oblong flat, clear

glass bottles; that plaintiffs' bottles contain about six ounces and defendant's about five and a half ounces; that plaintiffs' bottles are stamped "Ayer's Cherry Pectoral," and defendant's (I assume in the absence of any finding on that point) are not stamped; that plaintiffs' bottles are in a paper wrapper of a deep orange color, and defendant's bottles in a white paper wrapper; that plaintiffs' wrapper bears the printed words (the color of the ink not specified in the finding) "Ayers' Cherry Pectoral for the various affections of the lungs and throat, such as Colds, Coughs, Croup, Asthma, Influenza, Hoarseness, Bronchitis, and incipient consumption, and for the relief of consumptive patients in advanced stages of the disease. Prepared and sold by J. C. Ayers, Lowell, Massachusetts. Price one dollar;" and defendant's wrappers bear the words, printed in red ink, "Cherry Pectoral, Rushton, F. V.," and upon an inside wrapper "Cherry Pectoral," and after some printed words of description and recommendation, the words "For Sale, wholesale and retail, by Rushton & Co., 11 Barclay Street, New York, formerly of No. 11 Astor House;" that defendant advertised by posters, placards and signs the words "Cherry Pectoral," for sale at 11 Barclay Street, and placed signs in front of his store with the words "Depot of the Cherry Pectoral Company" thereon; that he conspicuously placed in his store a placard with the words "Ayers' Cherry Pectoral, one dollar. Rushton's Cherry Pectoral, fifty cents. Which will you have?" That he instructed his clerk to answer to purchasers who called for Ayers' Cherry Pectoral, that his Cherry Pectoral was not Ayers', and to ask persons inquiring for Cherry Pectoral, which they wanted, Rushton's or Ayers', and to say that Rushton's was much better; that bottles containing said preparations are almost uniformly sold in closed opaque paper wrappers.

We have then, the undisputed circumstances that the defendant has been careful to distinguish his preparation from plaintiffs', by a marked difference in the color of the wrappers, the lettering and the arrangement of the words printed on the wrapper, and by distinctive announcements, the signs in his store, and through his clerks. In fact, he seems to have taken precautions to prevent the two compounds from being confounded in the eyes of pur-

chasers; and to prevent purchasers being misled or deceived into buying his medicine under the impression that it was plaintiffs' medicine.

Defendant certainly did take advantage of the celebrity of plaintiffs' preparation to which the name of "Cherry Pectoral" seems, from the findings, to have been exclusively applied in the trade, in the last thirty years or more, to gain a readier market for a preparation of his own which he called "Cherry Pectoral;" whatever popularity Ayers' Cherry Pectoral had acquired as a medicine for throat and lung affections, he hoped to gain advantage from by calling his medicine a Cherry Pectoral, thus inducing persons to try his compound, if they could be persuaded that one Cherry Pectoral was as good as another. To this extent, and a very great extent it is no doubt, defendant proposed to build up a business upon and avail himself of, the fame which years of sale and a great expenditure of money for advertising on the part of plaintiffs and their predecessors had acquired for the well-known preparation they manufactured, but there is clear proof that he did not intend to incur any penalty for imitation of devices, labels, or marks, or for attempts to impose his compounds upon the public as the article plaintiffs manufactured. He kept within the letter of the law, if he were at liberty to call his preparation "Cherry Pectoral."

It appears from the findings, that Ayers' Cherry Pectoral is a medicine for the relief and cure of affections and diseases of the lungs and throat, of which medicine the extract of wild cherry is one of the beneficial ingredients. The word "cherry" describes, therefore, one of the ingredients of the compound, and the word "pectoral" describes the use and application of the medicine. The findings show that "pectoral" as an adjective referring to medicine for the throat and lungs, was known to scientific men, and was found in books of surgery, &c., before plaintiffs' compound was invented; and that medicines for the throat and lungs called "Pectoral Syrup," and "Pectoral Wine" appear in medical books prior to the plaintiffs' use of the word; that a medicine called "Britton's Pectoral Syrup" had been made and sold in Northamptonshire, England, before that time; that in dictionaries

published before plaintiffs' manufacture of "Cherry Pectoral," began in 1842, and of standard dictionaries of the English language, show that the word "pectoral" as a noun, as well as an adjective, was and is a common established word in the language signifying a medicine for coughs, for the stomach and lungs, for the breast and for diseases of the breast. (*Johnson's Dict.*, Ed. 1799; *Dunglison's Med. Dict.*, Tit. "Pectorals;" *Rees' Cyclopaedia*; *Richardson's Dict.*; *Blunt's*, 1681; *Philip's "New World of Words"*; *Glossographia Anglicana*, 1707; *Cole's Dict.*, 1717; *Kersey's Eng. Dict.*, 1721; *Bailey's Dict.*, 1763; *Johnson*, 1763; *Ash*, 1765; *Allison*, 1813; *Worcester*). The word "pectoral" therefore, is common property, as descriptive of a medicine for diseases of the chest, breast, lungs and throat, and no person can acquire an exclusive right to its use in that sense. The word "cherry" indicating an ingredient or the sole or chief ingredient, as an extract or tincture of wild cherry in a medicine cannot become the exclusive property of any person to describe the medicine in the compounding of which it is used. The same must of course be said of a descriptive term made up of the two words "cherry" and "pectoral," used to describe the ingredients and use of the compound.

The late case of *Caswell v. Davis*, (58 N. Y., 223), is controlling as a decision directly in point.

No attempt is made by defendant to infringe plaintiffs' trademark in the name of "Ayers," in which they have an exclusive property, and the injunction prayed for against the use of the name "Cherry Pectoral" should have been denied.

VAN HOESSEN, J., concurred.

Judgment reversed, and new trial ordered, costs to abide event.

Fairbanks, and others *vs.* Jacobus.

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IN THE CIRCUIT COURT OF THE UNITED
STATES, FOR THE SOUTHERN DISTRICT,
NEW YORK. IN EQUITY.

THADDEUS FAIRBANKS, AND OTHERS,*vs.*SAMUEL H. JACOBUS.

DECIDED 15 OCTOBER, 1877.

REPORTED 14 BLATCH., 337.

Fairbanks' Scale Case.

1. E. and T. Fairbanks & Co., manufacturers of scales, alleged that Jacobus made scales by using, to make the iron castings thereof, the corresponding parts of a scale made by them, to form the moulds for the castings, and that the general shape and arrangement and color and external appearance of such scales, were imitated from the Fairbanks' scales so nearly that only an expert in scales could distinguish the differences between them.
2. A trade-mark is always something indicative of ownership, by adoption and repute, and is something different from the article itself, which the mark designates.
3. Any one may make anything in any form and may copy with exactness that which another has produced, without inflicting any legal injury,

unless he attributes to that which he has made a false origin, by claiming it to be the manufacture of another person.

4. The words "Fairbanks' patent" were cast in the scales made by both parties. All the patents which Fairbanks & Co. had, had expired. Fairbanks & Co. applied for an injunction to restrain Jacobus from using the words "Fairbanks' patent" on his scales, and from making or selling an imitation of Fairbanks & Co's scales. **HELD:**

That the application must be denied; that the words "Fairbanks' patent" were not a trade-mark; and that Jacobus did not represent his scales to be of the make of Fairbanks & Co.

5. In trade-mark cases, it is by no means of course to grant preliminary injunctions even where the plaintiffs' case seems to be made out.

Lucius E. Crittenden, for the plaintiffs.

Reed and Drake, for the defendants.

JOHNSON, J.:

This motion is made for a preliminary injunction to restrain the defendant from the use of the words "Fairbanks' patent" upon platform scales, and from making or selling an imitation of Fairbanks' scales. This preliminary relief is sought substantially upon the grounds of imitation of the articles made and sold by the plaintiffs, and of violation of the plaintiffs' alleged trade-mark. No question of violation of patent rights is involved, for there is no claim by the plaintiffs that the scale complained of is, either in the whole, or in any part, an invasion of any existing patent owned by the plaintiffs.

Indeed, it is not claimed, on the part of the plaintiffs, that any part of their scale alleged to be imitated is protected by any existing patent, or that any existing patent owned by them applies to their own scale, except a small and unessential, though useful, addition to the scale frame, by which the oscillation of the weighing beam is prevented, under certain circumstances. This addition, which the scale complained of does not possess, is secured by an existing patent to the plaintiffs, and bears the proper words required by statute "Patented Feb. 11th, 1862," cast upon it.

1. The alleged imitation as claimed by the plaintiffs, consists in this, that the scale complained of as to the iron castings enter-

ing into its structure, was made by using the corresponding parts of a scale made by the plaintiffs, to form the moulds for those castings; and that the general shape and arrangement, as well as the color and external appearance, are imitated from the plaintiffs' scale so nearly that only an expert in scales could distinguish the difference between them. While, as matter of fact, I should, after an inspection of the two scales, not think the discrimination so very difficult, yet it may be taken to be not only very difficult, but impossible, to discriminate between them. That fact does not give the plaintiffs any right. Their patents, while they existed, (and those concerned terminated in or about 1845), protected them in the essential structure of their invention, but exterior form, painted color, and such non-essentials, were not, and could not be, the subjects of the patents, and did not, and could not, secure these to the plaintiffs. Much less could these be secured as a trade-mark, for, a trade-mark is always something indicative of origin or ownership, by adoption and repute, and is something different from the article itself which the mark designates. An invention of structure a patent for the invention secures; a design is secured by a patent for that.

3. Apart from these, any one may make anything in any form, and may copy with exactness that which another has produced, without inflicting any legal injury, unless he attributes to that which he has made a false origin, by claiming it to be the manufacture of another person. Any other doctrine is impossible to be maintained; for, otherwise, all the colors, all the unessential forms, could be monopolized as trade-marks, and exclusive rights would be created, not limited in time, as patents are, founded upon no public utility, and subject to no control but the will of the adopter. I think there is no difference in the cases on this subject. (*Amoskeag Co. v. Spear*, 2 Sandf. S. C. R., 599; *Gillott v. Esterbrook*, 47 Barb., 455; *Newman v. Alford*, 49 Barb., 588). I conclude, therefore, that there is no invasion of the plaintiffs' rights, in the purposed and actual identity, both of structure and appearance, in the scales in respect to which the defendant is sued, with those which the plaintiffs manufacture.

4. The case does not, however, rest here. On the base of the platform of what I may call the defendant's scale, are cast the words "Fairbanks' patent" with the number indicative of size, 11, and upon the weight beam are stamped the words "Fairbanks' patent." These are all the words which appear upon these scales, which can be the foundation of a charge of invasion of trade-mark, and, indeed, are all the words or figures upon any part of the scale. The same words appear on corresponding parts of the plaintiffs' scale, and, if they constitute a legal trade-mark, I shall assume, for the present purpose, that the defendants' scales violate it. Are these words a name of origin, or a name of quality, indicating structure? Whatever they are in the one scale, they are, also, in the other. In some of the plaintiffs' scales their origin is signified by a quite different mark: "Fairbanks Standard, made only by E. & T. Fairbanks & Co., St. Johnsbury, Vermont." This is a valid trade-mark of the plaintiffs, but does not appear upon their scale produced in Court. The other words must be understood as claiming that the thing on which it appears is protected by a patent. Especially is it thus localized and referred to the particular parts on which it appears, when, upon another part, is found the proper patent mark, which is necessary to support an action for an infringement, in the absence of notice, under section 4900 of the Revised Statutes. This gives significance to the use of the other marks, and makes the conclusion almost irresistible, that the purpose of the other words, on the beam and the frame, are to impress upon the incautious public, that the scale is the subject of a patent, and, therefore, not open to competition in manufacture or sale.

I agree, on this point, with the position of the plaintiffs' counsel, in his printed points, that "it is an error to suppose that even the patentee may so stamp his articles and deceive the public after the expiration of his patent," citing *Leather Cloth Co. v. Am. Leather Cloth Co.*, (*Am. Trade-Mark Cases*, 688-713). And I add, in confirmation of this view, the decision of Judge Cadwalader, in the Eastern District of Pennsylvania, October 4th, 1875, in *Consol. Fruit Jar Co. v. Dorflinger*, (*1 N. Y. Weekly Digest*, 427), upon reasons which seem to me quite satisfactory, and by

which, on a motion for a preliminary injunction, I ought to be guided. It is, of course, no answer, that the defendant is, at least, guilty of the same fault, or even a greater. The plaintiffs fail to make these words out to be a lawful trade-mark, and, of course, cannot maintain upon them their claim for relief.

As to the charge that the defendant threatens various supposed wrongs to the plaintiffs, in imitating their manufacture, and that he represents his scales to be of the plaintiffs' make, the allegations are not so made out as to satisfy my mind of their substantial truth. (*Byam v. Bullard*, 1 *Curtis C. C. R.*, 100). I doubt whether the defendant meant anything beyond the assertion of a right to use the words on the scale, which had been for many years openly used by him and his predecessors, under claims of right, and for some time, at least, and to some extent, with the knowledge of the plaintiffs or their predecessors.

Certainly, if the words "Fairbanks Patent" do not mean to assert the existence of a patent securing the scales, but only that they are made in conformity with, and embody the invention of, the expired Fairbanks' patent, they are free to all the world. What is not free is, to pretend that a scale is made by one person, which is, in fact, made by another.

5. In trade-mark cases, it is by no means of course to grant preliminary injunctions, even where the plaintiffs' case seems to be made out; and I shall, therefore, leave the further consideration of the case to the final hearing, when the questions as to the defendant's claim of right to the use of the words "Fairbanks' patent" and other questions of fact just referred to, and the unexplained circumstances and terms of the writing claimed to have extinguished the right of Chamberlain, can, if necessary, be further considered. The motion for an injunction must be denied, and the order heretofore made, granting an injunction till the decision of the motion, must be vacated.

6

IN THE CIRCUIT COURT OF THE UNITED
STATES, FOR THE SOUTHERN DISTRICT,
NEW YORK. IN EQUITY.

GEORGE HARRINGTON

vs.

JAMES L. LIBBY.

DECIDED 8 FEBRUARY, 1877.

REPORTED 14 BLATCHF., 128.

Tin Pail Case.

The exclusive use of a tin pail with a bail or handle to it, the tin ornamented with a geometrical pattern, and used to contain paper collars for sale, and sold with the collars, cannot be claimed as a trade-mark, either under the statute or by virtue of the general law of trade-marks.

James A. Whitney, for the plaintiff.

Edmund Wetmore, for the defendant.

JOHNSON, J.:

The plaintiff claims to be entitled to the exclusive use of a tin pail with a bail or handle to it, the tin ornamented with a geome-

trical pattern, and used to contain paper collars for sale and sold with the collars. This claim is not made on the ground that he is the inventor and patentee of pails thus made, or of the material used in making them, or of the art of selling collars by giving away a tin pail with them. But the claim is that this is a trade-mark, and entitled to protection as such, either by force of the statute of the United States on the subject, or by virtue of the general law of trade-marks. It appears that the ornamented tin pail which the plaintiff employs is a common article in commerce, and that pails made of tin, ornamented or unornamented, are and have long been in use for all such purposes as any one chose to apply them to. The question whether any one can seize upon such an article and make title to its exclusive use for a special purpose, by calling it a trade-mark, must be far from clear in favor of the claimant. The forms and materials of packages to certain articles of merchandise, if such claims should be allowed, would be rapidly taken up and appropriated by dealers, until some one, bolder than the others, might go to the very root of things, and claim for his goods the primitive brown paper and tow string, as a peculiar property. It will be observed, that it is not a mark at all which is claimed, but the whole enveloping package, the whole surface of which is covered by the ornamental pattern. There is no name, no symbol, no assertion of origin or ownership. The case strongly resembles that of Payson's Indelible Ink, (*Browne on Trade-Marks*, secs. 271, 272), where the claim was rejected, on the ground, that, if maintained, the effect would be to gradually throttle trade. The case of *Moorman v. Hoge*, (2 *Sawyer*, 78), seem to me quite in point. In favor of maintaining the right to the barrel in question in that case, all circumstances of fact concurred, but the Court held that the law did not recognize an exclusive right to an unpatented package, nor permit its assertion. I concur in the principles maintained in that case, and think the plaintiff has failed to show such a right in the premises as can entitle him to a preliminary injunction. The motion must be denied.

7

UNITED STATES CIRCUIT COURT, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.LA SOCIÉTÉ ANONYME DES MINES ET FONDERIES DE
ZINC DE LA VIEILLE MONTAGNE*vs.*

CHARLES H. BAXTER, AND OTHERS.

DECIDED 12 JUNE, 1887.

REPORTED 14 BLATCHF., 261.

Oxide of Zinc Case.

The right of A. to a trade-mark in connection with the dry, white oxide of zinc, is not infringed by the sale of a paint composed of a white oxide of zinc, ground in oil, and untruly represented as containing white oxide of zinc made by A., such trade-mark never having been applied by A. to that article ground in oil.

Daniel D. Lord, for the plaintiff.

Dickerson & Beaman, for the defendant.

BLATCHFORD, J.:

On the allegations of the bill, the plaintiff can claim their trade-mark only for the dry white oxide of zinc. It does not appear that

they ever sold that article ground in oil, or ever applied such trade-mark to that article ground in oil. The fact that the defendants sell a paint composed of a white oxide of zinc ground in oil, and represent it as containing white oxide of zinc made by the plaintiffs, when it does not contain white oxide of zinc made by the plaintiffs, is no violation of any trade-mark of the plaintiffs. The defendants have not sold the dry white oxide in that state. It is not shown that the plaintiffs have sold such oxide ground in oil. It is true that the oxide is intended to be ground with oil, for a paint. So, flour is intended to be made into bread. But, if a baker should falsely stamp his bread with the mark of a particular brand of flour, the maker of such brand, if having a trade-mark therefor, could not claim that the baker had violated his trade-mark. And so of any other raw material which enters as an ingredient into a compound or article of manufacture,

The application must be denied.

8

UNITED STATES CIRCUIT COURT, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

GEORGE J. SEABURY AND ROBERT W. JOHNSON*vs.*

JOHN M. GROSVENOR.

DECIDED 16 JUNE, 1877.

REPORTED 14 BLATCH., 262.

Caprine Plaster Case.

Where a person who claimed property in a trade-mark, had acquired it, if at all, by the use, in circulars, of fraudulent and deceptive and untrue language as to the origin and qualities of the article in respect of which the trade-mark was claimed. **HELD:**

That he had lost his right to claim the assistance of a Court of Equity to protect his trade-mark.

Rowland Cox, for the plaintiffs.

Joseph W. Howe, for the defendants.

BLATCHFORD, J.:

The evidence is clear that the plaintiffs were systematically and knowingly carrying on a fraudulent trade. Although they may

have omitted the fraudulent and deceptive and untrue language from their circulars before this suit was commenced, yet if they have any property in the trade-mark which they claim the title to, they acquired such property by the use, for a considerable time, of such language in the circulars which accompanied the articles they sold, and in respect of which the trade-mark is claimed. Such language was to the effect, that a celebrated chemist had recently discovered a vegetable principle of great value, and, prior to making it generally known, had introduced it into hospitals, and had generously extended its use to the most successful physicians; that the flattering and astonishing results which characterized its action, at once stamped it as the most remarkable principle ever discovered; that the powerful remedy was named Capcine; and that it was used in plasters prepared by the plaintiffs, and called "Benson's Capcine Plasters." A registered trade-mark is claimed in the word "Capcine." Courts of Equity refuse to interfere in behalf of persons who claim property in a trade-mark acquired by advertising their wares under such representations as those above cited, if they are false. It is shown that there is no such article as Capcine, known in chemistry or medicine, or otherwise. The authorities are clear, that, in a case of this description, a plaintiff loses his right to claim the assistance of a Court of Equity. (*Lee v. Haley*, L. R., 5 Chy. Appeal Cases, 159; *Leather Cloth Co. v. American Leather Cloth Co.*, 4 De G., J. & S., 142).

The motion for an injunction is denied.

9

UNITED STATES CIRCUIT COURT, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

I. C. FRESE & CO.*vs.*EDWARD BACHOF.

DECIDED OCTOBER TERM, 1877.

REPORTED 13 OFFICIAL GAZETTE, 635.

Hamburg Tea Case.

1. In a meritorious cause of action, properly brought in the firm-name for violation of firm-rights, leave will be given before final decree, to join a member of the firm who had been omitted as a party to the suit.
2. Long-continued use of a particular form of package and of particular colors for its wrappers, papers of directions and labels, having served to distinguish the complainants' article in the trade, the appropriation of such peculiarities in form and color by another dealer for packages of the same article will be restrained.

Arthur v. Briesen, for complainants.*Brodhead & Wright, Elliott F. Shepard*, and *Simon Sultan*, for defendant.

MOTION TO AMEND BILL.

Upon leave given before entry of final decree, motion was made and granted to join as party to the cause a firm member who had been previously omitted in an action brought and maintained in the firm-name.

Costs were disallowed, except so far as they had accrued since curing the defect of non-joinder by the appearance of the omitted partner.

(Test suit. Similar judgment entered by stipulation against *Th. Briedenfeld and Klein, Fleet & Co.*)

OPINION.—March 22, 1878.

WHEELER, J.:

This cause has been heard on bill, answer, replication, proofs, and argument.

The bill is brought by Christel F. H. Frese alone, claiming to stand upon rights acquired by a firm of methods of identifying their wares, of which he alleges himself to be now the sole member. The defendant does not admit any right to the orator, but leaves him to his proof. The proof shows Johann Siegmund Schroder to be a member of the firm equally with the orator, and whatever right it does show in respect to the matter of the bill, it shows to belong to the firm. As the case stands, the orator has no right to be protected in this form, and if it should proceed to a decree the bill would have to be dismissed.

1. But the bill is brought in the firm-name and right, and has been litigated in that right, and the want of the other member is a defect that can be cured by amendment. (*Lewis & Co. v. Locke*, 41 *Vt.*, 11). Under such circumstances, where a case appears to be meritorious, it is not usual to proceed to a decree without affording an opportunity to amend upon some terms. (*Story's Eq. Pl.*, section 236). This consideration makes it necessary to inquire into the merits of this case.

The orator's firm has not any patent on the compound called "Hamburg Tea." The manufacture and sale of that article are

open to all persons. Nor is it in the bill directly alleged, nor does the bill appear to proceed on the ground that this was appropriated and used by them to identify their production. So, for aught that appears, all persons are at liberty to apply that name to their own manufactures. The proof shows clearly that the name of the orator's firm has long been used in this business, and that the wares of the firm of this sort came to be known by it. It also shows that this firm is a successor of the former one. Whether it is or not, is a question of fact, and this fact could be and has been established by parol proof. The trade-marks of the firm were partnership property, and would pass to the successors. (*Coll. Part.*, sec. 165). The defendant does not claim the right to use the firm-name of the orator's firm, nor their registered trade-mark, and there is no question made about those. But the orator claims that his firm and their predecessors have long been accustomed to pack this article in long cylindrical packages with pink wrappers, and to have crimson papers of directions, and yellow ones of warning, tied in with each package, and their firm-name printed across a white label within a circle pasted across the ends of the string, and the same embossed with the words "Hamburg, Hoffensack, 6" on another white label pasted on the package, so that the package by its form and colors would be at once known by its general appearance without taking time to read anything on it, and that their wares have come to be well-known as theirs by the appearance of the packages.

2. They have the exclusive right to sell their wares as their own, and no other person has any right, by any means, to palm off any other wares than theirs as theirs. And if any person does utter any other wares than theirs as theirs an action at law would lie. And whenever there is danger that this would be done so often as to occasion multiplicity of suits, or so as to work irreparable injury, a Court of Equity would interfere by injunction. The orator's proof shows that the firm has long used this style of package.

It also appears that the defendant at first openly used the style of package, and firm-name; that, in obedience to warning, he discontinued the use of the name on the outside of the package, and that, under the pressure of legal proceedings, he has stopped

the use of that altogether, and also of the words "Hoffensack 6," but that he still continues the exact form and style of package, substituting his own name merely for that of the firm on the labels. The exact question is, whether this is a simulation of his wares for those of the orator's firm calculated to have them pass for the orator's firm's wares. Probably no mere form of a package would ever alone amount to a representation capable of indicating that the wares contained in it were those of any particular make. But when the form of the packages, the color of the wrappers and papers done up with them, and the form and color of the labels are considered all together, it is quite apparent that when they had been so long used by the orator's firm for holding this particular compound, when offered for sale, the mere appearance of the packages would amount to a representation that they contained that article of manufacture.

It is equally obvious that the very slight changes made by the defendant in the general appearance of his packages used by him now, would not put the general public purchasing such articles on their guard, and that the use of such packages for a similar article would amount to a forcible representation that it was the same article that the orator's firm had been accustomed to pack in that way. And when the mode in which the defendant commenced using such packages, and the various steps by which he has been brought to his present method are considered, there does not seem to be any fair question but that his use of them now is for the purpose of passing off his wares for those of the orator's firm.

Upon this view of the case, it seems that, with the proper parties before the Court, the defendant should be restrained by injunction from making the use he does of these symbols.

Let the cause stand, with leave to the orator to move for an amendment if he shall see cause within thirty days; otherwise let a decree be entered dismissing the bill of complaint with costs, but without prejudice.

OPINION.—MOTION TO AMEND BILL.

This cause has been further heard on the motion of the orator to amend; the affidavit of A. v. Briesen, solicitor, in support thereof and briefs of counsel.

From the whole case it appears that the firm of I. C. Frese & Co. consisted of two members. This cause was brought by one member, in the name of the firm, without joining the other member. The whole litigation has been carried on with reference to a right of the firm to protection and relief against the defendant; and it has been carried on in precisely the same manner that it would have been if the other member had joined in the bill as an orator, so far as has been made to appear or is claimed. The cause of action that has been litigated is exactly the same that the bill will cover if the amendment is allowed and made. It is urged in opposition that the Court has no power to permit an amendment to be made that will change the cause of action. This is considered to be true when the amendment would bring in a cause of action not before involved; and that is the sense in which the remark of the Supreme Court of Vermont, in *Lewis & Co. v. Loche*, (41 *Vt.*, 11), quoted in the defendant's brief, was used. A necessary amendment always changes a cause of action in another sense, as when it changes what would be no cause of action to a good one, or one that the proof will not support to one that it will, or one imperfectly described to one well described. In this case the cause of action in the name of the firm is well set forth, but the firm itself is not properly described and represented.

1. The amendment will cure that imperfection, which is precisely what was done in the case cited. And it may be done at this stage of the cause. (*Tremaine & Co. v. Hitchcock*, 23 *Wall.*, 518). It is also argued that the orator should not be favored because he seeks to restrain dealing in the well-known compound involved called "Hamburg Tea." But that is not the relief sought, nor that to which the firm is thought to be entitled; but it is that the defendant shall not pass off tea of this sort, of his own or others' manufacture, for that of the orator's firm. This is not claiming any monopoly, nor fostering one, but is merely

claiming and protecting a right of that firm that is common to all persons.

On the whole, it is considered that the amendment should be allowed, but that the orator should recover no costs of the proceedings in the cause while it was so situated that it could not proceed to a final decree in his favor; and the defect was one of which he must have had knowledge, although probably he had no knowledge of its effect.

Let an order be entered granting leave to amend the bill of complaint by permitting said Johann Siegmund Schroeder to appear as a party complainant therein in his right as a member of the firm of I. C. Frese & Co. at any time before the 15th day of May, 1878; and upon such appearance, let a decree be entered for the orators according to the opinion hereinbefore filed, with costs to the orators after the appearance; and if he does not so appear, let a decree be entered dismissing the bill of complaint with costs, but without prejudice.

DECREE.

This cause having come on to be heard upon the bill of complaint herein, the answer of the defendant, E. Bachof, the replication of the complainants to such answer, the amendment to the bill of complaint duly entered in the order book, and the proofs—oral, documentary, and written—taken and filed in said cause, and the same having been argued by counsel for the respective parties.

And it appearing that the firm of I. C. Frese & Co. is exclusively entitled to the style and arrangement of packages mentioned in the bill of complaint for containing the medical compound known as “Hamburg Tea,” manufactured and sold by said firm, and also to the exclusive use of its registered trade-mark, mentioned in said bill of complaint, and that the defendant has infringed the rights of the complainants by manufacturing, using, and selling what purports to be “Hamburg Tea,” in packages of substantially the same style and arrangement as those to which the complainants’ firm, of I. C. Frese & Co., is exclusively enti-

tioned, and also by applying to said packages the complainants' said registered trade-mark.

Now, therefore, in consideration thereof, it is ordered, adjudged and decreed, and the Court doth hereby order, adjudge, and decree as follows, viz:

1. That the said complainants do recover of the defendant those costs and charges and disbursements in this suit—to be taxed—which accrued after Johann Siegmund Schroeder has been made a party complainant herein in his right, as a member of the complainants' firm of I. C. Frese & Co.

2. That the said complainants do recover of the defendant the damages which the complainants have sustained by, and compensation for the manufacture, use, and sale by said defendant of medical or other goods contained in packages made in imitation of the style and arrangement of complainants' packages, set forth in the bill of complaint, or resembling the same so nearly as to be calculated to deceive.

3. That the said complainants do recover of defendant the damages which the complainants have sustained by, and compensation for, the manufacture, use and sale, by the defendant of medical or other goods contained in packages to which the complainants' registered trade-mark No. 1946, or substantially the same, or so nearly resembling it as to be calculated to deceive, was affixed.

4. That Joseph M. Denel, of the city of New York, N. Y., be appointed master to ascertain and take and state and report to the Court the number of packages containing medical or other goods manufactured or put up, and the number sold, by the defendant, or on his behalf, in infringement of the style and arrangement of the complainants' packages, and the number of such packages now on hand; and also the number of packages manufactured or put up, and the number sold by the defendant, or on his behalf, having the complainants' registered trade-mark No. 1946, or substantially the same, or so nearly resembling the same as to be calculated to deceive, affixed thereto, and the number of such packages on hand; and also the gains, profits, and advantages which the said defendant has received, or which have arisen or

accrued to him by reason of such infringements, and the damages suffered by the complainants, and the compensation due the complainants by virtue thereof.

5. That the said master, on such accounting, shall have the right to cause an examination of said defendant, and of other witnesses, to be had *ore tenus* or otherwise, and shall have the right to order the production of the books, vouchers, and documents, and other memoranda of said defendant, his agents, servants, and attorneys; and that the said defendant and other necessary witnesses attend for such purpose before said master from time to time, as such master shall direct.

6. That a perpetual injunction be issued in this suit forthwith against the said defendant, restraining him, his clerks, agents, servants, attorneys, and workmen, and all claiming or holding under or through him, according to the prayer of the bill of complaint for such injunction, but in accordance with the opinion filed in this cause.

10

UNITED STATES CIRCUIT COURT, EASTERN
DISTRICT OF VIRGINIA, AT ALEXANDRIA.
IN EQUITY.

W. T. BLACKWELL & CO.

vs.

W. E. DIBRELL & CO.

DECIDED 13 JANUARY, 1878.

REPORTED 3 HUGHES C. CT., 151.

Blackwell's Durham Tobacco Case.

1. ESTOPPEL. In order for one suit to constitute an estoppel upon any party to another suit, four conditions must co-exist, viz:
 - 1st. There must be an identity of the cause of action.
 - 2nd. There must be an identity of parties to the suit.
 - 3rd. There must be an identity in the character or quality of the respective parties, and
 - 4th. There must be an identity of the thing in question.
2. Defendants do business in Richmond, Va., and advertise and sell, as Durham smoking tobacco, tobacco which they put up in Richmond, and which they obtain from any source available to them other than Durham. Such a practice necessarily deceives every purchaser who, in purchasing this Durham smoking tobacco, believes that he is pur-

chasing the fine tobacco put up in the place of that name in North Carolina.

3. The right to use a trade-mark is forfeited by non-user for a period of eight years, and cannot be resumed in prejudice of one who had used it exclusively during the period of abandonment.
4. The assignment by one partner of all his interest in a firm to his co-partners carries with it, if not expressly reserved, the right to the exclusive use of a trade-mark of the firm.
5. The right of exclusively using the word Durham in labels on smoking tobacco, belongs to the manufacturers of the article in the town of Durham, North Carolina.
6. A trade-mark consisting of a word and symbol arbitrarily assumed, may be lost by non-use by its owners, especially if the disuse continues as long as eight years.
7. The right of exclusively using the word "Durham" in connection with the picture of a Durham bull in labels on smoking tobacco, belongs to W. T. Blackwell & Co., of that town.
8. If an equivalent trade-mark, without any knowledge of the first, be originated and devised by another person during such period of disuse, that other person may thereby acquire a right of exclusive use in the second trade-mark.
9. If this second trade-mark during such period of abandonment, acquires a public and valuable geographical and commercial signification, so that the use of the original trade-mark as an arbitrary one, would operate to deceive and defraud the public, a Court of Equity may enjoin against such use of the original one.

Mr. Solicitor General *Samuel F. Phillips* and *W. A. Maury* of Washington; *Mr. Legh R. Page*, of Richmond; *Mr. John W. Daniel*, of Lynchburg; and *Messrs. Merriman, Fuller and Ashe*, of North Carolina, appeared for the complainants; and *Mr. W. H. Browne*, of Washington; *Mr. George Harding*, of Philadelphia; and *Messrs. Williams and Digges*, of Lynchburg; and *John O. Stiger*, of Richmond, appeared for the defendand.

IN CHANCERY.

Some time before the year 1860, the North Carolina Railroad was laid off over the farm of Dr. Bartlett Durham, in Orange

County, North Carolina. A station was established there, and called Durham Station. This spot shortly became the seat of a small tobacco factory, a blacksmith's shop, a tavern, and the residence of two or three families. It remained an insignificant place until after the civil war, in 1865. It then began to grow up under the effect of a very prosperous tobacco business, which had risen there. In 1866, it was incorporated as a town, and called Durham. Now it is a place of several thousand inhabitants, and of a very large business.

The original tobacco factory of 1860 was conducted by the firm of Morris & Wright. This firm principally manufactured plug tobacco, but it utilized its clippings and waste tobacco by putting it in bags and disposing of it as smoking tobacco.

Some time before, or in 1861, one of the partners of this firm Wesley A. Wright, (who is connected with the defence in this suit), sold out all his interest to the other partner, Morris, and went off into the neighborhood, where he manufactured tobacco in a rude way for a year, and then joined the Confederate Army, and disappeared from Durham Station. To that place he has not returned, either to reside or do business. He seems to have paid a visit there about 1871 or 1872. We first hear of him after the war, as a tobacco manufacturer, in 1869, in Liberty, Virginia. He then went to Stewartsville, near Liberty. Hearing that J. R. Green, a successor to Morris & Wright, at Durham, was using the Durham bull as a trade-mark, he adopted the device of the head and neck of a short-horn bull on his tobacco. While at Lynchburg, in 1871, Wright sold to L. L. Armistead a patent which had then recently obtained, No. 111,712, for a compound liquid flavoring—which he used in making an improved smoking tobacco called “Durham Smoking Tobacco,” in which appellation he used the word Durham as an arbitrary term for the smoking tobacco made with the said patented flavoring liquid. *Record*, p. 211. All right to use the word thus derived by Armistead, was sold by Armistead in September, 1872, to the firm of W. T. Blackwell, then consisting of W. T. Blackwell and Julian S. Carr, of Durham, N. C. *Record*, p. 207. It appears from the answer of defendants, Dibrell & Co., that they are and have

been using "with the consent and by the authority of the said Wesley A. Wright, a label substantially the same" as that used by the complainants, and filed by them as an exhibit, to wit: A label, having the words and devices, "established 1860, at Durham, N. C., the original Durham Smoking Tobacco, W. A. Wright, originator and patentee."

The original factory of Morris & Wright, at Durham's Station, went on under different proprietors, and its business has gradually developed into that now conducted by W. T. Blackwell & Co., the complainants in this suit. It is probably the largest manufactory of smoking tobacco in the world.

Those who profess to know, ascribe the prosperity which has attended this business to the peculiar excellence of the tobacco grown in several counties North of Durham, which market their product at that place. They say that it is through the influence of the climate or soil, or both, that the tobacco raised in the counties of Alamance, Orange, Caswell, Person, and Granville, in North Carolina, three-fourths of which is brought to Durham, has this quality. It is probable that there is more demand for Durham tobacco as a smoking tobacco than for any other grown in the United States. It is regarded as superior to all other articles for making granulated tobacco on account of its bright color and fine natural flavor; its being chiefly flue, sun, or air cured, and thin in the leaf and sweet. Nineteen-twentieths of the tobacco manufactured at and sent from Durham is grown in the counties named. Durham is the principal market for the tobacco of these counties.

A circumstance which is claimed to have given this tobacco the most sudden and wide-spread celebrity was the following:

Just at the close of the war the factory at Durham, which has been mentioned, had come down by assignment and succession to, and was then conducted by, one J. R. Green. At the time that Sherman's and Johnston's armies were in Orange County, Green happened to have a large quantity of loose leaf tobacco lying in bulk on the floor of his factory. Of course this was a prey which soldiers of either army as they passed along eagerly seized upon, and the evidence is that the whole of this loose tobacco was thus

carried away, and as the armies were soon disbanded much of it is conjectured to have been carried to distant parts of the Union. At all events, the excellent quality of this smoking tobacco speedily obtained wide-spread advertisement and celebrity, and ever since then orders have come to Durham from every quarter of the United States.

J. R. Green found his business growing up rapidly under his hands. He at once adopted as his brand or label, and put it upon his bags, the words, "Durham Smoking Tobacco." He connected with these words the side figure of a short-horn bull, as a symbol of the word Durham; and he had a full size painting of such a bull placed broadside upon his factory, in conspicuous view of the railroad, as an advertisement of his business to all travellers. Green having died, his business passed by succession and assignment to Blackwell and others, and is now conducted by W. T. Blackwell & Co., the complainants in this cause. The name Durham placed in Green's brand was, of course, suggested by the place where the species of tobacco in which he dealt was principally marketed, and was intended as descriptive of that tobacco. It indicated tobacco grown in what Wheeler called the "Golden Belt of North Carolina." The trade-mark of a Durham bull was naturally assumed as a symbol of the word Durham, which had come to characterize the particular growth and quality of tobacco which is marketed and manufactured at Durham.

Those who claim under Wright disclaim that the word Durham, as used by him and them, has any reference to the place, Durham's Station, or Durham, in North Carolina, or to the tobacco marketed there by planters. They claim that Wright, when he manufactured tobacco near Durham's, a place then of utter insignificance, used the word Durham as an arbitrary term; that his tobacco was flavored with certain liquids invented and artificially concocted by him; that it was this flavoring, and not the soil or climate of the region trading at Durham, that gave his tobacco its excellence, and that the name Durham, and the device of a Durham bull were suggested to him about the year 1860, by seeing the brand of Durham mustard on a tin box. Wright's testimony on this head is as follows: Was in business at Liberty,

Va., in 1869; that was the first time the bull's head was used; first view was to adopt the entire bull in connection with the word Durham; the reason of not doing so was that his two sons in Kentucky wrote him that J. R. Green, of Durham, N. C., had adopted the bull on his brand, and he did not wish to interfere with anything that was ahead of him; first conceived the idea of using the word Durham, and the bull in connection with it in 1860; and the reason why he did not carry it out until 1869 was his inability to do so for the want of funds; the idea was first suggested by picking up a card [can!] of Durham mustard with the vignette of a bull on it.

Wright claims that Morris & Wright used the word Durham on their labels in 1860, and that he himself used the word in his label when living near Durham in 1861; but the evidence on this point is not at all conclusive.

On the other hand, the complainants deny that the word Durham was used at all before 1865 or 1866, either on the labels of Morris & Wright or of any of the successive firms which followed the original firm of Morris & Wright in the business at Durham's, if it was used, however, they claim the right to the exclusive use of it as successors and assignees of Morris, who bought out Wright's interest in the business of Morris & Wright. They insist, moreover, that Durham as descriptive of tobacco, is a geographical term, which first gained its significance just after the war, in 1865-66; that it derived its significance solely from the use of it by J. R. Green; and that, as Green's successors, they are entitled to the exclusive use of it. They patented a trade-mark in 1870 (No. 122), their patent describing their trade-mark as "painted on glazed paper, upon which is represented a side view of a Durham bull and the words Genuine Smoking Tobacco."

In 1871 a suit was brought in the Superior Court of North Carolina by W. T. Blackwell against W. A. Wright, (*Blackwell v. Wright*, 73 N. C., 310), in which the complainant, claiming a right to the exclusive use of the word Durham as a descriptive term for his smoking tobacco, on the same label with his symbolic trade-mark of the side view of a short horn bull, sought to enjoin the defendant Wright from using the word Durham as a description

of his smoking tobacco upon a label similar in color, material, and general appearance, having on it the head and neck of a short horn bull. The suit was a trade-mark suit, and the complaint contained no charge of fraud in deceiving the public, and no prayer for an injunction to prevent the use of a label deceptively assimilated to that of the complainant. The suit, after going to the Supreme Court of North Carolina, was dismissed on demurrer to the complaint, the demurrer being based on the ground that the complainant did not, by formal allegations of assignments, trace his title to the exclusive use of the trade-mark in question from J. R. Green.

In the same year a suit was brought in the United States Circuit Court for the Western District of Virginia, at Lynchburg, by W. T. Blackwell and J. S. Carr, partners, trading under the firm-name of W. T. Blackwell, against L. L. Armistead. See *infra*, p. 163, and *Blackwell v. Armistead, Brown on Trade-Marks*, 510. In that suit the complainants claimed the exclusive right to use the trade-mark already described, including the word Durham and the side view of short horn bull; charged an infringement of it by Armistead, as assignee of William A. Wright, in the use of the label of Wright, also already described; and prayed an injunction against all further use of the last named label. In this suit the complainants prevailed, and a perpetual injunction was granted; and the matters in controversy were afterwards compromised.

Under this condition of facts, the complainants, W. T. Blackwell & Co., a firm now consisting of W. T. Blackwell, James R. Day and Julian S. Carr, of Durham, N. C., have brought their bill into this Court against W. E. Dibrell and W. W. Phillips, partners, doing business in Richmond, Va., under the firm-name of W. E. Dibrell & Co. The complainants claim an exclusive right to use the trade-mark described in their patent (No. 122); they charge that the defendants are using the device and trade-mark which has been described as an imitation of their own and in infringement of their exclusive right; they allege that the defendants nowhere put their own name upon their labels, and that they disclose by such concealment an intention to defraud the complainants and the public generally, and they charge also, that

by the use of said label and trade-mark the defendants are practicing a fraud and deception by which the public are deluded, and induced to buy the said smoking tobacco as and for smoking tobacco made in Durham by the complainants. They charge also that the decree in the suit of *Blackwell v. Armistead* estops Wright and all others claiming under him from using the Wright label. The bill prays for an account and for a perpetual injunction.

The answer of defendants denies the right of complainants to the exclusive use of the word Durham in their label; denies that the Wright label is a fraudulent simulation of Blackwell's; founds their own title to use it upon the title of Wright, originating in 1860, and claimed to be still subsisting, and denies any intention to defraud the complainants or deceive the public. The answer also claims that Blackwell and W.T. Blackwell & Co., are estopped from claiming the exclusive use of the word Durham in their label by the decree of the Supreme Court of North Carolina in the case of *Blackwell v. Wright*.

The following opinion was delivered by

HUGHES, J.:

It is useless to review all the points relied upon by counsel on each side in their able argument in the cause. I shall consider only those questions upon which, in my judgment, the case really turns.

I shall first deal with the objection of estoppel or *res judicata*, urged by each party against the other.

1. In order for one suit to constitute an estoppel upon any party to another suit, four conditions must co-exist, viz: 1st. There must be an identity of the cause of action. 2d. There must be an identity of parties to the suit. 3d. There must be an identity in the character or quality of the respective parties; and 4th. There must be an identity of the thing in question. See *Smith v. Turner*, 1 *Hughes*, 375.

These conditions of identity do not exist between the present case and either of the cases of *Blackwell v. Wright* or *Blackwell v. Armistead*. These cases therefore, do not operate as estoppels, nor do they at all affect the one now under consideration, except so

far as they are precedents of authority upon the principles which were decided by them. In *Blackwell v. Wright* the decision was upon demurrer to the complaint; and, in technical effect, it was only that Blackwell had not traced his title to his trade-mark by proper allegations from Green; while, on the merits, the decision went only so far as to determine that the allegations of the complaint did not make a case of exclusive right to the trade-mark for the plaintiff. The complaint there did not charge that Wright's use of the trade-mark was a fraud upon the public, or pray for an injunction on that ground. None of these allegations can be made of the complainant's bill in this case.

In *Blackwell v. Armistead* it is true that the decision was upon the principal questions raised in the present case; but owing to the character of the pleadings it was based upon grounds narrower and more technical than those upon which I propose to found the present decision. That suit was a trade-mark case. This is more, and involves the question of the fraudulent use of a trade-mark, to the injury of the public at large, as well as of the complainants. Therefore neither of the two cases which have been urged in estoppel govern even as precedents the present one, which I shall now proceed to consider.

Two questions arise as to the pleadings and evidence :

1st. The first is, whether the defendants have any right at all to use a label in which the word Durham is used as descriptive of smoking tobacco, and in which the figure of a short-horn bull is used as a symbol of the word Durham; their right to the exclusive use of it not being claimed.

2d. The second question is, whether the complainants have a right to the exclusive use of such a label.

In considering the first question, I shall for the sake of brevity speak of the defendants' right to use the label described as Wright's, inasmuch as their title to use such a label could come, under the evidence in this cause, only from Wright.

Has, then, Wright, or his assignees, now, or have they at any time since 1865, had any right at all to use a label having in it the word Durham, as descriptive of smoking tobacco, and having also in it the figure of a short horn bull, or any part of that animal, as

a symbol of the word Durham? Of course their title to use the word and the symbol stands on the same basis; if it falls as to the word it falls also as to the symbol of the word.

There can be no doubt of Green's original right to the exclusive use of the full figure of a short horn bull as a trade-mark. That is virtually conceded by Wright himself in his testimony.

As to the word Durham as descriptive of smoking tobacco, the right to use it is in this cause claimed by defendants, who do business in Richmond, Va., and who advertise and sell, as Durham smoking tobacco, tobacco which they put up in Richmond, and which they obtain from any source available to them other than Durham.

2. Such a practice necessarily deceives every purchaser who, in purchasing this Durham smoking tobacco, believes that he is purchasing the fine tobacco put up in the place of that name in North Carolina. Dibrell & Co., claim solely from Wright. What then, is Wright's title under which this deception comes about?

He claims that he did not, in 1861, sell his right in the label used by Morris & Wright, to his partner, Morris, when he sold all his interest in the business. He claims that he derived the word Durham and the device of a short horn bull from a Durham mustard box. He pretends that neither the word nor the device, as invented and used by him, was descriptive or geographical in purport, but that they were arbitrary symbols, and that having been so at the beginning he and his assignees have still a right to use them.

3. The objection to this pretension lies not merely in the improbability of the origin of the word Durham and its symbol which Wright recounts, or in the unsatisfactory character of the evidence on which his original right to use the word and its symbol is based, or in the presumption that when he sold in 1861, he sold all his interest to Morris; but it lies also in these two facts, viz: 1st. That whatever title Wright had to the use of the word Durham after leaving Morris in or about the year, 1861, was lost by non-use, his disuse continuing through a period of eight or nine years after he left the vicinity of Durham's; and 2nd. That during this long period of disuse, the brand of Durham smoking

tobacco acquired a definite and peculiar meaning with dealers and consumers; the word Durham ceasing to be (even if it ever was) a mere arbitrary term, and having obtained a geographical signification as to the place—Durham, and a commercial signification as to the articles of tobacco manufactured at Durham. During the interval of disuse, the phrase Durham tobacco had come to indicate that portion of the product of a particular region of country which was marketed at the place called Durham's or Durham. The phrase "Durham Smoking Tobacco" had come to indicate in all markets, and among all dealers and consumers, the smoking tobacco marketed and manufactured at this place of Durham, in North Carolina.

It was not until after this signification had attached to the phrase that Wright adopted (or, as he pretends, returned to) the use of the word Durham, which he had abandoned. If, as he claims, the word Durham had in fact been used by him at first as an arbitrary trade-mark, and if, in addition, he had continued the use of it without interruption down to 1866, and on to the present time, that use by him would itself have prevented the other and local signification from attaching to the brand and word; for in that case, Durham smoking tobacco would have described two tobaccos: first, those marked and manufactured at Durham, and, second, those sprinkled with Wright's "Durham" juice.

But he did abandon its use; he stood by for some eight years, and allowed a peculiar commercial and local signification to attach to the word Durham as descriptive of smoking tobacco, and not until after that local and commercial signification had come to identify the tobacco labelled with the word all over the country as coming from a particular region, and as having a particular quality, and not until after this brand had come to be worth thousands of dollars to the manufacturers of this particular tobacco at this particular place, did he begin or resume the use of the device, which he claims to have derived from the mustard can.

2. To put that word now on tobacco grown elsewhere than at Durham, even though sprinkled with his "Durham" decoction,

is, in the light of the evidence in this case, to pass them off as tobaccos coming from Durham, and is to deceive and defraud all who deal in and purchase the commodity as smoking tobacco from Durham. It has so come to pass from Wright's non-use for eight years, that to manufacture and sell other tobaccos at all and brand them with the word Durham is to deceive the public, no matter what liquid may be used on them. Under existing circumstances, to manufacture even Durham tobacco elsewhere than at Durham, and to sprinkle them with a foreign liquid, is to deceive the public generally, and those who put up the genuine article at that place particularly.

The manufacture of these tobaccos at that place is the best guarantee which the public and the trade can have, that the commercial article labelled Durham Smoking Tobacco, and sold in all markets, is genuine, and prepared under the fewest temptations to adulteration.

3. That the right to use a trade-mark may be lost by abandonment or disuse is too clear to need argument or the support of authority. The law of the subject is stated in the chapter on *Abandonment*, sections 674 to 691, of *Brown on Trade-Marks*.

It cannot be pretended that in Green's first use of his label, in 1865 or 1866, he had any intention of taking up an old label at second hand, or had any knowledge or belief that Wright, or any one else, could claim the label which he then devised as entirely novel and peculiar. The field was open to his enterprise and invention, for establishing his business and inventing his label and trade-mark just as he did.

Green's adoption in 1865 or '66 of the word Durham, as descriptive of the best tobacco of North Carolina put up by him, and of the bull as a symbol of the word, was naturally suggested by the fact of his business. If Wright had ever had such a label, which I do not feel that the evidence warrants us to believe, it was in 1865-66 unknown in Durham; had been abandoned even then for some four years; had never signified anything but tobacco sprinkled with Wright's decoction; and had never borne the valuable and creditable commercial signification which the climate and soil and good husbandry of North Carolina and the enterprise of a Durham manufacturer were about to give it.

By the several facts of Wright's non-user of the label for eight years; of its never having, even as claimed by him, had any but an arbitrary significance as tobacco sprinkled with a species of artificial treacle, and of its having during a long period of disuse acquired a new, wholly different, and well and widely known geographical and commercial signification, Wright lost his right of using the label altogether. His use of it now operates necessarily to mislead and deceive the public as to the source of production and quality of the article bearing the label, thereby defrauding them: and the Court will therefore make a decree of perpetual injunction against the further use of it.

As to the second question, whether Blackwell & Co., have an exclusive right to the use of the label described in the pleading, I think on the evidence submitted that they have. We have no hesitation in so deciding as against the defendant in this cause, and will incorporate in the decree of the Court an order for an account of profits against the defendant as prayed in the bill.

5. The label and trade-mark of complainants was established in 1865 by J. R. Green. His business and that of his successors built up the insignificant and obscure place, Durham's Station, into the flourishing town "Durham." The town grew up during the first four or five years of the use of the label, and owed its growth in chief part to the business indicated by the label. In that respect the case is similar to that of the trade-mark Cocaine, *Burnett v. Phalon*, 3 *Keyes*, 394. In respect to the commercial article bearing the geographical name, it is similar to that of the Akron cement, *Newman v. Alwood*, 51 *New York*, 189. The right of the complainants in this case has the double strength of that of the proprietors of the trade-mark Cocaine, and of that of the Akron cement. The use of the principal characteristics of their trade-mark by manufacturers not conducting their business at Durham is a deception put upon the public, and may be enjoined on that ground alone, irrespectively of the trade-mark right.

4. The use of the trade-mark invented by Green under which he and his successors built up his trade, and built up the town of Durham, like the use of the word Akron to the proprietors of the commercial article bearing that name, belongs exclusively to the

successors of Green, and the Court should secure its exclusive use to them.

I have some doubt whether in a litigation between Blackwell & Co., on the one hand, and defendants not doing business in the town of Durham on the other, it was competent for the Court to decree that Blackwell & Co. have the exclusive right to the use of the word and symbol characterizing their trade-mark; but it is certainly competent for us to render a decree responsive to the issue made up by the allegations and denials of the bill and answer, one of which is this right of exclusive use claimed by Blackwell & Co. As between the complainants and defendants in this suit, therefore, we may so decree, even though other persons than the defendants to this record be not bound by the decree.

Judge BOND concurred in the decree, but is not responsible for every position taken in the opinion.

This trade-mark had been the subject of a previous suit in the Circuit of the Western District of Virginia. The following was the decision of Judge RIVES on similar questions to those decided as just reported by the Circuit Court of the Eastern District of Virginia.

United States Circuit Court, Western District of Virginia, at Lynchburg, March Term, 1872.

W. T. Blackwell and J. S. Carr, partners under the style of W. T. Blackwell v. L. L. Armistead. IN CHANCERY.

RIVES, J.:

The preliminary injunction in this case was founded on the statement in the bill. In pursuance of the notice required by statute, the defendant contested its allegations upon *ex parte* affidavits assailing the title of the plaintiffs. But in that incipient state of the proceedings it would not have been proper, if at all practicable, to pass upon the merits of their defence; and the only question there was, whether the case as presented by the bill and affected by this adverse testimony, was still such as to require this

stay, till the merits of the controversy could be developed by further pleading and testimony. The propriety of this interposition by the Court will scarcely be now questioned, as these further proceedings have shown the case to be one of perplexity and doubt.

The pleadings have now been perfected. The defendant's answer was duly filed, issue taken upon it, and the cause set down for final hearing. A vast volume of testimony has also been taken, some of it contradictory, and a vast deal of it irrelevant and impertinent. It is to be regretted that the zeal of counsel or the anxiety of parties should have so augmented the bulk of this testimony as to make a needlessly expensive record of it, and to devolve upon all engaged in its examination a wearisome amount of unprofitable reading. Still it is a subject of congratulation that the cause is now fully developed in all its aspects and bearings, and has been argued with a discriminating force and fulness of research alike masterly and instructive, and calculated to produce settled convictions one way or the other.

Our first task is to acquire accurate and precise ideas of the issues made by the pleadings. If this be done, and then the law be properly applied, it seems to me we can reach a safe conclusion almost without resorting to the voluminous testimony. The plaintiffs claim a trade-mark, designed in 1865 or '66, and continuously used ever since. It is exemplified and made a part of their bill. The descriptive terms are "Genuine Durham Smoking Tobacco," and the symbol or device is the side view of a Durham bull. They assert that this trade-mark has been violated by the defendant in using, under date of January, 1871, these terms; "The Durham Smoking Tobacco," and the symbol or device of "a bull's head," with a note of the sale to the defendant of Wright's patent for the manufacture of "Genuine Durham Smoking Tobacco." This latter trade-mark of the defendant is also *exemplified* in the bill and placed in juxtaposition and contrast with the plaintiffs' trade-mark.

The answer, while calling for full proof of the allegations of the bill, does not directly deny this statement, but rests the defence upon three chief grounds: 1. The prior use of this trade-mark by Wright (under whom the defendant claims) as far back as

1860. 2. That the defendant's trade-mark is not an infringement of the plaintiffs, but is wholly dissimilar; and 3. That the plaintiffs, by fraudulent representations in the premises, have deprived themselves of all equitable assistance.

The main contest is considered by all parties and the counsel in this case to rest on the *priority* in the use of this disputed trade-mark. The defendant does not pretend that Wright, under whom he claims, ever used the identical trade-mark set up by the plaintiffs. On the contrary, he takes especial pains to show that he placed no particular value on the term "Durham," which he now asserts belongs in common to his and plaintiff's brands. The discovery which he had made, and for which he seeks protection, was his preparation for a mode of treating smoking tobacco, so as to mitigate its noxious qualities and impart to it an agreeable flavor. This is the merit he claims; this the process he has patented. The testimony and the answer concur in proving that the whole merit of this smoking tobacco, and its celebrity, were due to the use of the flavoring he gave his tobacco. He was confessedly the first to commence its manufacture at Durham's Station. There was nothing in the locality he could have reasonably counted upon to commend his manufacture to the public. But, if we are to credit the defendant's answer and his testimony in this cause, it was his discovery of the flavoring compound on which he plumed himself. Accordingly, it was this which he emblazoned on his stencil plate. Take his own statement for the present, and what was his brand? "*Best Spanish Flavored Durham Smoking Tobacco.*" What, in view of the pleadings and evidence in this cause, is the characteristic, the vital element of this trade-mark? Manifestly, "*Best Spanish Flavored.*" That was the only conspicuous and discriminating element in the trade-mark. "Durham," if indeed a part of it, was, upon the defendants' own showing, subordinate and insignificant. Now, the plaintiffs concede in the fullest manner Wright's superior title to the use and brand of his flavoring compound, and disclaim in their process any infringement of it; nor does it appear that there has been any, nor, indeed, any formal complaint of it.

The pretension of the defendant, then, amounts to this; that because, in 1860, he branded his smoking tobacco "*Best Spanish*

Flavored Durham," wholly because of the mode in which he flavored it, no subsequent manufacturer of the article at Durham, without the use of his process, shall brand his as "Genuine Durham Smoking Tobacco" with a symbol which he never used. The reply is that, under the circumstance of his use of the name "Durham," there was nothing in it so descriptive as to restrain succeeding manufacturers at the same place from engrafting it on their brand, so long as they laid no claim to nor made any use of his "Best Spanish Flavored" compound, which he, indeed, appropriated by this first and original use of this only conspicuous term on his stencil plate in 1860-61. It must be remembered that Wright was only in the infancy of this manufacture at Durham, and that others followed and developed it till the plaintiffs instituted their brand in 1865 or 1866.

Conceding, then, all the defendant claims by virtue of his purchase from Wright, he fails, in my opinion, to rebut the plaintiffs' title by proving a brand as used by Wright previously, wherein "*Best Spanish Flavored*" was the distinguishing attribute, and "Durham," under the circumstances at that time, a mere unmeaning *incident*. Thus stands this point in the light of the pleadings alone, the allegation of the plaintiffs on the one hand, and the denials and defences of the defendant on the other.

The testimony as to the fact whether the term "Durham" was ever upon the stencil-plate of Morris & Wright is contradictory. But in my opinion it preponderates against the existence of that name in that brand. Counsel have adroitly insisted that the testimony against it is negative, and cannot from its nature, however commanding, overcome clear affirmative proofs. The proposition of law involved in the statement is correct; but the whole inquiry is into a fact, namely: What was the stencil used by Morris & Wright? Some, on the one hand, who had used it, declare with emphasis it was "*Morris & Wright's Best Spanish Flavored Smoking Tobacco*;" others, but namely, Wright and his two sons—the latter at the time but boys—stated it as "*Morris & Wright's Best Spanish Flavored Durham Tobacco*." The proofs, therefore, on both sides are equally affirmative. If, then, it be left in doubt, we must look to the probabilities of the case

to turn the scales. What motive could have existed with Wright, all whose reliance was upon the merits of his flavoring compound, to invoke the name of a small, thriftless station on a railroad, settled by only two or three families, with a store and this factory, to invoke its name to give celebrity to the *preparation* to which he solely looked for his reward! It seems to me extremely improbable, upon ordinary grounds of reason and human action, to suppose that he used "*Durham*" on his stencil at all. On comparing and weighing the testimony on both sides, I am constrained to admit the conclusion that he did not. Neither he nor his vendee, therefore, have any claim to contest, under this state of the evidence, the validity of the plaintiffs' trade-mark and their original and paramount title thereto.

It cannot be denied that it is abundantly proven in this cause, that the manufacture of Morris & Wright, and of those who succeeded them at Durham, was known, called, and distinguished in the market as "*Durham*" smoking tobacco. It is on this notorious fact in the cause that the able and ingenious argument has been raised, that the public, by its voice, may appropriate and consecrate to an individual, property in a designation by which he may choose to denote any product of his industry. But I can find no warrant for such proposition in the law of this subject. On the contrary, it is distinctly laid down by the authorities, that it is only the *actual use* of the mark, device, or symbol by the dealer which entitles him to it, and gives him the right to be protected in the enjoyment of it.

The doctrine on this subject has grown with commerce, and has assumed the form and title of a distinct body of law under the moulding hand of able Judges, who have sought in their decisions to establish its guiding principle, and of acute commentators and essayists, who have exerted the powers of a superior analysis and discrimination to extricate from doubt the true maxim of this beneficent code of business ethics.

So much of it as is necessary for our present inquiry is comprehended in a single proposition. It is the *seminal* principle of the whole doctrine. The simple statement of it is, that the dealer has *property* in his trade-mark.

5. This is allowed him because of the right which every man has to the rewards of his industry and the fruits of his discovery, and because of the wrong of permitting one man to use as his own that which belongs to another. In regard to the latter, it may be well said that any imitation of a trade-mark, calculated to deceive the unwary customer, differs from an absolute forgery, not in the nature, but rather in the extent of the injury. The dissimilarity to the expert wholesale dealer may be such as to save him from the imposition, but too slight, and that perhaps by design, to diminish sales to the incautious purchaser. But upon the success of fraud depends, ultimately, the extent of the injury. Let the spurious fabrication meet the same sale among private and individual consumers as the genuine article, and the wholesale dealer loses all motive for the exercise of his skill in detection, when he, perhaps, can reap better profits from the spurious, and therefore cheaper, than from the genuine article. In this way a simulated trade-mark may work the same mischief, and to the same extent as a forgery, defying detection at the hands of the *expert*.

With this view of the law I proceed to examine the *second* ground of defence; that the defendant has not infringed the trade-mark of the plaintiffs. That is scarcely the subject of argument. It must be referred to ocular examination and decision. Place the respective trade-marks side by side, contrast the labels, the words, and the devices, and each one's vision must determine for himself whether the imitation is such as to deceive the unpracticed and unwary customer. It matters not now, in the critical inspection of them, and aided by ingenious counsel, we can clearly discern differences between the two. The true question is, whether, taking the "*tout ensemble*," Armistead's trade-mark might not pass with the unwary for that of William L. Blackwell & Co.; and if that be so, the wrong is done, and the title of the latter to be protected by this Court is consummated. For my part, I do not see how trade-marks so similar could escape being confounded in the market. One reads "*Genuine Durham Smoking Tobacco*;" the other "*The Durham Smoking Tobacco*." This use of the definite article makes these phrases equivalent. To remove all

doubt, and aid the deception, in the note of the sale of the patent to Armistead, it reads, for "Genuine Durham Smoking Tobacco." Thus the language, to this extent, of the label is identical. Now, as to the symbols, or devices; one is the side view of the Durham bull; the other, that of his head, on a medallion. The one symbolizes, by a part, the name "*Durham*" as effectually as the other does by the whole. The color of the paper is also the same. Whether this simulation be the product of accident or design does not matter. It is the province of this Court to suppress it in either case. It is a little curious, however, to note that Wright's first label, at Liberty or in Bedford, was wholly different; and that after his son had seen plaintiffs' trade-mark in Kentucky, and after his return to his father, the present trade-mark, as transferred to the defendant, was adopted by Wright.

The third and last ground of defence is that the plaintiffs have forfeited their right to relief in this Court by reason of their false and fraudulent pretensions. This is upon the ancient and familiar principles that those who do iniquity must not ask nor expect equity. It is worthy of all acceptation, it is a hoary maxim, hallowed by its age, and unlike some other sacred antiquities, as yet unassailed by the spirit of change or reckless progress; I adhere to it. But the charges are serious and demand investigation.

The first is that the plaintiffs sent out business envelopes and business cards, giving the year 1860 as the date of the establishment of their enterprise. In the absence of explanation this might well impugn the *bona fides* of the plaintiffs, as in their bill they fix it no earlier than 1865. But was this statement by mistake or design? Have the plaintiffs failed to account for it? A junior member of the firm was examined, and showed how it all occurred *innocently*, and without intent to deceive. He ordered the printing and gave the date; soon after the packages were received and opened in the presence of Dr. Blackwell. The latter saw the error of date and corrected it; and the witness stated that he proceeded to correct the misdate by writing the figure (5) over the cipher in 1860, so as to make the date 1865, as corrected by Dr. Blackwell, but that some might have gone out before the correction. The exhibits made by the defendant of these envelopes

and cards corroborate rather than conflict with the witness. *That* should not be taken for *fraud* which is proved by an unimpeached witness to have been a mistake on his part. Besides there was no reasonable motive for such misrepresentation; the plaintiffs had nothing to gain by it, but much to lose, on the hypothesis of the counsel for the defendant.

The next is a charge of falsehood in representing that the label was secured by copyright. There is not a particle of proof to that effect. Argument and ridicule alone are relied upon to show the inapplicability and absurdity of a copyright for such a print. The language of the statute is certainly comprehensive enough to embrace a label of this kind. *Act of July 8th, 1870, sec. 86, United States Statute at Large, vol. 16, p. 212.* The object of such copyright is to secure to "the authors, inventors, or designer" of any such "print" the sole liberty of printing and vending the same. It forbids the surreptitious use and illegal sale of his labels. This is a perfectly legitimate resort to copyright in such a case and for such a purpose. It would, indeed, be absurd and ridiculous if the object were, as sarcastically portrayed by counsel, to protect the designer against the unlawful multiplication of such *ycleped* works of art. The dealer seeks merely by his copyright to keep the printing and vending of his labels in his own hands and under his control. It has been resorted to in other cases, as, for instance, the case of *Wolfe v. Goulard, Cox American Trade-Mark Cases, 227*, for the label of "*Schiedam Schnapps*." There is nothing unreasonable or incredible in this claim of the plaintiffs to a copyright for their label, nor is there anything in the testimony or the law to lead us to discredit it and brand it as a falsehood.

It seems to me, therefore, that both these charges are unfounded. They spring from the heat of forensic contests. They pertain to the polemics of the bar. Their effect is to provoke recrimination. Hence, the plaintiffs' counsel retaliate by imputing *falsehood* to the defendant in dating this purchase of Wright's the 1st of January, when he had stated in his answer he would not buy till he had ascertained his title by certificates, and those very certificates bore the subsequent date of the 6th of that month. The imputation seems plausible, but the transaction is susceptible of a more chari-

table construction, which I deem it my duty to put upon it. Dates are commonly immaterial, and often misapplied in business transactions. The main fact is doubtless correctly stated by the defendant, though he is made himself to confront it by a *mistaken* date.

I am glad therefore to have it in my power to state that there is nothing in this cause to affect the fair fame of the parties, plaintiff or defendant. They are doubtless respectable men, and enterprising manufacturers of tobacco in their respective communities. They are engaged, as I believe, in the honest pursuit of their rights as they respectively understand them. The defendant has acted on the information of another, under whom he claims. He has obeyed the order of this Court. The only thing that I have to regret is, that the same deference was not paid by another manufacturer; who, though no party to this suit, could not have been ignorant of it from his very relation to the defendant. But the plaintiffs have not chosen to bring him before this Court, save in proving his acts in the use of the simulated mark, notwithstanding the injunction upon his brother.'

I am sure the plaintiffs and defendant, as enterprising dealers, will find their ultimate interests subserved by the doctrine I have sought to expound and maintain as to their trade-marks. Whoever may now be the loser by it may soon have occasion to invoke it for his own protection, and they whose rights are now sustained, must learn thereby to respect those of other competitors in their business, at the same time that they take encouragement to themselves from their present success. All intelligent men engaged in manufactures and other enterprises must sooner or later become reconciled to losses in whatever quarter they may fall, that may be fairly viewed as penalties for the infraction, however unintentional, of laws well settled, designed, and calculated to vindicate the honor, advance the morals, and promote the interests of trade.

For these reasons I decree the perpetuation of the injunction, and order an account to be taken by a master, of the profits made by the defendant from his sales under the simulated trade-mark aforesaid.

11 Actien Gesellschaft Apollinaris Brunnen vs. Somborn.

11

UNITED STATES CIRCUIT COURT, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

ACTIEN GESELLSCHAFT APOLLINARIS BRUNNEN

vs.

JULIUS SOMBORN AND LAZARUS SOMBORN.

DECIDED 16 JANUARY, 1878.

REPORTED 14 BLACK., 380.

Apollinaris vs. Apollinis.

The use, on labels and bottles, of the word *Apollinis*, in connection with the representation of a bow and arrow or anchor, was restrained by preliminary injunction, on account of the similarity between them and the word *Apollinaris*, and the representation of an anchor, as before used by the plaintiff, as being calculated and designed to induce the supposition, by users and dealers, that the waters of the defendant, so marked, were the waters of the plaintiff; but the plaintiff was ordered to give a bond to pay all damages to the defendant, if it should be finally determined that the plaintiff was not entitled to the injunction.

Rowland Cox, for the plaintiff.

Edward T. Bartlett, for the defendants.

WHEELER, J.:

Upon the hearing of the motion of the orator for a preliminary injunction in this cause, it is considered, that the use, by the defendants, on their labels and bottles, of the word *Apollinis*, in connection with the representation of a bow and arrow, or anchor, as used by them, on account of the similarity between them and the word *Apollinaris* and the representation of an anchor, as before used by the orator, is calculated to lead those using and dealing in such waters, to suppose that the waters of the defendants so marked are the waters of the orator; and as there is no other reason apparent, but that the use of these symbols was adopted for that purpose, wherefore, it is ordered, that, upon the filing a bond to the defendants, in such penal sum as shall be fixed by the clerk, as a master of this Court, with good surety approved by him, conditioned for the payment of all damages to the defendants, in case it shall finally be determined, in this cause, that the orator is not entitled to this injunction, a writ of injunction do issue, to restrain the defendants from the further use of the word *Apollinis*, and such representations of an anchor, or bow and arrow in connection with the sale of their waters, until further order in the premises.

12

NEW YORK SUPREME COURT, FIRST DEPARTMENT. IN EQUITY. SPECIAL TERM.

ENOCH MORGAN'S SONS' COMPANY

vs.

SCHWACHOFER.

DECIDED JANUARY, 1878.

REPORTED 5 ABBOTT'S PR., NEW CASES, 265.

Sapolio vs. Saphia.

TRADE-MARK. COLORABLE IMITATION.

1. The doctrine of relief in equity, against infringement of trade-marks, rests upon the principle, that no one should be permitted so to dress his goods for sale, as to enable him to induce purchasers to believe that they are the goods of another.
2. To sustain an action in a State Court for an injunction against an infringement or imitation of trade-mark or labels, plaintiff, although his label contains a registered trade-mark, need not prove an imitation of that mark. It is enough if the general effect of the defendant's wrapper and label, constitute a wrongful imitation of those of plaintiff, although defendant may have replaced the symbol or "trade-mark," with a clearly different device.

3. It is quite difficult in actions of this character, to precisely draw the line between those cases in which the plaintiff is entitled to relief, and those in which relief should be denied. The decisions are conflicting and many of them irreconcilable.
4. Upon principle, no man should be allowed to sell his goods as the goods of another, nor should he be permitted to so dress his goods as to enable him to induce purchasers to believe that they are the goods of another.
5. In such cases the Court has power to interfere, and should exercise the power.
6. Courts will interfere where it is apparent that there is an imitation of plaintiff's label, whether as to color, shape, or inscription, which imitation is calculated and intended to deceive the general public.
7. Defendant enjoined from dressing his goods in wrappers so closely resembling the plaintiff's, as to enable him to deceive the public and perpetrate a fraud.

[*Note of Austin Abbott, to syllabus 1.* Earlier cases have sought for various theories in support of this branch of equity jurisprudence; some authorities put it on the basis of property in plaintiff violated by defendant, others on the basis of fraud and deceit actually committed to the injury of the plaintiff: others on damage to him by interference with his trade; and more still, on several of these elements: all, however, seeking for a guide in analogy to other classes of actions for injuries to property, or for fraud. In many cases, therefore, the Courts have laid down rules drawn from these analogies, which have limited in various incongruous ways, the relief that the Court might otherwise properly give. And much of the conflict in the cases arises from the inherent difficulty of limiting a branch of equity jurisdiction, which has its own peculiar necessity and natural limits, by rules which have their origin and propriety in the peculiar character of other branches. The elements of property and of fraud are usually involved, incidentally at least, and considerations of public policy have infused wholesome energy into the modern line of decisions on this subject.

The true basis of relief, however, and its just limits are found not in resorting to rules appropriate to other classes of cases, but

in application of the test announced in the case in the text. The gist of the cause of action is in the fact that defendant is sailing under false colors to the danger of plaintiff's legitimate trade. The extension of the principle beyond cases of trade-marks, in which it seems to have originated, to the protection of signs, labels, wrappers, colors, and the like, illustrate the true basis of the doctrine.

In Massachusetts, where the Court has been very cautious in granting relief, and has hesitated to extend the rule, the style and color of label have been recognized as proper subjects of protection beside what is usually understood as a "trade-mark."

In *Dixon v. Dixon* which has never been reported, the plaintiff's labels contained the following words:

"Stove Polish, Dixon's Prepared Carburet of Iron, Price 10 cents. Prepared from pure carburet of iron only by John Dixon & Co. black lead crucible manufacturers and practical chemists, Jersey City, N. J."

[Here followed recommendations].

One of the imitations by John Dixon and one Meyer had "John Dixon & Co's" instead of "Dixon's." Another had the words "Prepared from pure carburet of iron only by George M. Dixon, wholesale druggist, northwest corner of * * * * * and Main Streets, Cincinnati, Ohio," instead of corresponding clause in the genuine.

The decree by Bigelow, J., awarded a permanent injunction according to the prayer of the bill, protecting both the general style and color of package, contents of labels and trade cards. Defendants violated the injunction, and were convicted of a contempt in so doing by Hoar, J.

For other and more recent authorities, see *McLean v. Fleming*, *U. S. Supreme Court*, 18 *Alb. L. J.*, 38; *Colman v. Crump*, 70 *N. Y.*, 573; *Caswell v. Davis*, 58 *N. Y.*, 223, and cases cited; *Taylor v. Gillies*, 59 *N. Y.*, 331, and cases cited; *Talcott v. Moore*, 6 *Hun*, 106].

[*Note of Austin Abbott to syllabus 2.* So when one trader sells an unpatented production of his own in bottles or casks indelibly

marked with his known design, the Court will restrain a rival trader from selling a similar production in the same bottles or casks, although the rival trade puts a label of his own thereon. *Ch. Div. Appeals*, 1878; *Rose v. Loftus*, 38 *Law Times Rep.*, N. S., 435; *L. P. Singer Machine Manuf. Co. v. Wilson*, L. R., 3 *App. Cas. H. L.*, 376].

John Henry Hull and *Clarence A. Seward*, for the plaintiff.

J. H. Stanbrough and *J. Kugelmann*, for the defendant.

TRIAL BY THE COURT.

Enoch Morgan's Sons' Company, a manufacturing corporation formed under the laws of New York, sued John T. Schwachofer for an infringement of the trade-mark and labels, &c., of Sapolio, described in the complaint as consisting of a human face reflected in a polished pan; of the word "Sapolio;" of wrapping a cake of Sapolio in an argentine foil covered paper, so as to present a silvery surface to the outside of the package, and encircled by an ultramarine colored band of paper, of about half the width of the package, extending entirely around it, and printed in gold letters.

The defendants, under the name of the East River Chemical Works, had, for some time, been engaged in selling an article called Saphia, of substantially the same properties as Sapolio, and put up in a cake of very nearly the same size and shape, wrapped in similar argentine foil covered paper, and encircled in like manner with the plaintiff's article by an ultramarine colored band of paper, printed in gold, bearing upon one side the word "Saphia," or the "Queen's Brilliant," and on the other side the symbol of a woman's face, looking at an article held up in one hand.

The printing of the symbol and of the lettering upon "Saphia" was in gilt, and bore the same general resemblance to that of the plaintiff's "Sapolio," as would be presented by a cake of nearly the same dimensions, encircled in the same kind of silver paper and banded around by a blue colored paper band.

Other facts appear in the opinion.

An application for a preliminary injunction had been denied.

LAWRENCE, J.:

It is quite difficult, in actions of this character, to precisely draw the line between those cases in which the plaintiff is entitled to relief, and those in which relief should be denied. The decisions are conflicting, and many of them irreconcilable: but, in this case, after fully considering the evidence, I am of the opinion that the plaintiffs are entitled, to a portion, at least, of the relief which the complaint demands.

4th. Upon principle, no man should be allowed to sell his goods as the goods of another, nor should he be permitted so to dress his goods as to enable him to induce purchasers to believe that they are the goods of another.

In the consideration of this case, I shall lay out of view the United States Statute in relation to trade-marks, because that provides that "nothing in this chapter shall lessen, impeach or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if the provisions of this chapter had not been enacted." I do not, therefore, regard the plaintiffs as being compelled, in order to obtain the relief they seek in this action, to show that there has been an imitation of the trade-mark which the plaintiffs have filed in the patent office. See *Popham v. Wilcox*, 14 *Abb. Pr.*, N. S., 206.

It would seem that the true rule is laid down in the case of *Edleston v. Vick*, (23 *Eng. L. & Eq.*, 51, 53), where Vice-Chancellor Wood, adopting the language of Lord Langdale in *Croft v. Day*, (7 *Beav.*, 84, 87), says:

"That what is proper to be done in cases of this kind depends on the circumstances of each case. * * * * That for the accomplishment of a fraud in each case two circumstances are required—first, to mislead the public; and next, to preserve his own individuality." Commenting further upon the language of Lord Langdale in *Croft v. Day*, the Vice-Chancellor proceeds:

"Now, in that case of *Croft v. Day* there were, as Lord Langdale said, many distinctions between the two labels; and in this case before me, just as in that case of *Croft v. Day*, any one who takes upon himself to study the two labels, will find even more marks of distinction than were noticed in argument. But in this

case, as in that, there is the same general resemblance in color. Here there is the same combination of colors, pink and green; there is the same heading, 'Her Majesty's Letters-Patent' and 'solid-headed pins,' and the name 'D. F. Taylor,' with the words 'exclusively manufactured,' upon the two labels, which are of precisely the same size, and the scrolls in the same form, and 'exclusive patentee' in an exactly similar curved line. * * * * Nor does it rest only with the general resemblance of the outer wrappers; the papers in which the defendant's pins are stuck, bear also a great similarity; they are as like as can be to the papers in which the plaintiffs' pins are stuck.'" Then, after stating that he agrees that there must be an intent to deceive the public, the Vice-Chancellor holds that the defendants, both in the outer and inner wrappers, made a palpable imitation with the intent to deceive the public, and he accordingly restrained them. I have referred to this case at length because it seems to me to be particularly in point.

But there are several authorities in our own Courts which uphold the same doctrine. In *Williams v. Spence*, (25 *How. Pr.*, 367), Montell, J., says: "The only question to be determined, therefore, in this case, is whether the labels, devices and hand-bills used by the defendants, as set forth in the complaint, are calculated to and do deceive the public into the belief that the soap they are selling is the soap made and sold by the plaintiff. * * * * The oral evidence that the labels, devices and hand-bills used by the defendants are calculated to deceive the public also preponderates; and an inspection of the respective labels, devices and hand-bills satisfies me that the public would be readily deceived, and purchase the defendant's soap under the belief that they were purchasing the plaintiff's."

Lea v. Wolf, (13 *Abb. Pr.*, *N. S.*, 391), Mr. Justice Ingram says: "The color of the paper, the words used, and the general appearance of the labels when used, show an evident design to give a representation of those used by the plaintiff. * * * * It is impossible to adopt any conclusion other than that the intent was to have purchasers, from the general appearance of the article, to suppose that it was the original Worcestershire sauce which

they were buying." (See also, *Cook v. Starkweather*, 13 *Abb. Pr.*, N. S., 392).

And in *Lockwood v. Bostwick*; (2 *Daly*, 521), it was held "that a party will be restrained by injunction from using a label as a trade-mark, resembling an existing one in size, form, color, words, and symbols, though in many respects different, if it is apparent that the design of the imitation was to depart from the other sufficiently to constitute a difference when the two were compared, and yet not so much so, that the difference would be detected by an ordinary purchaser, unless his attention was particularly called to it, and he had a very perfect recollection of the other trade-mark."

And in *Kinney v. Basch*, (16 *Am. Law Reg.*, N. S., 597), Mr. Justice Van Brunt says:

"A careful inspection of the labels in question shows, beyond a doubt, that those of the defendant were adopted in order to deceive the public when they purchased the cigarettes of the defendant's manufacture."

I am satisfied from the evidence in this case that the intention of the defendant has been, from the first, to make an article as nearly as possible, resembling that manufactured by the plaintiffs, and to put it off upon the public as the same article. I am also satisfied that it was the intention of the defendant, in adopting the blue and tin-foil wrappers, and in printing on them the directions for use in language so closely resembling that employed by the plaintiffs, to impose upon the public, and to lead purchasers to believe that in purchasing the defendant's article, they were, in fact, obtaining the sapolio of the plaintiffs. In this connection the wonderful similarity of the color of the inside of the tin-foil wrapper, used by the defendant with that used by the plaintiffs, should not be forgotten.

The whole case, to my mind, shows an intention, on the part of the defendant, to avail himself of the reputation which the plaintiffs had acquired in the market for their sapolio, by their enterprise and ability, and by the large expenditures which they had made in bringing the sapolio to the attention of the public.

It appears that the plaintiffs have been for many years engaged in manufacturing sapolio; that the article has acquired a great reputation, and that the plaintiffs have expended very large sums of money in advertising. The evidence shows that the defendant, after analyzing a cake of sapolio, and ascertaining how it was made, set about making an article similar in character, color and appearance to that of the plaintiffs.

This he may possibly have a right to do; but when the Court finds that the defendant, after having possessed himself of the secret of the manufacture of the plaintiffs, has, in addition, coined a name much resembling sapolio, in appearance, and which he admits is a fancy name, having no particular derivation or signification, and has then proceeded to encase his cakes of saphia in wrappers also closely resembling the plaintiffs, both in their external and internal appearance, as to color, size, and partially as to inscription and directions for use, the Court has, in my judgment, the power to interfere, and should exercise its power.

It is claimed that the plaintiffs cannot have an exclusive right to use tin-foil or ultramarine blue colored paper, in putting up their article, as such paper is much used for ordinary commercial purposes.

6. This is true, but the cases cited show that the Courts will interfere where it is apparent that there is an imitation of the plaintiffs' label, whether as to colors, shape or inscription, which imitation is calculated and intended to deceive the general public. The evidence satisfies me that the blue wrapper, as used by the defendant, is calculated to deceive purchasers, and I think it is very clearly proven that the ordinary purchaser is deceived by the similarity of the dresses in which the soaps are put upon the market.

A critical and careful examination of the two packages will undoubtedly reveal distinctions and differences between the labels, and the devices thereon are different, but there is such a general resemblance that, to borrow the language of the Vice-Chancellor, in *Edelston v. Vick*, *supra*, "The Court or jury would be bound to presume that it was not a fortuitous concurrence of events which has pro-

duced this similarity; it would be irrational not to rest convinced that this remarkable coincidence of appearance, external and internal, is the result of design." In the case of *Abbott v. Bakers' and Confectioners' Tea Association*, (*Weekly Notes*, 1872, p. 31), an injunction had been issued restraining the defendants from issuing wrappers which were in imitation of those of the plaintiffs.

On appeal the Lord Chancellor said: "That though no one particular mark was exactly imitated, the combination was very similar, and likely to deceive. It was true that there was no proof that any one had been deceived, or that the plaintiffs had incurred any loss; but where the similarity is obvious, that was not of importance." The appeal was therefore dismissed, (*See case reported below; Weekly Notes*, 1871, p. 207). This last case seems decisive of the question now under consideration, (*See also Lockwood v. Bostwick*, 2 *Daly*, 521; *Godelot v. Hazard*, 49 *How. Pr.*, 10.

I am therefore of the opinion that the plaintiffs are entitled to an injunction restraining the defendant from vending saphia in the blue packages in which it is now sold. By this I do not mean to be understood as holding that the defendant has not the right to manufacture and also sell saphia, nor to restrain him from the use of that name, or of the figure or device upon the label.

7. But I do intend that he shall abstain from dressing his goods in wrappers so closely resembling the plaintiffs', as to enable him to deceive the public, and perpetuate a fraud. That he shall not sell Saphia as and for Sapolio. In other words, he must sell under his own colors, and not under those of the plaintiffs.

Judgment accordingly.

There was no appeal.

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CIRCUIT COURT UNITED STATES, NORTHERN
DISTRICT OF ILLINOIS. IN EQUITY.

SINGER MANUFACTURING CO.*vs.*NELS LARSEN.

DECIDED FEBRUARY, 1878.

REPORTED 8 BISS., 151.

Singer Sewing Machine Case.

1. EXPIRED PATENTS. Right to use of Name. If a sewing machine has acquired a name which designates a mechanism or a peculiar construction, parts of which are protected by patents, other persons, after the expiration of the patents, have the right to construct the machine and call it by that name, because the name only expresses the kind and quality of the machine.
2. TRADE-MARKS. There can be no trade-mark in the name "Singer Sewing Machine."
3. "SINGER SEWING MACHINE." While any one, not connected with the Singer Manufacturing Company, has the right to construct a "Singer Sewing Machine," yet he cannot be permitted to do any act, the necessary effect of which, will make people believe that the machine he constructs and sells, is manufactured by the Singer Manufacturing Company.

4. MODIFIED INJUNCTION. Requiring defendant to refrain from selling any Singer Sewing Machine, without indicating in some distinct manner, that said machines were not manufactured by the Singer Sewing Machine Company.

Wm. H. King, for complainant.

W. B. Scates, for defendant.

DRUMMOND, J.:

1. Under the evidence in this case, I think there can be no doubt that the plaintiff cannot claim the exclusive right to manufacture the "Singer Sewing Machine." All that it can claim is to make a machine of its own peculiar manufacture, with a device in the nature of a trade-mark. Otherwise, after a patent has expired which has established the nomenclature of a sewing machine, as the Howe patent, or the Wilson patent, the patentee might go on and have the benefit of the patent indefinitely.

On a machine called "The Singer Sewing Machine," there were various patents. Those patents have all expired, and nothing can, therefore, be claimed under them. Other persons cannot be prevented from manufacturing a machine like the Singer Sewing Machine, and which may be called, to distinguish it from other machines, "Singer's Sewing Machine." If a sewing machine has acquired a name which designates a mechanism or a peculiar construction, parts of which are protected by patents, other persons, after the expiration of the patents, have the right to construct the machine and call it by that name because that only expresses the kind and quality of the machine. I have read the reports of the case of *Singer's Manufacturing Company vs. Wilson*, originally decided by the Master of the Rolls in England, and afterwards on appeal, in the Chancery Division of the High Court of Justice, and again, on appeal from the latter Court to the House of Lords, and I do not think it is necessary to controvert the general rule there laid down—that there must be something to indicate that the thing manufactured is not the same as that of the complainant; in other words, to show it is not manufactured by the plaintiff. That is, it is a question of manufacturer, not of name. A person could not

claim a right to construct a peculiar form of barrel as to dimensions and capacity merely, irrespective of any marks or brands impressed upon it. That of itself could not be a lawful trade-mark. The same rule would be applicable to the construction of a wagon or carriage, which, owing to some peculiarity, might possess a particular name, as that of the original manufacturer. A man might construct a wagon or carriage precisely like it, and he would not be liable if he did not claim in some form that it was constructed by the manufacturer. The only principle upon which an action can be sustained under such circumstances, as I understand, is through a trade-mark. If there were a valid trade-mark called a "Singer machine," then there would be some force in the plaintiff's claim. Here the plaintiff and the defendant have a trade-mark somewhat similar, and if there is on the machine manufactured by the plaintiff, a valid trade-mark to indicate that it is of the plaintiff's manufacture, no one else ought to be permitted to put anything on his machine to show that it has been manufactured by the plaintiff; that is, to use the same trade-mark. It may be the defendant has made his machine to imitate the plaintiff's, and to induce people to believe that it is the same.

2. But as I have said, I do not think, under the circumstances of this case, there can be a trade-mark for the name "Singer's Sewing Machine."

An illustration is furnished in the opinion of the Lord Chancellor in the House of Lords in the case already referred to. A carriage called a "brougham" had been in very general use for many years. If that were devised by a man of the same name, so that, from its peculiarity of construction it was generally known by that name, it certainly cannot be claimed that the man who devised it, or his assignees, would have a sole right to construct a "brougham" for all time to come. If no patent existed upon it, or any of its parts, any one who has the requisite skill could construct just such a "brougham" as was originally constructed. There could, in such a case, be no trade-mark which the law would protect in the name "brougham;" and I therefore do not think that the opinion of the House of Lords

can be construed to mean what is claimed by the counsel of the plaintiff in this case.

3. So that, while I hold that the defendant is not prevented from constructing a "Singer Sewing Machine," still, he cannot be permitted to do any act, the necessary effect of which will be to imitate, or to make any one believe that the machine which he constructs and sells, is manufactured by the plaintiff.

4. Neither has he the right to use any device which may be properly considered a trade-mark, so as to induce the public to believe that his machine has been manufactured by the plaintiff; and, therefore, I shall modify the injunction in this case by simply requiring the defendant to refrain from selling any Singer Sewing Machines manufactured by any person or company other than the plaintiff, without indicating in some distinct manner that the said machines were not manufactured by the Singer Manufacturing Company.

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COURT OF COMMON PLEAS, NEW YORK CITY.

SPECIAL TERM. IN EQUITY.

ISAAC W. ENGLAND, as assignee for the benefit of the
creditors of FRANK LESLIE and FRANK LESLIE,
Plaintiffs.

vs.

THE NEW YORK PUBLISHING COMPANY of the City
of New York, HENRY LESLIE, and THE AMERICAN
NEWS COMPANY, Defendants.

DECIDED APRIL 16, 1878.

REPORTED 8 DALY, N. Y., 375.

Frank Leslie Case

1. A person may legally name himself, or change his name, or acquire a name by reputation, general usage and habit.
2. A person has a right to use his own name as a trade-mark to designate an article which he produces and sells, although another person of the same name, has previously produced and sold the like article with the same designation, and has made the use of the designation valuable.

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3. Where, however, the later use of the designation in such a case is made for the purpose of *leading* the public to believe that the articles so designated are those of the prior user of the designation, and thus depriving such prior user of his gains, the Court will restrain such dishonest use.
4. The test is, whether he used the name honestly and fairly in the ordinary prosecution of his business, or dishonestly to palm off his own commodity as the production of another.
5. The plaintiff's original name was Henry Carter, and the defendant, his eldest son, was born in England, and his name, as registered at birth, was also Henry Carter. Both came from England to this country, where the plaintiff assumed the name of Frank Leslie, and published various newspapers under title of which the words "Frank Leslie's" formed, in each instance, part. These publications became widely known, and their titles obtained a pecuniary value. The plaintiff also obtained an Act of the Legislature changing his name from Henry Carter to Frank Leslie; directed his son, the defendant, to take that name, and his son by that name was christened and married here. Afterward, the son, in obedience to his father's wishes, and under threats of disinheritance, assumed the name of Henry Leslie. By this name, while employed by his father, he signed receipts and became known to many acquaintances, but to his wife and many of his relations, he was still known as Frank. He had been further influenced to assume the name of Henry by being told that he was prohibited from using the name of Frank, by an order of Court. Upon learning that there was no such order, he resumed the name of Frank Leslie, and, in connection with others, incorporated under the name of the New York Publishing Company, commenced the publication of a serial, entitled "Frank Leslie, Junior's, Sporting and Dramatic Times." An injunction against this use by the defendants of the words "Frank Leslie," was asked for by the plaintiffs. **HELD:**

That such injunction should be denied.

MOTION FOR AN INJUNCTION.

The facts are stated in the opinion.

Francis C. Bowman, for the plaintiffs.

Thomas B. Browning, for defendants.

CHARLES P. DALY, Chief Judge.

This action is brought to restrain the defendants, the New York Publishing Company, from using the name "Frank Leslie" as

part of the title of a weekly journal published by them, entitled "Frank Leslie, Jr's, Sporting and Dramatic Times." The plaintiff, Frank Leslie, has for many years been the publisher of pictorial periodicals, which in the language of the complainant, "have become widely and favorably known," embracing, as weekly journals, "Frank Leslie's Illustrated News," "Frank Leslie's Illustriete Zeitung," "Frank Leslie's Journal," "Frank Leslie's Chimney Corner," "Frank Leslie's Boys' and Girls' Weekly," &c., &c., with others of like character published monthly, and two annually. These publications, it is alleged, have a large, extensive and profitable sale; and by the skill and ability of Frank Leslie, and the reputation which these publications have acquired, the use of his name has become of great value.

It is alleged that there is no person of the name of Frank Leslie, engaged in the publication of the defendant's journal, and that the use of that name as part of the title of it is to mislead the public into the purchase of it as one of Frank Leslie's publications, and divert them from purchasing those of the plaintiff, to the plaintiff's injury.

2. The defendant, The New York Publishing Company, is composed of three persons, incorporated under that name, one of whom is the eldest son of Frank Leslie, who claims that his name is also Frank Leslie, and that he has the right to use it with the suffix of junior attached to designate the journal, in the publication of which he is one of the proprietors. It is well settled, as a general proposition, that a person has the legal right to use his own name to designate an article produced and sold by him, although another person of the same name has previously manufactured and sold the like article with the same designation. (*Burgess v. Burgess*, 17 *Jur.*, 292; 22 *L. J. Chan.*, 275; 17 *Law & Eq. R.*, 257; *Meneely v. Meneely*, 1 *Hun*, 367; *Wolfe v. Burke*, 7 *Lans.*, 156; *Faber v. Faber*, 49 *Barb.*, 359; *Browne on Trade-Marks*, secs. 206, 423).

3. Where it is clear, however, upon the facts, that the one having the like name makes use of it as a trade-mark for the purpose of imposing his own articles upon purchasers for another article

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which has become known and well established, then it is alike an imposition upon the public and an attempt to secure for himself, by this dishonest means, what rightfully belongs to another; and where that is clearly shown to have been the object for which he is using the name as a trade-mark, he will be restrained thereafter from so using it. (*Stonebraker v. Stonebraker*, 33 *Md.*, 268; *Holloway v. Holloway*, 13 *Beav.*, 209; *Craft v. Day*, 7 *Id.*, 84; *Rodger v. Nowell*, 5 *Man., Gr. & Sct.*, 109.)

This is the law in respect to the rights of two parties who have the same name, and use it as a trade-mark to distinguish an article or commodity produced by them of the like character.

4. The fact that a man has used his own name to designate the article he produces, and that the name has become valuable to him through the article becoming extensively known, gives him no right to exclude any other man of the same name from affixing his name upon the same kind of article if he manufactures it. The test is whether he uses the name honestly and fairly in the ordinary prosecution of his business, or dishonestly to palm off his own commodity as the production of another. It remains then but to apply the law as thus stated to the facts of this case, there being no material conflict as to the facts.

5. The name of the plaintiff, Frank Leslie, was originally Henry Carter. His eldest son, one of the defendants, who was born in England in 1844, was called after his father, Henry Carter, and was registered by that name in England. After coming to this country the plaintiff assumed, in place of his former name of Henry Carter, the name of Frank Leslie. Under that name, at a *nom de plume* and title for his publications, he began to publish the serials referred to, and in 1857 his name was changed by an Act of the Legislature of this State to Frank Leslie.

When the defendant, who claims that his name is Frank Leslie, was a boy, his father told him that he was his eldest son, he wished him to be named after him, and accordingly directed him to take the name of Frank Leslie, which he did. This it may be inferred, the plaintiff did, as he had himself assumed the name of Frank Leslie, and it appears that the defendant thereafter called himself, and was known to others, by the name of Frank Leslie, Junior.

His father thereafter called him Frank; he signed his name as Frank Leslie, Junior, and letters—the envelopes of which were produced upon the motion—were addressed to him by his father in that name. In 1864 he was christened in the Episcopal Church at Elizabeth, New Jersey, by the name of Frank Leslie; and the following year, 1865, was married by that name in his father's presence. His statement is that from his boyhood he has been and is still known by his wife, by his mother, and by other relations, both in conversation and in correspondence, as Frank Leslie, Junior.

After his marriage he went to Chicago with intention of going into the publishing business there, and whilst there accepted a proposition from his father to conduct there the western edition of the latter's various publications. Whilst there, his father began to write to him as Frank H. Leslie; and, upon asking for an explanation of this change, he was informed by his father that he had rich relations in England who might leave him property in the name of Henry; but that, notwithstanding this, he still retained and continued to be known as Frank Leslie, Junior. After being a year in Chicago he returned to this city, where he was employed in his father's establishment, and some time about the year 1876 was told by his father that he must drop the name of Frank. He refused to do so, upon which his father threatened to disinherit him. A short time afterward a lawyer called upon him, and read to him what he was given to understand was an order of a Court, prohibiting him thereafter from using the name of Frank Leslie, Junior. It was not shown to him, nor was any copy of it given to him; and being, as he swears, inexperienced in legal matters, he supposed it to be a legal and valid order of Court, the prohibition of which was obligatory upon him, and he therefore assumed the name of Henry Leslie. Whether the paper so read to him was founded or not upon any legal proceeding has not been shown. The presumption is that it was not, as a search has been made in the Court from which it is alleged to have emanated, and no such order has been found. As the name of the lawyer who read this paper has been given by the defendant, and he is a well known member of the bar of this city, I must assume that if there

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was any legal proceeding enjoining the defendant from using the name of Frank Leslie, Junior, it would have been shown by the plaintiff.

Whilst in his father's employment thereafter the defendant audited bills and signed receipts in the name of Henry Leslie, and became known to many acquaintances by the name of Henry or Henry Leslie; but in his domestic intercourse with his wife, mother, and relations, he continued to be called and known as Frank Leslie, Junior.

In 1868 he commenced the publication of a pictorial journal, entitled "The Illustrated Dramatic and Sporting News," which was copyrighted, and entered by him as a copyrighted publication, under the name of Henry Leslie, which he testified that he did supposing that he was prohibited by the document before referred to from using his former name, and he swore that he would never have so entered the paper, or signed receipt, if he had been aware of the facts which he subsequently ascertained. This journal was of temporary duration. After it ceased, and before he commenced the publication of the one now sought to be retained, entitled "Frank Leslie, Junior's, Sporting and Dramatic Times," he saw the lawyers who had read to him the documents before referred to, and who told him that it was an injunction granted by Judge Garvin of the Superior Court; that it was foolish on the part of his father to do such a thing; that it amounted to nothing, and that the defendant had a *perfect right* to use the name of *Frank Leslie*, Junior. The defendant afterward saw Judge Garvin, who had no recollection of having signed any such order, and who doubted the fact of having done so; whereupon the defendant caused a search to be made in the clerk's office of the Superior Court, and no such order was found on file.

Having thus been informed by the lawyer who had read the document to him that it amounted to nothing, and that he had a right to the use of the name which he had abandoned, and no such order, after search made, having been found on the file of the Court, he resumed his name of Frank Leslie, Junior; and in the new journal published by him during the present month, in connection with the defendants who have formed the New York

Publishing Company, he gave that name as a part of the title of the new journal, calling it "Frank Leslie, Junior's, Sporting and Dramatic Times."

None of the facts above stated are contradicted, and there is little difficulty in applying to them the law, as before stated. In the first place, as respects the defendant's designation as Frank Leslie,* Junior, it is to be observed that the use of that name by him was not, in the first instance, his act, but a name taken by him when a boy, by the desire and direction of his father; nor can his subsequent abandonment of it and adoption, to a certain extent and in certain acts, of the name of Henry Leslie, be considered a voluntary act on his part, but one done under the impression that he was prohibited by what he was led to believe was a valid and legal order of Court, from using it thereafter. It was certainly not reprehensible for him to assume again the name by which he had been known from boyhood, by which he was christened and married,—when he had learned that there was no validity in nor foundation whatever for, the paper purporting to be an order of Court forbidding him to retain it.

1. I held, in *The Matter of Snook*, (2 Hilt, 566), that although the custom was universal for male persons to bear the name of their parents, there was nothing in the law prohibiting a man to take another name if he desired to do so; that there was no penalty or punishment for so doing, nor any consequence growing out of it, except so far as it might lead to the confounding of his identity; that if any such changes rarely occur, it was not only because there is an honorable pride in bearing the name of one's ancestors, but because it is scarcely in the power of a man to change his name, unless he goes to a place where he is unknown, for whilst he continues to abide where he is known, people will continue to call him by the name to which they are accustomed; and several adjudged cases were there cited, holding that a name might be acquired by reputation and by general usage and habit, and that where such had been the case it would be taken as the true Christian and surname of the party. In *Doe v. Yates*, (5 Barn. & Ald., 544), where an estate was devised with the condition that the devisee would procure his name to be altered

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to that of the testator, and the devisee having taken the testator's name by his voluntary act, without applying for the King's license to do so, and without an Act of Parliament, it was held that this was a sufficient compliance with the condition, and that the devisee was entitled to the estate.

What was said by Chief Justice Abbott in rendering judgment in that case may be cited for its direct bearing upon the present case. "A name," he said, "assumed by the voluntary act of a young man at his outset in life, adopted by all who know him, and by which he is constantly called, becomes for all purposes as much and effectually his name as if he had obtained an Act of Parliament to confer it upon him."

That the defendant had acquired the name of Frank Leslie, Junior, does not rest upon his testimony alone, but is established by evidence of the most satisfactory kind. His wife swears that she first made his acquaintance when he was at school, at the age of 16 years, at West Poultney, in Vermont, that she was then introduced to him by the name of Frank, and that before her marriage she saw letters directed to him by his father by the name of Frank Leslie, Junior; that for two years after her marriage his father addressed him by the name of Frank, but that afterwards, her husband having had a misunderstanding with Mrs. Squier, the present Mrs. Frank Leslie, she was requested by the plaintiff, Frank Leslie, to drop her name of Mrs. Frank Leslie, Junior, and her husband having afterwards told her that unless he gave up the name of Frank Leslie until he was either taken into business with his father, or deferred it until his father's death, he would be disinherited, she therefore called her husband Harry when in the presence of his father, but otherwise retained her married name of Mrs. Frank Leslie, Junior. Thomas F. Brady, who was for ten years employed by Frank Leslie, swears that during that time the defendant was addressed as Frank Leslie, Junior, and that he supposed that to be his name. Joseph K. Bright, who was formerly superintendent of Frank Leslie's engraving department, swears that he knew the defendant when he, the witness, was in his father's employment as Frank Leslie, Junior, and always understood that such was his name; and finally the defendant's

mother testifies that for the last *twenty years* she has always addressed him as Frank.

2. It is very clear upon this state of the facts that the defendant is entitled to call himself Frank Leslie, Junior, and that he has a right to use that name in the title of a journal published by him, as a co-proprietor with others. If the plaintiff has given a value to the name Frank Leslie by the many years that he has been associated with the serials published by him, that does not preclude the son from using the same name as the title of a journal published by him, unless it is designedly used in a way to deceive the public, and lead persons to purchase his paper under the impression that they are purchasing one of his father's publications. There is nothing in the case to warrant any such conclusion. The journal published by the defendants under the name of "Frank Leslie, Jr's, Sporting and Dramatic Times," is a publication devoted to a special class of subjects, and designed for a class of readers who take interest in such subjects. It does not appear that the plaintiff, Frank Leslie, publishes any journal of this description, or that he has ever published one of the kind; and the defendant's paper is not only distinguished from the publications of the father by this circumstance, but by the suffix of junior in the title, the plain import of which is that it is published by the son of the well-known proprietor of numerous pictorial publications, and which is true. There is neither fraud nor deception in such a publication. The defendant's name, from his boyhood upward, has been Frank Leslie, Junior; and if there has been any temporary departure from the use of it, it has been through the father's ineffectual efforts to get him to change it after he arrived at the age of twenty-three years. It may be and probably is, a pecuniary advantage to him to be able to make use of a name which has become widely known through his father's pictorial publications; but, being his name, he has the right to use it in the title of a journal of which he is a co-proprietor, and when the suffix of *junior* is attached to it in the title no one is deceived by it. The right of a son who has learned to manufacture a particular article in his father's service to affix his name to an article of the same kind when engaged in business for himself, is distinctly

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recognized in two of the cases that have been cited. (*Burgess v. Burgess, supra*, and *Meneely v. Meneely, supra*), however detrimental it might be to the father's business to have the same article manufactured and vended under the same name by the son. This case does not even go as far as this. It is not the production and sale of the same article. It is the publication of a newspaper different in its special character from those published by the plaintiff, and which by its title denotes that it is published, not by the father but by the son.

The motion for the injunction must therefore be denied.

Motion for injunction denied.

Royal Baking Powder Co. *vs.* Mason, *et al.*

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UNITED STATES CIRCUIT COURT, SOUTHERN
DISTRICT OF ILLINOIS. IN EQUITY.*

ROYAL BAKING POWDER COMPANY*vs.*

F H. MASON, ET AL.

DECIDED MAY, 1878.

Royal Baking Powder Case.

1. Plaintiffs by adoption and use of the term "Royal," connected with "Baking Powder," have acquired a right of property in the use of said word "Royal" as a trade-mark.
2. That defendants commenced the manufacture and vending of a leavening compound, to which they gave the name of "Royal Dry Hop Yeast," for the purpose of leavening bread, cake, or for other culinary purposes, and put up in boxes, cans and other packages, with the term aforesaid displayed thereon. HELD:

That the use of the word "Royal" by defendants, was and is a violation and infringement of the rights of complainants to the use of the word "Royal" in connection with leavening compounds.

* Not reported.

TREAT, J..

This action was brought to enjoin the defendants from using the word or term "Royal" in connection with a leavening compound called "Dry Hop Yeast," or any leavening compound with the word "Royal" attached thereto.

Now, on this day came the said complainants by Robinson, Knapp & Shutt, their solicitors, and the said defendants having appealed herein and filed their answer to the complainants' bill herein, and this cause being ready for hearing, and the same being heard by the Court upon the said bill, and exhibits, answer of the said defendants, and testimony submitted, and the Court having fully considered the same, doth find as follows:

That said complainants are a corporation, organized and acting under and by the authority of the laws of the State of New York, and that on or before the 23rd day of September, A. D., 1873, they were engaged in the manufacture of a Baking Powder, to be used for leavening bread and cake and other culinary purposes, and that long before said day they had adopted and used as a name for the article manufactured by them the word "Royal," and to which compound or Baking Powder they gave and affixed the name of the "Royal Baking Powder," and that they had adopted the said term or word "Royal" as their trade-mark; that before the adoption of said term "Royal" as a trade-mark by the complainants, no Baking Powder or other leavening compound had been manufactured or sold to which the name "Royal Baking Powder" had been given, or to which it had been in any way attached; that from long before the 23rd day of September, A. D., 1873, and up to the hearing hereof, said complainants have been continuously engaged in manufacturing at the city of New York, and selling in cans, boxes, and other packages, Baking Powders with their said trade-mark affixed thereto, and that ever since the adoption of said trade-mark by the complainants, Baking Powders of their manufacture have been well-known to the public throughout the United States by the name or trade-mark of "Royal Baking Powder," so that dealers in and consumers of Baking Powder well knew that the said term "Royal" prefixed to the words Baking Powders indicated that the article or compound to which said term

is or was given, or to which it was attached, was manufactured by the complainants, and under the said name was sold by them, all of which was well-known to the defendants, long prior to their infringement of the same, as hereinafter mentioned, as the trade-mark of the complainants.

1. The Court further finds, that by long and prior use of said term as their trade-mark aforesaid, the complainants have acquired a property in the use of the said word "Royal" as a trade-mark, and attached to and designating the compound aforesaid made by them, and having thus acquired the exclusive right to the use of the word or term "Royal" as a trade-mark in the manufacture of the said compound, on the 23rd day of September, A. D., 1873, the said complainants did deposit in the Patent Office of the United States at Washington for registration, their aforesaid trade-mark, and in all respects they complied with the laws of the United States, in such cases made and provided, and whereupon letters of protection issued out of said Patent Office to the said complainants for the use of the said word as their trade-mark, in the manufacture aforesaid, for the term of thirty years from the fourteenth day of October, A. D., 1873, unless sooner terminated in accordance with the laws of the United States.

2. The Court further finds that the defendants on or about the first day of September, A. D., 1876, at the district aforesaid, commenced the manufacture and vending of a leavening compound to which they gave the name of "Royal Dry Hop Yeast," and which compound was for the purpose of leavening bread cake, or other culinary purposes, and which compound in boxes, cans, and other packages, and with the term aforesaid displayed thereon, has been put upon the market for sale by said defendants, and all which use of said word or term "Royal" is and was a violation and infringement of the rights of the complainants to the use of the word "Royal" in connection with leavening compounds; that the use of said word or term by the defendants was not with the consent nor has been by the privity of the complainants.

Thereupon, and in consideration of the premises, the Court doth order, adjudge, and decree, that the complainants as against the defendants are entitled to the exclusive use of the term

“Royal” as their trade-mark, in the manufacture and sale of Baking Powders by the complainants, and that the defendants are not entitled in any manner to the use of the word “Royal” in connection with the compound manufactured and sold as aforesaid by the defendants.

It is therefore ordered and decreed, that the defendants, their servants and agents be perpetually enjoined and restrained from using the term or designation “Royal” in connection in any manner with the manufacture and sale by them of any leavening compound, and particularly the said compound known and called by them “Royal Dry Hop Yeast,” and also from selling any such compound with the word “Royal” attached thereto, except as obtained from the complainants or their agents or vendors; and it is further ordered that the complainants recover from the defendants their cost in this behalf expended, and that they have execution therefor.

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UNITED STATES CIRCUIT COURT, NORTHERN
DISTRICT OF ILLINOIS. IN EQUITY.

THE DAUSMAN AND DRUMMOND TOBACCO COMPANY*vs.*RUFFNER, ET AL.

DECIDED 8 JULY, 1878.

REPORTED 15 OFFICIAL GAZETTE, 559.

Cross-Bar Tobacco Case.

1. One of the principles running through the law of trade-marks, is that there need be no utility attached to the trade-mark itself; that is, it shall have no useful purpose in connection with the goods further than to show the origin or manufacture.
2. A registration trade-mark for plug-tobacco, consisting of one longitudinal line dividing the plug into equal parts, and a series of transverse lines crossing the plug at right angles with the longitudinal line, and at equal distances from each other, will not prevent the use of a trade-mark for tobacco, consisting of a series of seven Greek crosses stamped on the centre of the surface of the plug at equal distances from each other, and a series of half crosses on the margin opposite the full crosses, as guides for cutting the plug into pieces.
3. Every manufacturer has the right to indicate points or lines of division by marks upon his goods or packages.

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4. The Patent Office was of the opinion that both were allowable as applied to the same class of goods.

BLODGETT, J..

Complainant in this case seeks to enjoin defendants from using a trade-mark adopted by complainant, and registered in pursuance of the Act of Congress, to designate an article of plug chewing-tobacco manufactured by complainant. The complainant's proofs tend to show that it adopted the trade-mark in question in June or July, 1877, and applied it to designate a peculiar and superior quality of plug-tobacco; and on the 24th of August application was made to register said trade-mark, which registration was allowed and completed on the 20th of November. The trade-mark claimed is described in complainant's specification in the following terms:

"Said trade-mark consists of a series of lines or indentations arranged in a specific manner upon the plug tobacco manufactured by us. The lines composing the peculiar mark consist in one longitudinal line, extending the length of the plug, and dividing it into two equal parts, and a series of transverse lines running across the plug at right angles to the longitudinal line, arranged at equal distances from each other and dividing the plug into equal parts, transversely of the lump, as shown in the accompanying fac-simile."

No letters or names are combined with said lines to make the trade-mark claimed, but complainant alleges that soon after this style of plug was brought out and placed upon the market it received the designation from and is known in the trade as "Cross-Bar Tobacco." The mark used by the defendants to designate their tobacco is also registered pursuant to the Act of Congress, and consists of a series of seven Greek crosses stamped or impressed upon the centre of the surface of the plug at equal distances apart and a series of half crosses on the margin of the plug opposite each of the full crosses, "which lines are so stamped upon said tobacco as guides for cutting or dividing the plug into pieces of one ounce each." Much proof has been offered on the part of the defendants to show that complainant was not the first to adopt and use longitudinal and transverse lines upon manufactured goods for the purpose

of indicating the measured or equal portions into which the piece could be cut or separated, but I do not deem it necessary to analyze or consider all this testimony from the view I take of the case.

A mere ocular examination of the tobacco-plugs manufactured by complainant and defendants clearly shows that both parties have adopted their respective lines or marks for one purpose, and that is to enable the retailer to cut measured quantities from the plug. The defendants honestly and frankly admit that such is the purpose for which they placed their lines upon their plug-tobacco, namely, to enable the retailer to cut off the tobacco in ounce lumps or pieces.

1. The complainants evidently intend to accomplish the same purpose, although they do not say so in their specifications, because they provide for running the longitudinal line through the centre of the plug, and the cross-lines at equal distances from each other transversely across the plug, so as to divide it into equal parts. One of the principles running through the law of trade-marks is that there need be no utility attached to the trade-mark itself—that is, it shall have no useful purpose in connection with the goods further than to show the origin or manufacture. But in this case there is evidently a purpose in these lines by both parties, and that is to designate the manner in which the plug can be cut up for the purpose of retail, and the complainants in their specifications say:

“The number of transverse lines may be varied slightly, according to the size of the plug, without materially modifying our trade-mark, the general nature of which is a single longitudinal line running along the middle of the plug, with a series of transverse lines at equal distances from each other and crossing the longitudinal line at right angles.”

Now they may vary, of course, the number of cross-lines and their distances apart by the thickness of the plug. Having the plug thicker or thinner, the transverse lines might be farther apart or closer together, as may be required, in order to make the requisite quantity in each of these measured parts.

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2. And the question is, can the complainant, by registering these longitudinal and transverse lines as a trade-mark to designate its plug tobacco, prevent other manufacturers of plug tobacco from so making their plugs as to enable the retailer to cut it off in equal or measured quantities? And I am of opinion that complainant's trade-mark cannot be so constructed or applied as to prevent defendants from indicating by mark or lines upon their plugs the point at which to cut off equal or measured quantities.

3. Any manufacturer of goods which are sold by the piece, such as cloths, for instance, must have the right by marks or lines to indicate where to cut, in order to remove each yard, or part of a yard, or other specific quantity. So, in regard to liquids put up, for instance, in glass bottles or similar packages, lines might be drawn, showing the half or other portion of the contents of the package, so as to enable a consumer or retailer to withdraw measured parts, and no manufacturer by registering a trade-mark upon a package of that kind could prevent another manufacturer from thus showing how a measured portion of the contents of his package might be withdrawn.

4. The defendants' mark is not precisely like the complainant's, and it is obvious the Patent Office was of the opinion that both were allowable as applied to the same class of goods, for almost contemporaneously with the registry of complainant's trade-mark the Patent Office allowed the defendants to register their trade-mark, and, in fact, the registration of the defendants' mark was completed and the certificate issued before that of complainant's, so that it is clear the Patent Office took the view that one of these did not infringe upon the other.

The defendants' tobacco is known to the trade by another name or designation from that of the complainant. It is known and put upon the market as "Army and Navy plug tobacco," instead of "Cross-Bar Tobacco."

3. It was admitted by the complainant's counsel upon the argument that the complainant's trade-mark could not and should not be so construed as to prevent the defendants from marking their tobacco in some manner so as to indicate where to cut, in

order to remove a certain measured quantity, and it seems to me that in making this admission they practically admit away the case as against this defendant. The Greek cross, although it is the equivalent in every respect, so far as practical use is concerned, of the complainant's lines in their plug, yet, at the same time, as one has the right to show where to cut, so the other has, and my conclusion is that one manufacturer cannot, by registering straight lines intersecting each other as these do, prevent another from indicating to the consumers of his goods, where they must cut for certain quantities.

The motion for the injunction is, therefore, overruled.

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IN THE SUPREME COURT OF THE STATE OF
NEW YORK. SPECIAL TERM. IN EQUITY.

ROWLAND N. HAZARD AND JOHN C. HAZARD

vs.

JOHN R. CASWELL AND WILLIAM M. MASSEY.

DECIDED SEPTEMBER, 1878.

REPORTED 57 HOW. PRAC., 1.

“Established 1780” Case.

*Trade-mark. Injunction. When and how co-partnership name
may be continued by successors. Rights under.*

1. The words “Established 1780,” or “Established A. D. 1780,” which have been conspicuously displayed and used upon the signs, labels, bill-heads, &c., of a drug house for a great number of years, may strictly and rightly be denominated a trade-mark, and the right to the exclusive use of such words will be protected by a Court of Equity.
2. Where one partner retires from a firm, and the other members of the firm, with the consent of the retiring member, continue the business under the old firm-name, as they may do under the statute (*Laws of 1854, chapter 400*), they will be held to have succeeded to the business of the old firm.

3. As the right to use the words "Established 1780," or "Established A. D. 1780," when the partnership between the plaintiffs and the defendant ended, belonged to the business, it passed to the successors of the firm.
4. If the successor to the business of the manufacturer of one compound, or of one article, has a right to the continued and sole use of the name or mark by which the public recognizes its genuineness, so the successors in the business to those who placed upon the market many compounds, all marked and designated by certain well-known words, are entitled to the continued and sole use of such words which distinguished the preparations. And what is true in regard to articles manufactured by predecessors in business and continued by successors, is also true in regard to new compounds.
5. Where the facts showed that the plaintiffs took the legal statutory step to perpetuate the old business as its successors, and the defendant permitted them to carry it on as such under the old name, for two years; that the defendant sold to the plaintiffs the whole stock, building, signs, labels, &c., and in four formal and legible receipts, the defendant calls the plaintiffs "successors to the old firm." **HELD:**

That plaintiffs are in fact, the successors of the old firm, and entitled to use a combination of words which was the property thereof, because it designated and marked it as well and as clearly as its name did.

Application by plaintiffs for an injunction restraining the defendants from using upon their signs and labels, as druggists, the words "Established 1780."

Henry E. Howland, for plaintiffs.

John L. Hill, for defendants.

WESTBROOK, J.:

The plaintiffs, Rowland N. Hazard and John C. Hazard, are druggists and co-partners, carrying on business as such, under the name, style and firm of Caswell, Hazard & Co., at No. 132 Thames Street, in the city of Newport, State of Rhode Island, and also at the corner of Broadway and Twenty-Fourth Street, and at the corner of Sixth Avenue and Thirty-Ninth Street, in the city of New York. Prior to the 31st day of July, 1876, the business had been conducted by such plaintiffs in connection with

the defendant, John R. Caswell, on which day (see agreement for winding up partnership, and also the bill of sale of the Newport store,) the partnership of the three terminated. The business had been carried on by the three from the year 1872, and the plaintiffs owned twenty-three-thirtieths thereof, and the defendant Caswell seven-thirtieths.

2. From the 1st day of January, 1867, to July, 1872, the same firm-name had been used, and during that period the plaintiff, Rowland N. Hazard, the defendant John R. Caswell, and one Philip Caswell, Jr., were the members. In July, 1872, the said Philip Caswell, Jr., sold out his interest in the business to the plaintiff Rowland N. Hazard, and John C. Hazard became a member thereof, the firm-name remaining unchanged; and the business was continued under the old name and style of Caswell, Hazard & Co., pursuant to chapter 400 of the laws of 1854, entitled "An Act allowing the continued use of copartnership names in certain cases."

1. The business which was conducted by the plaintiffs and the defendant Caswell was a continuation of that which had been established at Newport in 1780 by one Charles Feke. This, I think, the papers in the cause fully establish, and for years prior to the withdrawal of the defendant John R. Caswell, the date of which was July 31, 1876, the words "Established 1780," or "Established A. D. 1780," had been conspicuously displayed upon the signs, bill-heads and labels of the firm. During the time of such display, the firm had been known by various names, but during all the time the defendant Caswell was connected with the business, which was from 1859 to 1876, he, in common with his partners, by a conspicuous display of the words upon the signs, labels, bill-heads, &c. of his firm, asserted and declared to the world that the business carried on had been established in the year 1780. This assertion, made continually during a period of seventeen years, the defendant Caswell is in no situation to controvert, and its truth, resting upon his own long-continued assertions, as well as upon the positive evidence of its entire accuracy, must, for the purposes of this motion, be assumed.

1. When the copartnership between the plaintiffs and the defendant Caswell ended, in 1876, it is evident that the right to use the words "Established 1780," or "Established A. D., 1780," belonged to the business, and passed to the successors of the firm. Used, as these words and figures were, to identify a drug house, and to give it character by its age, and such use, continued for many years, necessarily distinguishing it from any other, it is quite apparent, that the exclusive enjoyment of such use is as valuable, as a species of trade-mark, to the continuers of that business, as the exclusive enjoyment of a trade-mark upon a well-known article is valuable to the manufacturer thereof. Indeed, the reasons which protect the owner in the sole use of a name or mark upon a single article are especially applicable to the business of these plaintiffs who, if they do succeed to the old business, must compound and sell many articles which had been previously compounded and sold by their predecessors of the genuineness of which the public is to be assured by the use of the old declaration upon the labels. Those statements which appeared upon the packages containing the various preparations of the firm for many years, identified its goods, and each one, or rather each form of the statement (for both convey the same thought) can strictly and rightly be denominated a "trade-mark." Every argument sustaining the right to exclusively use a name or trade-mark to designate one manufactured article, may be used in this case with a force multiplied by the number of preparations which are continued to be put up by those who continue the old business.

4. If the successor to the business of the manufacturer of one compound or one article, has a right to the continued and sole use of the name or mark by which the public recognizes its genuineness, so the successors in business to those who placed upon the market many compounds, all marked and designated by certain well-known words, are entitled to the continued and sole use of such words which distinguish the preparations. And what is true in regard to articles manufactured by predecessors in business, and continued by successors, is also true in regard to new compounds. The fact that a business is a continuation of one

long established, when communicated to the public, is of actual value to its owners. In the case of a drug and medicine house, the formulas, receipts and prescriptions are not only preserved for the purpose of reproducing articles which have for years been compounded, but they are also the foundations from and by which new results are continually produced, and which may legitimately be regarded as the growth of the business of former years. As such new preparations have their origin from such old business and are really the enlargement thereof, why should not the owners of both the old and new compounds own and enjoy as property a combination of words, which not only designates their preparations and business, but which gives value to both, because they thus bear a mark which carries with it the reputation acquired during the years that are past. Very clearly, a man's name could not be used by another, without the consent of its owner, to impose upon the public, under that disguise, the business or goods of the latter as those of the former. A mark or a combination of words may be used to distinguish the owner's goods and business as well as his name, and when thus distinguished and known to the public, precisely the same arguments which entitle an individual to the use of his own name apply. No man may injure another's business and impose upon the public alike, by selling his own goods so disguised by the use of either the other's name or mark as to induce the buyer to believe they are those of the person whose name or mark they bear. The argument is as sound when applied to an entire business as it is when applied to a single article, as applicable to marks or combinations of words known by the public as indicating a particular article or business as to the owner's name, which only indicates and declares the same thing. The right of protection in the use of names or trade-marks rests, it seems to me, upon the same principle. The owner of either is entitled to its entire value and work in the reputation and character, it may give to any article offered to the public, or to any business conducted.

2. Either the name or mark, and the one just as much as the other, may distinguish an article or business, and the more

honored the name or mark is by public favor the more valuable it is to the owner of the article or business.

1. Entertaining these views, which seem to me very simple and clear, if the question before me was new, I should find no difficulty, in deciding that the successors in business to the old firm of Caswell, Hazard & Co., own, and are entitled to use, the words which distinguish both their general business and their specific preparations. Their right, however, so to do rests upon many cases. See among others, *The G. & H. Man. Co. agt. Hall*, 61 *N. Y.*, 232; *Sohier agt. Johnson*, 111 *Mass.*, 238; *Shipwright agt. Carpenter*, 19 *Weekly Rep.*, 599; *The Jos. Dixon Crucible Co. agt. Guggenheim*, 7 *Phila.*, 408.

2. The next question which this cause presents is, have the plaintiffs succeeded to the business of the old firm of Caswell, Hazard & Co.? A careful examination of the papers requires me to give to this interrogatory, also, an affirmative answer, for the following reasons:

First. The defendant, Caswell, retired from the firm on July 31st, 1876, and the present plaintiffs continued the business at the old places under the firm name of Caswell, Hazard & Co.

It was done under the statute before referred to (chapter 400 of the laws of 1854.) The use of that firm-name, and the continuation of the business by the plaintiffs, as its successors, has been uninterrupted and unquestioned. The right to use the firm-name depended upon the fact that it was a continuance of the old business, as the act clearly imports. Mr. Caswell, having for two years permitted the use of the firm name by the plaintiffs under the statute, upon the assumption that they were the successors to the business thereof, is in no condition now to gainsay it. There are times when a party must speak or be precluded from so doing. The act of the plaintiffs was undoubtedly known to him. Without question he allows them thus to carry on business and expend their money. Certainly, if Caswell is not entirely estopped from questioning the title of the plaintiffs as successors to the old firm, his long silence is very high evidence in construing the agreement of settlement and separation.

Second. By bill of sale, dated October 7th, 1876, which also fixes July 31st, 1876, as the date when his copartnership with plaintiffs ended, the defendant Caswell conveyed to the plaintiffs all his "right, title and interest in the stock in trade and property of every kind of the copartnership in Newport, in the county of Newport, in the State of Rhode Island, formerly carried on by the parties under the firm of Caswell, Hazard & Co., excepting only book accounts outstanding 31st day of July, A. D., 1876, to have and to hold the same to the said Rowland N. Hazard, and John C. Hazard, and their assigns forever."

3. The property thus conveyed, and which the plaintiffs "and their assigns" could have and hold "forever," included the signs upon the building containing the words "Established A. D., 1780," and the labels, bill heads, letter heads, &c., which contained similar language.

If it was not understood that the plaintiffs were to continue the old business, why was this property sold without any reservation whatever? It being so sold, it follows, at least so far as the Newport store and business are concerned, that the plaintiffs legitimately succeed to the old business by purchase, and, as that was a part and parcel of the general business of the firm, it affords also a very strong presumption that all the business was to be conducted by the plaintiffs as the successors of the old firm.

Third. By articles of agreement between the parties, dated October 7, 1876, and which, in the commencement thereof, are styled "agreement for winding up the co-partnership affairs of Rowland N. Hazard, John C. Hazard and John R. Caswell, which ended 31st July, 1876," the plaintiffs assume the lease of the Thirty-ninth street, (the Twenty-fourth street store they already had leased), and the fixtures in both are transferred to them. The agreement also declares: "The bottle moulds heretofore used by the co-partnership are to become the property of the Hazards for use in their business." If the plaintiffs did not succeed to the business why the transfer to them of signs, inscriptions and the modes of making them? Unless they were to be treated as successors these purchases, in part at least, were useless. No such thought could have been in the minds of either, for the moulds of

the bottles, which would indicate the continuance of the business by the plaintiffs, are declared to be "*for use in their business.*"

Fourth. In four receipts, three whereof are dated March 12, 1878, one for \$124.31 in full for Caswell's interest in the "labels bearing the firm name of Caswell, Hazard & Co., Caswell, Mack & Co., and Hazard and Caswell;" another for \$54.78 in full for his interest "in and to the apparatus, or utensils on hand:" another for \$115.39 for his property "in and to the bottles, excepting ginger ale bottles, bearing the firm name of Caswell, Hazard & Co., Caswell, Mack & Co., and Hazard and Caswell;" and one for \$6,678.49, dated February 23, 1878, in full for his share of, and interest in, "the stock of surgical implements and appliances, the plaintiffs are styled and called "*successors* to the old firm." The fact is not forgotten that Mr. Caswell says he signed the receipts carelessly without noticing the words quoted. Mr. R. N. Hazard, on the other hand, reports that Caswell read them carefully, and that the interlineation which occurs in one, "excepting ginger ale bottle," was made at Caswell's suggestion. The probabilities are against the evidence of Mr. Caswell on this point. It is hardly to be supposed any business man would sign four formal receipts, in which the words "*successors* to the old firm" are conspicuous, without observing them. He must, from all the facts, be assumed to know their contents, and knowing their contents, the meaning of these words were to him, as to every other business man, clear and unmistakable.

From the facts, then, that the plaintiffs took the legal statutory step to perpetuate the old business as its successors, and the defendant Caswell has permitted them to carry it on as such under the old name for two years; that the defendant Caswell sold to the plaintiffs the whole stock, building and stock at Newport, that he also sold to them the signs, labels, and bottle moulds of both New York stores, and that in four formal and legible receipts he calls the plaintiffs "*successors* to the old firm," the conclusion is irresistible that the plaintiffs are in fact the successors of the old firm and entitled to use a combination of words, which was the property thereof, because it designated and marked it as well and as clearly as its name did. Either of the facts enumerated might

not, perhaps (though this is not conceded), if it stood alone, be sufficient to justify the Court, at this stage of the cause, in granting the relief asked. Each one, however, is very strong, and taken together, their concurrent testimony is too clear to be overcome.

Having now shown that the words "Established 1780," or "Established A. D. 1780," fairly belongs to the plaintiffs as trade-marks to continue the manufacture of old articles or new, and as indicative of the fact that they succeeded to the good-will and reputation of a business long established, and that such term is in fact their sign and mark as distinguishing their business, it follows that they are entitled to the relief asked for. The defendants, in their new places of business, are not entitled to use a mark or sign which conveys an untruth, because it injures the plaintiffs and the public alike. No citation of authority on this point is necessary as the principle is so well understood as to be elementary.

The application of the plaintiffs for an injunction is granted. The form of the order, including the amount of the undertaking, will be settled on notice.

18

IN THE SUPREME COURT OF THE STATE OF
NEW YORK. IN EQUITY. SPECIAL TERM.

THE HURRICANE PATENT LANTERN COMPANY

vs.

EDWARD MILLER & CO. AND G. W. WOODWARD.

DECIDED SEPTEMBER, 1878.

REPORTED 56 HOW. PR., 234.

Hurricane Lantern Case.

TRADE-MARK. WHAT DOES NOT CONSTITUTE AN
INFRINGEMENT OF.

1. In a suit to restrain the use of trade-marks alleged to be simulated, if it appears by the testimony that the marks used by the defendants, though resembling those of the plaintiffs in some respects, have not deceived and are not likely to deceive the ordinary mass of purchasers paying the attention which such persons usually do in buying the article in question, an injunction will not be granted.
2. Where the alleged imitation by the defendants, of the plaintiffs' trade-mark consisted, among other things, in the directions for the use of the article, which directions were identical with those printed on the plaintiffs' label. **HELD:**

That this did not constitute an infringement of the plaintiffs' trade-mark.

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HELD, also,

That the words "Tempest," and "Hurricane," are not to be regarded as so similar as to warrant the conclusion that the public is liable to be misled into believing that the articles to which these words are applied are of the same manufacture.

Mr. Blanke, for plaintiffs.

Mr. Betts, for defendants.

LAWRENCE, J.:

A perusal of the testimony in this case has strengthened the impression which I formed upon the trial, that the defendants have done nothing which entitles the plaintiff to the injunction prayed for in the complaint.

1. The testimony establishes to my satisfaction that although the defendants intended to manufacture and place upon the market a lantern which should possess essentially the same features, as to quality and character, as the plaintiff's lantern, they have not been guilty of an infringement of any of the plaintiffs' rights. Nor can I find upon the evidence that in point of fact the public has been deceived, or is likely to be deceived, by the resemblance between the pictures of the lanterns respectively shown upon exhibits A and B, attached to the complaint. The language of the two exhibits is identical, but the plaintiffs cannot claim an exclusive right to the use of such language. They can have no copy-right in it.

If the resemblance between the pictures of the lanterns, shown upon exhibits A and B, had been so close and striking as to convince me that the defendants intended to perpetrate a fraud upon the public, and to represent their goods as those of the plaintiffs, the fact that the language of the circulars was identical would have been important.

2. But the pictures referred to are so dissimilar that they cannot, in my opinion, be mistaken as intended to represent the same article by any but the most careless observer. This case, therefore, falls within the principles laid down in *Falkinburgh agt. Lucy*, (*American Trade-Mark Cases*, pp. 459 and 460, and in the cases there cited).

3. In *Falkinburgh agt. Lucy*, as in this case, the alleged imitation by the defendant of the plaintiff's trade-mark consisted, among other things, in the directions for the use of the article, which directions were identical with those printed on the plaintiff's label, and yet it was held that this did not constitute an infringement of the plaintiff's trade-mark, (*See also, Tallcott agt. Moore*, 6 Hun, 106). I do not regard the words "tempest" and "hurricane" as so similar as to warrant the conclusion that the public is liable to be misled into believing that the lamps are of the same manufacture.

Such being my conclusion, it follows, under all the authorities, that the defendants have been guilty of no wrong of which the plaintiffs can complain, and that the plaintiffs are not entitled to the injunction which they seek, (*See Tallcott agt. Moore*, 6 Hun, 106; *Partridge agt. Menck*, 2 Sand. Ch., 622; *Same Case*, 2 Barb. Ch., 104, 105; *Snowden agt. Noah*, *Hopkins Ch.*, 347; and *American Grocer Pub. Assn. agt. Grocer Pub. Co.*, 51 How., 404.) There should, therefore, be judgment for the defendants.

Findings may be settled on five days notice.

19

IN THE UNITED STATES PATENT OFFICE.

SIMPSON*vs.*WRIGHT & BRO.

DECIDED 2 NOVEMBER, 1878.

REPORTED 15 OFFICIAL GAZETTE, 248.

MOTION TO REHEAR.

1. Where a trade-mark adopted and applied to an article by a firm is continued to be applied unopposed, to the same article after dissolution, by the remaining partner, the title thereto belongs to the latter against a former partner, who subsequently applies the mark to an article similar in appearance, but different in quality.
2. Proof having been adduced on this point in an interference proceeding and not considered, a rehearing granted for that purpose.

In the matter of the interference between the trade-mark application of T. J. Simpson and the certificate of registration, No. 4,982, granted to Frank Wright & Bro., July 31, 1877.

DOOLITTLE, *Acting Commissioner* .

The principal point in this motion to rehear was made orally at the time the hearing was had, and it is this, that the composition to which the trade-mark in dispute was attached by the firm of Wright & Simpson was not the same composition to which Wright continued to attach it after the dissolution of the partnership, and that Simpson alone continued to use the trade-mark applied to the same article made by the firm.

If this allegation is established by the proof, then there is little difficulty in solving the question as to the proper person entitled to registration ; for it is clear that if a trade-mark adopted by a firm is continued to be used by the surviving or remaining partner upon the same article after the dissolution of the firm, then the party so continuing to use it, unopposed, retains the lawful ownership of the mark, as he alone makes that particular article which the public has learned to distinguish by such mark. The use by another of that mark on an article, the same in appearance but different in quality, would be a fraud upon the first party and upon the public, and this use on the spurious article would vest no rightful title in the one so employing it.

As neither this point nor the proof upon it has been considered in any of the previous decisions, a rehearing will be allowed upon the matter before the Examiner of Interferences.

The case is re-opened for that purpose, and Wednesday, November 6, is fixed for the day of hearing.

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IN THE UNITED STATES CIRCUIT COURT, FOR
THE EASTERN DISTRICT OF WISCONSIN. IN
EQUITY.

B. LEIDERSDORF, ET AL.

vs.

J. G. FLINT.

DECIDED NOVEMBER, 1878.

REPORTED 8 BISSELL, 327.

TRADE-MARKS. CONSTITUTIONAL LAW.

1. The legislation by Congress upon the subject of trade-marks, of July 8, 1870, is unconstitutional.
2. It cannot be sustained under the powers to legislate, in favor of authors and inventors, nor under the power to regulate commerce.

Winfield Smith, for complainants.

Jenkins, Elliott and Winkler, for defendant.

DYER, J.:

This is a bill for an injunction to restrain an alleged infringement by defendant of complainants' trade-mark, used upon pack-

ages of tobacco and registered according to Act of Congress. Both complainant and defendant are citizens of Wisconsin, and the bill is based upon that provision of Section 4,942 Revised Statutes, which gives to the party aggrieved by the wrongful use of his trade-mark, a remedy by injunction, according to the course of equity, in any Court having jurisdiction over the person guilty of such wrongful use, and is filed upon the theory that this Court has jurisdiction to entertain such a bill, though both parties are citizens of the same State.

The bill is demurred to, on the ground that the Court has no jurisdiction, and the demurrer raises the question of the constitutional power of Congress to legislate upon the subject of trade-marks.

The question is of great importance, and appears to be new, since, with the exception of *Duwell v. Bohmer*, 10 *Chicago Legal News*, 356, we were referred upon the argument to no reported case in which it has been determined.

The statutory provisions relating to trade-marks are contained in Title 60, Revised Statutes, which is entitled "Patents, Trade-marks and Copyrights." They authorize the registration of trade-marks, impose restrictions upon such registration, and confer certain remedies for the protection of the rights of parties who have complied with the requirements of the statute. The remedies thus given are mentioned in Section 4,942, which provides that "any person who shall reproduce, counterfeit, copy or imitate any recorded trade-mark, and affix the same to goods of substantially the same descriptive properties and qualities as those referred to in the registration, shall be liable to an action on the case for damages for such wrongful use of such trade-mark, at the suit of the owner thereof; and the party aggrieved shall also have his remedy, according to the course of equity, to enjoin the wrongful use of his trade-mark, and to recover compensation therefor in any Court having jurisdiction over the person guilty of such wrongful use."

The only clause in the Constitution from which it can be well claimed Congress derives its power to legislate upon the subject, is Article 1, Section 8, Clause 8, which authorizes Congress "To promote the progress of science and the useful arts, by securing for

limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." If the power in question is given by this clause of the Constitution, then, inasmuch as by Section 629 of the Revised Statutes, the Circuit Courts are invested with original jurisdiction of all suits at law or in equity arising under the patent of copyright laws of the United States, and in view of the Act of Congress of March 3, 1875, which confers jurisdiction in all civil causes arising under any law of the United States, where the amount in dispute exceeds \$500, and of the provisions of Section 4,942, Revised Statutes, above referred to, there is ground for claiming that the Courts of the United States have jurisdiction in suits which involve the right to trade-marks without regard to the citizenship of parties.

But, in contending that the power to legislate upon the subject of trade-marks is derived from the constitutional provision before cited, it must be necessarily assumed that the maker of a trade-mark is an author or inventor, and that a trade-mark is a writing or discovery within the meaning of that clause.

1. Argument can hardly be needed to demonstrate that a law regulating trade-marks is not, in any just sense, a copyright law. The general meaning of the term copyright, is an author's exclusive right of property in the work which he produces. It includes the right of the citizen who is an author of any book or writing, any literary, dramatic or musical composition, any engraving, painting, drawing, map, chart or print, and of models or designs intended as works of art. It is something which appertains to authors who, by their writings and designs, promote the advancement of literature, science and the useful arts. An author by standard definition is "one who produces, creates or brings into being; the beginner, former, or first mover of anything; hence, the efficient cause of a thing. The term is appropriately applied to one who composes or writes a book or 'writing,' and in a more general sense to one whose occupation is to compose and write books" or writings.

So, too, invention implies originality. Originality, not mere mechanical dexterity, is the test of invention. *Blake v. Stafford*, 3 *Fisher*, 305. It is the "finding out, the contriving, the creat-

ing of something which did not exist, and not was known before, and which can be made useful and advantageous in the pursuits of life, or which can add to the enjoyments of mankind.'" *Conover v. Roach*, 4 *Fisher*, 16; *Ransom v. Mayor of New York*, 1 *Fisher*, 265. To entitle one to the character of an inventor, he must himself have conceived the idea embodied in his improvement. It must be the product of his own mind and genius. *Pitt v. Hall*, 2 *Blatchford*, 234.

The dissimilar characteristics of trade-marks, and copyrights, and inventions for which patents may be granted, have been pointed out or illustrated in various adjudicated cases. A trade-mark has been very well defined as one's commercial signature to his goods. It may consist of a name, symbol, figure, letter, form or device, if adopted and used by a manufacturer or merchant in order to designate the goods he manufactures or sells, to distinguish the same from those manufactured or sold by another, so that the goods may be known in the market as his, and to enable him to secure such profits as result from his reputation for skill, industry and fidelity. *McLean v. Fleming*, 6 *Otto*, 245; *Upton's Trade-Marks*, 9; *Taylor v. Carpenter*, 2 *Sandford's Chancery Reports*, 604.

The basis of a trade-mark right is primarily the encouragement of trade. As the Court, in discussing the subject, say in *Partidge v. Menck*, 2 *Barbour's Chancery R.*, 101, the question in such a case is not whether a person was the original inventor or proprietor of the article made by him and upon which he puts his trade-mark, nor whether the article made and sold by another under his trade-mark is an article of the same quality or value. But the Court proceeds upon the ground, that the complainant has a valuable interest in the good-will of his trade or business, and that having appropriated to himself a particular label or sign or trade-mark, indicating that the article is manufactured or sold by him or by his authority, or that he carries on his business at a particular place, he is entitled to protection against any other person who pirates upon the good will of his customers or of the patrons of his trade or business, by sailing under his flag without his authority or consent.

The name, word, mark, device, or symbol constituting a trade-mark may be devoid of novelty, originality, and of anything partaking of the nature of invention. As the Supreme Court say in *Canal Co. v. Clark*, 13 *Wallace*, 322, "undoubtedly words or devices may be adopted as trade-marks, which are not original inventions of him who adopts them. Property in a trade-mark, or rather in the use of a trade-mark or name, has very little analogy to that which exists in copyrights, or in patents for inventions. Words in common use, with some exceptions, may be adopted, if at the time of their adoption, they were not employed to designate the same, or like articles of production." So in *McLean v. Fleming*, 6 *Otto*, 245, it is said that trade-marks are not required to be new, and may not involve the least invention or skill in their application or discovery.

As is well shown by a writer who has with evident care collated the authorities on the subject, (*Vol. 7, Central Law Journal*, 143), the foundation of title to a trade-mark is priority of adoption and actual use in trade, and it neither in application nor discovery necessarily possesses the elements of originality, novelty or invention.

"The power given to Congress to promote the progress of science and useful arts, is restricted to the rights of *authors* and *inventors*, and further, their rights are only to be secured for a *limited time*." *Livingston v. Van Engen*, 9 *Johnson*, 566.

This limitation in time is imposed by the constitutional provision itself. But the right to a trade-mark is of common law origin, and as a common law right, it is limited only by the period of its use, and ceases only with its abandonment. Property in inventions and discoveries did not exist at common law, and for their protection we have to look wholly to the constitutional provision on the subject.

The consideration for which a grant is made by the public to the author of a new and useful invention, of an exclusive right, is the benefit resulting to the public from the invention. The consent of the inventor to make his invention known and available to others, and ultimately to give it to the public, constitutes the consideration for which he is entitled to receive protection

from the Government in the form of the grant of an exclusive right. *Curtis on Patents, preface.* Not so with trade-marks. For when the exclusive right to use a trade-mark terminates, no corresponding benefits result to the public. Its value is gone when it ceases to be exclusive and becomes the property of the public.

Mr. Browne, in his *Treatise on Trade-Marks*, says, p. 75: "The rights of inventors and authors, as long settled in Great Britain, were familiar to the framers of the Constitution," and, as *Mr. Justice Story* says: "It is doubtless to this knowledge of the common law and statutable rights of authors and inventors that we are to attribute the constitutional provision. It was beneficial to all parties that the national government should possess this power; to authors and inventors, because, otherwise, they would have been subjected to the varying laws and systems of the different States on this subject, which would impair, and might even destroy, the value of their rights; to the public, as it would promote the progress of science and the useful arts, and admit the people at large, after a short interval, to the full possession and enjoyment of all writings and inventions, without restraint. In short, the only boon which could be offered to inventors to disclose the secrets of their discoveries, would be the exclusive right and profit of them, as a monopoly, for a limited period."

A copyright is limited by time, a trade-mark is not. A copyright is limited territorily, but a trade-mark acknowledges no boundaries. They are unlike in their natures.

In every aspect suggested, and in other respects which might be suggested, it would seem that the analogy between property in the use of a trade-mark and a patent for an invention, and between a trade-mark right and a copyright fails. Property in a trade-mark exists independently of statute. It is otherwise with inventions and discoveries. As is said by the Court in *Rodgers, et al. v. Philp, et al.*, 1 *Official Gazette*, 31, they "are protected only in consequence of the constitutional provision on the subject, which does not apply to trade-marks."

Considering with care the important question involved, and not unmindful that the question, whether a law be void for repugnancy to the Constitution, or for want of constitutional authority to enact it, is at all times one of much delicacy. I am constrained to hold that legislation by Congress upon the subject of trade-marks, is not authorized, either by the letter or spirit of the constitutional provision from which such authority is sought to be deduced. The maker of a trade-mark is neither an author nor an inventor, and a trade-mark is neither a writing nor a discovery within the meaning and intent of the constitutional clause in question.

2. It may be added, that the constitutionality of the trade-mark statute cannot be sustained under the clause which gives to Congress the power to regulate commerce among the several States, nor, in my opinion, under any of the provisions of the Constitution which prescribe the legislative powers of Congress.

From these views, it follows that this Court is without jurisdiction to entertain the present controversy, which, as before stated, is between citizens of the same State.

Demurrer to bill sustained.

In this opinion Mr. Justice HARLAN, who sat at the hearing, concurred.

The principle laid down in this decision was affirmed by the Supreme Court of the United States in *The United States v. Steffens*, 10 Otto, 82.—[REPORTER.]

21

IN THE UNITED STATES PATENT OFFICE.

JULES E. CAIRE. APPEAL.

DECIDED 2 DECEMBER, 1878.

REPORTED 15 OFFICIAL GAZETTE, 248.

Black Swan Case.

1. It is not sufficient that traders may not be misled by the resemblance which a proposed trade-mark bears to another, but the distinction must be sufficient to prevent the deception of ordinary purchasers or consumers.
2. Where a trade-mark is calculated to mislead, even if no one has been actually deceived, an intention to deceive will be presumed.
3. The word "Swan," having been registered and applied to gin, the registration by another of the words "Black Swan," to be applied to same article, denied.

APPEAL from the decision of the Examiner of Trade-Marks in the matter of the application of Jules E. Caire for registration of a trade-mark, filed July 20, 1878.

DOOLITTLE, *Acting Commissioner*;

The applicant seeks to register, as a trade-mark, the words "Black Swan", appropriated to gin. These words are used in

connection with the figure of a swan, but the figure is not claimed as an essential part of the mark, and may be omitted.

1. The application has been rejected upon the word "Swan," registered as a trade-mark for the same article to another person in 1871. In the judgment of the Examiner, the prefix "Black" does not sufficiently distinguish applicant's proposed mark from that of the one previously registered, so as not "to be likely to deceive the public." (4939, *Revised Statutes*). Applicant insists that it is sufficiently distinctive not to deceive traders; but this is a construction of the statute far too narrow. It has been held that even if wholesale buyers are not misled, but retailers or consumers are, by the resemblance which one mark bears to another, the right of action exists. (*Clark v. Clark*, 25 Bar., 76; *Brooklyn White Lead Co. vs. Masury*, *Ibid*, 416.)

2. And it has also been held that if a mark is calculated to mislead, even if no one has actually been deceived, the Courts will presume the resemblance to be not accidental, but intentional, and for the purpose of deception, and for this purpose the whole trade-mark need not have been counterfeited. (*Amoskeag Manufacturing Co. v. Spear*, 2 Sandford S. C., 607; *Dixon Crucible Co. v. Gugenheim*, *Cox T. M. Cases*, 559.)

3. If in this case, the figure of a black swan was the essential part of the trade-mark, the resemblance would not be so great; but the fac-similes presented by the applicant do not show a black swan, nor does his statement or the declaration restrict him to the use of such a figure. The general public is likely to be deceived. Seeing the figure of the swan upon the goods of applicant, and knowing that there was such an article in the market as "Swan Gin," people could be very readily deceived by the proposed trade-mark, and a purchaser using ordinary caution would not necessarily be put upon his guard by the word "Black." An inquiry at a store for the "Swan Gin" would be properly answered by handing the customer the "Black Swan Gin."

The decision of the Examiner of Trade-Marks is affirmed.

22

UNITED STATES CIRCUIT COURT, NORTHERN
DISTRICT OF ILLINOIS. IN EQUITY.

CHARLES W. LEA, ET AL.

vs.

FRANK DEAKIN.

DECIDED JANUARY, 1879.

REPORTED 11 BISSELL, 23.

Worcestershire Sauce Case.

1. TRADE-MARKS. "Worcestershire Sauce" is a Generic Term. The term "Worcestershire Sauce," has become generic as applied to a certain kind of table sauce, and cannot be exclusively appropriated by the complainants, simply because they reside in Worcestershire, England.
2. RES JUDICATA. Former Decree in England. A decree rendered by the Master of the Rolls in England, refusing an injunction and dismissing a bill in equity to restrain the infringement of an alleged trademark, and which was not appealed from, is a complete bar to a suit brought in this country for the same purpose by the same complainants, against the agent of the defendant in the English suit.

Rogers & Appleton and Henry M. Collyer, for complainants.
Charles E. Pope and George C. Christian, for defendant.

DRUMMOND, J.:

1. This case has been ably and fully argued by the counsel of the respective parties, and as it has been pending for a long time, although I have not had, from other engagements, the opportunity of considering it so thoroughly as I could wish, I may state now the conclusions at which I have arrived, without going into any special detail of the reasons leading to such conclusions. The plaintiffs are, and have been for a long time, the manufacturers of what has been called "Worcestershire Sauce," in Worcestershire, England. It is at present, and has been for some time, known as "Lea & Perrin's Worcestershire Sauce." The defendant is a resident of Wisconsin, and has been in the habit of receiving from England a sauce somewhat similar to that of the plaintiffs which is called "Improved Worcestershire Sauce," prepared by Richard Millar & Co., of London. The defendant is their agent for the sale of this latter sauce in this part of the country. I think the proof establishes that there has long been known in the market a certain kind of sauce used for the table, on fish and meats of various kinds, as "Worcestershire Sauce;" that it is a sort of generic term given to this kind of sauce from the fact that it was originally manufactured in Worcestershire, England. It seems to have been manufactured also in other places, and the term "Worcestershire Sauce" seems to have been applied to that species of sauce. Under the circumstances, therefore, it can hardly be claimed that the plaintiffs, simply because they reside in Worcestershire, and manufacture a sauce which they call "Worcestershire Sauce," have the sole right to the application of the term to that species of sauce. I think that the proof also shows that the plaintiffs have been cognizant for many years of the fact that there was this kind of sauce manufactured to which the term was applied; that for many years they took no steps to prevent the parties from manufacturing the sauce; and that, therefore, there may be said to have been something in the nature of an acquiescence in the manufacture of the sauce.

2. The proof also shows that the plaintiffs filed a bill in Chancery in England against the principal of the defendant, Millar, of London, on the ground that he or his company were manufac-

turing the very species of sauce which is the subject of controversy in this case, asking for an injunction to restrain him from such manufacture, and from using the term "Worcestershire Sauce," they claiming that they had the right to it as a trade-mark, and that no one else could use it without their consent, and also asking for an accounting from the defendant. The case was heard by the Master of the Rolls, Sir George Jessel, and fully considered by him in 1876, and the injunction was refused and the bill dismissed. See *Sebastian on Trade-Marks*, 305; *Seton on Decrees*, 4th Ed., 242. There was no appeal from this decree; on the contrary, it seems to have been acquiesced in by the plaintiffs. I see nothing in the record to raise a doubt that the case was decided on its merits. I think, therefore, that case is a bar to the action of the plaintiffs. They brought the suit against Millar, the principal of the defendant in this case, on the very subject-matter of controversy here; they asked for an injunction for the same reasons that the injunction is asked here, and for substantially the same general relief. It was refused by the Master of the Rolls, and the bill dismissed. Deakin, the defendant here, has acted for Millar, the defendant in that case. It would be an anomaly if it were true that Millar could manufacture and sell his sauce in England, and at the same time Deakin, who sells it here, and obtains it from him, could be restrained here at the instance of the plaintiffs from selling it.

By agreement between the parties, and the order of the Court, many of the questions on the admissibility of evidence were submitted to the Master, and he made his report thereon to the Court, and exceptions have been taken to his report. It is unnecessary for me to consider these various exceptions. It is sufficient to say, I think, there is evidence in the case which ought to be admitted, and from which these conclusions can be deduced. The result will be, therefore, that the bill will be dismissed.

A name which has become generic in meaning, cannot be appropriated as a trade-mark. *Canal Company v. Clarke*, 13 Wall., 311, 323; *Thompson v. Winchester*, 19 Pick., 214; *Wolff v. Goulard*, 18 How. Pr., 64; *Sherwood v. Andrews*, 5 Am. Law

Reg., U. S., 591; *Candee v. Deere*, 54 *Ill.*, 439; *Singer Mfg. Co. v. Wilson*, *Law Rep.*, 2 *Ch. Div.*, 434; *Cocks v. Chandler*, *Law Rep.*, 11 *Eq.*, 446; *Ford v. Foster*, *Law Rep.*, 7 *Ch. Appeals*, 611; *Burke v. Cassin*, 45 *Cal.*, 467; *Burnett v. Phalon*, 9 *Bosw.*, 192; *Binninger vs. Wattles*, 28 *How. Pr.*, 206; *Singleton v. Botton*, 3 *Doug.*, 393; *Canham v. Jones*, 2 *Vesey & Beames*, 218. But see *Newman v. Alvord*, 49 *Barb.*, 588; *Congress Spring Co. v. High Rock Spring Co.*, 45 *New York*, 291; *Dunbar v. Glenn*, 42 *Wis.*, 118; *Witherspoon v. Currie*, *Law Rep.*, 5 *English and Irish Appeals*, 508.

There can be no trade-mark in the name "Singer Sewing Machine." *Singer Manuf'g Co. v. Larsen*, 8 *Bissell*, 151. The word "Parabola" used as the name of needles, not being descriptive of any peculiar quality of the needles, is a valid trade-mark. *Roberts v. Sheldon, Id.*, 398. So the term "Yankee," applied as the name or label upon soap, is a valid trade-mark. *Williams v. Adams, Id.*, 452.—[REPORTER.]

23

UNITED STATES CIRCUIT COURT, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

GILES F. FILLEY

*vs.*PERLEY A. CHILD.

DECIDED 4 JANUARY, 1879.

REPORTED 16 BLATCH., 376.

Charter Oak Case.

The plaintiff having acquiesced for a long time in the manufacture and sale by defendant, of cooking-stoves containing certain improvements patented by plaintiff, and to which the name "Charter Oak" had been applied as a trade-mark, and the patent having expired, defendant cannot be prevented from calling such stoves by the name of "Charter Oak," so long as he does not represent them as being made by the plaintiff, or induce others to believe that they are made by the plaintiff.

Mr. Samuel S. Boyd, for complainant.

Mr. Esek. Cowen, for defendant.

BLATCHFORD, J.:

1. The bill alleges that the plaintiff, in 1851, "conceived of applying" the name of "Charter Oak," as a trade-mark, to

cooking-stoves embodying certain improvements in their internal construction, which he had invented, for the purpose (1) of securing to himself more completely and exclusively the benefits to be derived from the manufacture and sale of such cooking-stoves, and (2) of giving to the same a particular name, to enable the general public and purchasers to distinguish the same from all other cooking-stoves.

It is not alleged in the bill that the plaintiff has ever applied the name "Charter Oak" to any other cooking-stove than the one embodying said improvements; nor that the cooking-stoves sold by the defendant, bearing upon them the name "Charter Oak," embodied said improvements; nor that the said improvements were patented to the plaintiffs. It is shown that said improvements were patented to the plaintiff June 14, 1853; that the patent was re-issued to him December 27, 1859, and that it was extended for seven years from the 14th of June, 1867. There is no evidence that any one prior to the plaintiff applied the name "Charter Oak" to a stove containing said improvements, and it is shown that all the stoves sold by the defendant have been stoves containing said improvements and having upon them the name "Charter Oak." The suit is not brought upon the patent for the violation thereof.

The bill alleges that the use of said trade-mark by the defendant "is intended and designed, and well calculated to deceive the public into the belief that the stove bearing it is the genuine stove" of the plaintiff, "since, by said name, 'Charter Oak' alone is the said stove bought, sold, and known." There is no evidence that any one buying one of such stoves as the defendant has so sold, would believe that he was buying a stove containing the improvements so patented to the plaintiff.

As the patent has expired, and the defendant has a right to sell cooking-stoves embodying the patented improvements, the sole question is, whether the defendant has a right to sell them with the name "Charter Oak" upon them. The evidence satisfactorily shows that the plaintiff, during the entire twenty-one years' duration of the patent, knew of and acquiesced in the manufacture and sale by M. L. Filley, and those under whom he claims,

of cooking-stoves containing the patented improvements, with the name "Charter Oak" upon them. M. L. Filley made the stoves now complained of. He has built up a business through such acquiescence in the manufacture and sale of such cooking-stoves with such name. Under such circumstances the plaintiff cannot, after his patent has expired, and when M. L. Filley has the right to make stoves containing said improvements, prevent him from calling them by the name of "Charter Oak," so long as he does not represent them as being made by the plaintiff, or induce others to believe that they are made by the plaintiff.

The bill is dismissed with costs.

24

SUPERIOR COURT OF NEW YORK.

ALEXIS GODILLOT, PLAINTIFF AND RESPONDENT

*vs.*EDWARD C. HAZARD, ET AL., DEFENDANTS AND
APPELLANTS.

DECIDED 6 JANUARY, 1879.

REPORTED 44 N. Y. SUP. CT., 427.

Julienne Case.

TRADE-MARKS. INJUNCTION.

1. Every manufacturer, and *every person for whom goods are manufactured*, has a right to distinguish the goods he manufactures *or sells*, by a peculiar mark or device, that they may be known as his in the market, and he is entitled to protection of the same, irrespective of the fact that similar goods are manufactured or sold by others. (See cases cited in opinion.)

HELD *also, by the Court below*, that this right extends to a vendor who merely sells, and has no direct relation to the manufacturers.

2. A trade-mark may consist of anything not already appropriated; marks, forms, symbols, which designate the true origin or ownership of the article; this, although the words adopted are in common use. It cannot

however, consist of anything which merely denotes the name or quality. There can be no right to the use of mere generic words.

3. The language of Lord Justice Gifford, in *Lee v. Haly*, (39 *Law Journal*, 380), approved: "the principle upon which the cases go, is not that there is a property in the word, but that it is a *fraud* upon a person who has established a trade," &c., &c.
4. HELD, in this case, that the injunction sought to be obtained in the action, should be granted.

Before CURTIS, Ch. J., SEDGWICK and FREEDMAN, JJ.

APPEAL by defendant from judgment enjoining him from using a certain trade-mark, &c.

The action was tried before the Hon. CLAUDIUS L. MONELL, at a Special Term, April, 1875.

The complaint alleged that the plaintiff, for more than three years, had been engaged in putting up in packages of about one pound each, and importing, an article known as "Julienne," compounded of various vegetables, for making Julienne soup, upon which package he had placed a label or trade-mark devised by him, a copy of which is annexed to the complaint.

The device consists of the words "Conserves Alimentaires," under which is the coat-of-arms of the city of Paris; upon either side of the monogram a "C" in a circle, and underneath the words "Paris" and "Julienne," with directions for preparing for use and using.

The device adopted by the defendants is in all respects like the plaintiff's device, except the monogram is "F. G." In size, type, color and appearance, the two devices are entirely alike.

The answer alleged that "Julienne" was a generic name, and the mixture of vegetables used in making Julienne soup was prepared and imported into the United States long prior to its being put up and imported by the plaintiff, and was previously well-known to the general public by the name of "Julienne."

Upon the pleading and affidavits, a motion was made and granted to dissolve the preliminary injunction, but no appeal was taken.

On the trial the plaintiff testified that the article was put up for him in Paris, and that it has not before been prepared or put up

in the same manner. There was evidence on the part of the defendants that the article known as "Julienne" was prepared and put up by several other manufacturers in France, and was imported into this country.

One of the defendants testified that the defendant caused the label they used to be printed in Paris by their agent, having previously seen the plaintiff's label on packages of the "Julienne" they had purchased from him.

The Court found the fact that the plaintiff first adopted, and uses the label claimed as his trade-mark, that the defendants' label was calculated to deceive the customers of the plaintiff to his damage.

The following opinion was delivered at special term:

MONELL, Ch. J.:

The case made by the evidence upon the trial of this action so far varies it from the case presented upon the motion to vacate the injunction, that I am not embarrassed by the decision then made.

It now appears that the article sold by the plaintiff was prepared and put up for him in Paris by the firm of Hollier and Co., and although there is evidence that a similar article, designated "Julienne," is prepared and put up at other establishments in France, yet it is clearly established that the "Julienne" imported and sold by the plaintiff is prepared and put up expressly for him.

It is not, therefore, in my opinion, material whether other manufacturers prepare the same article in the same manner and of the same material, or that it is imported into the United States and sold by other persons.

There is no such property in the secret of manufacture that it can be protected; any one may prepare "Julienne" of the same ingredients that enter into the composition of the plaintiff's article, and he may designate it "Julienne," and sell it as such. The property and right to protection is in the device or symbol which is invented and adopted to designate the goods to be sold, and not in the article which is manufactured and sold.

1. The right to protection is not exclusively in the manufacturer. The persons for whom the goods are manufactured, (*Amoskeag Mfg Co. v. Spear*, 2 *Sanaf.*, 599; *Walton v. Crawley*, 3 *Blatchf.*, 440) and the vendor who sells and who may have no direct relation to the manufacturer, has such right. (*Partridge v. Menck*, 2 *Barb. Ch.*, 103; *Taylor v. Carpenter*, 2 *Sandf. Ch.*, 614).

Even, therefore, assuming that the article imported by the plaintiff is an article of common manufacture in France, and is imported generally into this country, and sold under the name of "Julienne," that does not deprive the plaintiff of his property in the device which he has invented as a trade-mark, and which he has put upon the packages, for the purpose of designating the article he sells.

In *Amoskeag Manufacturing Company v. Spear*, (*supra*), the learned Judge Duer says, (p. 605):—

"Every manufacturer and every merchant for whom goods are manufactured has an unquestionable right to distinguish the goods he manufactures or sells by a peculiar mark or device, in order that they may be known as his in the market;" and in *Partridge v. Menck*, (*supra*), the Chancellor says, (p. 103): "The question is not whether the complainant was the original inventor or proprietor of the article made by him, and upon which he now puts his trade-mark, nor whether the article made and sold by the defendant is of the same quality and value." And Beardsley, J., says, in *Tyler v. Carpenter*, (*supra*): "It is immaterial that the complainants were not admitted to be the manufacturers of the article. It was conceded that they were the vendors, and engaged in the sale of it." In *Lee v. Haley*, (39 *Law Jour.*, 284), the plaintiffs were dealers in coal—a natural product, in the general reach of all dealers. Yet the Court protected the goodwill of a business represented by a particular style of address.

It sufficiently appears from the evidence that the plaintiff is in a position to entitle him to adopt a trade-mark to designate the goods in question. They were manufactured exclusively for him, and, within the authorities I have cited, he, as the vendor, had a right to establish a reputation for the quality of the article he sold,

and perpetuate it by a device which would denote its origin and ownership.

If he has done so, he should be protected in its exclusive use.

2. A trade-mark may consist of anything, marks, forms, symbols, which designate the true origin or ownership of the article. It cannot consist of anything which merely denotes the name or quality.

There can be no right to the use of mere generic words. Hence, "Julienne," designating the manufactured article, does not denote origin or ownership, and like "Schnapps," (*Wolfe v. Goulard*, 18 How. Pr., 64), and "Club House Gin," (*Corwin v. Daly*, 7 Bosw., 222), it is a word used merely to designate the article or its quality.

The words "Conserves Alimentaire," which are alike applicable to every description of preserved or dessicated food, do not relate exclusively to the name or the quality of any particular preparation, and are, therefore, the subject of an exclusive appropriation in connection with words which did not denote the name or quality, and in that sense they may be regarded as designating the true origin or ownership of the manufacturers.

The adoption of words in common use as a trade-mark was sanctioned in *Matsell v. Flanagan*, (2 Abb. N. S., 459), where the "United States Police Gazette" was held to be an infringement of the plaintiff's right to the use of the "National Police Gazette;" and in *Messerole v. Lynberg*, (4 Id., 410), the word "Bismark," as a trade-mark for a particular description of paper collars, was protected; and in *Newman v. Alword*, (49 Barb., 588), a stronger case, "Akron Cement," which was the name of the place where the cement was made, was brought within the class of words entitled to be appropriated as a trade-mark. These several cases are approved in *Rillet v. Carrier*, (11 Abb. N. S., 186), where the manufacture of a syrup from the juice of the pomegranate was called "Grenadine" and "Grenade Syrup." In that case it appeared that "Grenade" was a French word signifying pomegranate, and that "Grenade Syrup" was sold in France under that name. It was, however, held that the plaintiff,

by the adoption of the words, has acquired a property in their use which the Courts would protect.

Again, the copy of the coat-of-arms of the City of Paris, when in connection or combination with other marks, words or devices, not denoting name or quality, will cover a property in it which will prevent its use in the same connection or combination by another person.

In this case, however, none of the words or devices are isolated or disconnected from each other. They form in combination a whole, supplemented by the plaintiff's monogram, together, as is claimed, constitute his trade-mark.

It is not necessary in this case to designate any particular words or symbols as constituting the plaintiff's trade-mark; although I am of opinion that the words "Conserves Alimentaires" on the coat-of-arms of the City of Paris as a symbol, could, if it was necessary, be separately regarded as such; but the combination of all the words and symbols, which the plaintiff has put upon his label, entitles him to be protected against the appropriation and use of such combination by the defendant.

It has now come to be well settled, that the adoption of any words or device not already in use, and not denoting the name or quality of the article, will constitute a trade-mark; and they so far become property that the Courts will protect the owner against any usurpation or interference; and for the well-grounded reason that a person who, by his skill and industry, has acquired a good reputation for the commodity he manufactures or sells, ought to be allowed to reap the fruits of it. This is forcibly illustrated in *Williams v. Johnson*, (2 *Borw.*, 1), when the trade-mark was "Genuine Yankee Soap," words of common use, but as they did not denote the name or quality of the manufacture, the plaintiff's property in them was fully sustained.

Independently of this, the label, as a whole, is entitled to protection. The Courts have gone to the extent of bringing within its protection not the trade-mark alone, but the packages, cases, and handbills. (*Williams v. Spence*, 25 *How. Pr.*, 366).

In *Cook v. Starkweather*, (13 *Abb. N. S.*, 392), the Court held that the package, case, or vessel, in which the commodity is put,

is prepared in a peculiar or novel manner, constituted it so much a part of the trade-mark as to entitle it to participate in the protection which would be given to the trade-mark itself.

Upon the whole case, therefore, I am satisfied that the plaintiff has such property in the label he has adopted, to designate the goods he offers for sale, that he should be protected in its exclusive use. He has, through his skill and industry, gained a reputation in the community for the excellence of the article he imports, and he ought to be permitted to reap the profits of it.

I am led to my conclusion in this case the more readily for the reason that I can find no excuse or justification for the defendant's acts. One of them testified that they had frequently purchased packages of the plaintiff's "Julienne," and had sent to Paris directions to have their label prepared. It was prepared in all respects like the plaintiff's, except the insignificant change in the monogram.

That it was a willful invasion of the plaintiff's rights there can be no possible doubt. The defendants were at liberty to manufacture "Julienne," or to have it manufactured for them, of the same materials and in the same manner, and to import and sell it in this market under the same name, and the plaintiff would have had no legal cause of complaint. With that undisputed right they were not content, but they meant to also trade upon the plaintiff's reputation, and profit by it.

3. In *Lee v. Haley*, (*ubi supra*), Lord Justice Gifford says: "The principle upon which the cases go is not that there is property in the word, but that it is a *fraud* upon a person who has established a trade, and carries it on under a given name, that some other person should assume the same name." And the Chancellor in *Partridge v. Meuck*, (*ubi supra*), also says: "That, having appropriated to himself a particular label or sign, or trade-mark, indicating to those who wish to give him their patronage, that the article is manufactured or sold by him or by his authority, or that he carries on his business at a particular place, he is entitled to protection against any person who attempts to pirate upon the good-will of the complainant's friends or customers, or of the

patrons of his trade or business, by sailing under his flag without his authority or consent."

And, again, in *Rillet v. Carlier* (*ubi supra*), Mr. Justice Pratt says: "The defendants can have no possible motive in using these words (Grenade Syrup), except to avail themselves of the reputation the plaintiff's article has gained under this name."

4. The plaintiff must have judgment perpetually, enjoining the defendants from using the trade-mark, with costs.

Hugh Porter, attorney, and of counsel, for appellant,—Cited . *Newman v. Alvord*, 51 N. Y., 189; *Amoskeag Manufacturing Co. v. Spear*, 2 Sandf., 599; *Partridge v. Meuck*, 2 Barb. Ch., 101; *Lemion v. Gauton*, 2 E. D. Smith, 343; *Wolfe v. Barnett*, 24 La. Am., 97; *Del. and Hudson Canal Co. v. Wallace*, 13 Wall., 311, (U. S. Supreme Court, 1871); *Ferguson v. Davol Mills*, 2 Brew., 314, and *Cox Am. Trade-Mark Cases*, 516; *Carmichal v. Latimer*, 5 N. Y. Weekly Dig., 46; *Osgood v. Allen*, 1 Holmes, 185; *Congress and Empire Spring Co. v. High Rock Congress Spring Co.*, 45 N. Y., 291; *Dixon Crucible Co. v. Guggenheim*, 2 Brews., 321; *Upton Trade-Marks*, 25-30; *Leather Cloth Co. v. Am. Leather Cloth Co.*, 11 H. Ld. Cas., 523; *Pidden v. Howe*, 8 Sim., 477; *Partridge v. Meuck*, 1 How. App. Cas., 547; *Wolfe v. Burke*, 56 N. Y., 115; *Palmer v. Harris*, 60 Penn., 156; *Hobbs v. Francis*, 19 How. Pr., 567; *Fetridge v. Wells*, 4 Abb. Pr., 144.

Nelson Smith & Leavitt, attorneys, and *Nelson Smith*, of counsel, for respondent,—Cited: *Amoskeag Manufacturing Co. v. Spear*, 2 Sandf., 599; *Walton v. Crawley*, 3 Blatchf., 440; *Taylor v. Carpenter*, 2 Sandf. Ch., 603, 614; *Same v. Same*, 11 Paige, 292; *Wotherspon v. Currie*, L. R., 5 H. L., 508; *Partridge v. Meuck*, *Cox Am. Trade-Mark Cas.*, 72; [This reporter gives the case as decided by V. Ch. Sanford, Ch. Wolworth, and the Court of Appeals]; *Morrison v. Case*, 9 Blatchf., 548; *Coleman v. Crump*, 70 N. Y., 573; *Brie v. Larbaud*, decided in the French Court of Riom, and reported in *Brown on Trade-Marks*; *Raggett v. Findlater*, L. R., 17 Eq. Cas., 36; *McAndrew v. Boss*, 4 De

Gex, J. & S., 380; *Ford v. Forrester, L. R.*, 7 *Ch. App.*, 70; *Broadhurst v. Barlow*, decided by Vice-Chancellor Wickens, in 1872, 11 *Alb. L. J.*, 169, where the case is reviewed; *Knott v. Morgan*, 2 *Keen*, 213; *Seixo v. Provezende, L. R.*, 1 *Ch. App.*, 198; *Croft v. Day*, 7 *Beavan*, 85; *Edelsten v. Edelsten*, 1 *De Gex, J. & S.*, 185; *Hoist v. Denham, L. R.*, 14 *Eq.*, 542; *Braham v. Bustard*, 1 *Hemming & M.*, 447.

The decision of the General Term was as follows:

PER CURIAM.—The judgment appealed from should be affirmed with costs upon the opinion delivered at Special Term.

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UNITED STATES CIRCUIT COURT, NORTHERN
DISTRICT OF ILLINOIS. IN EQUITY.

ROBERT J. ROBERTS

vs.

GEORGE W. SHELDON, ET AL.

DECIDED 7 JANUARY, 1879.

REPORTED 8 BISSELL, 398

“Parabola Case.”

1. The word “Parabola,” registered June 27, 1871, by Robert J. Roberts, of New York, as a trade-mark for needles, held not to be descriptive, but an arbitrary term adopted by complainant to distinguish his needles from those of other manufactures, and his right to so select and apply it affirmed.
2. Defendants’ and complainant’s labels are almost identical to the eye, that is the reading upon them is essentially the same. In one case it is “Robert’s Parabola gold burnished sharps.” Upon the other label or package, upon the same colored paper and with the same colored ink, is printed “William Clark & Sons’ Parabola gold burnished sharps,” so that there is a similar use of terms or letters and the same use of the word “Parabola,” and the only distinction is that between “Roberts,” and “William Clark & Sons.”

3. The use of it by another manufacturer, prefixed by the manufacturer's name, would be, in accordance with a former decision of the Court "that any prefix or suffix used with the trade-mark, would not give others the right to use it in connection with the manufacture of similar goods," an infringement of the exclusive right of the complainant to use that term to designate goods of his manufacture.

Messrs. Goodwin, Offield and Towle, for the complainant.

Mr. P. L. Shuman, for the defendants.

BLODGETT, J.:

This case comes up on application by the plaintiff for an injunction against the defendants, and on the demurrer of one of the defendants, George W. Sheldon, to the bill. The bill states, in substance, that the complainant is the manufacturer of needles in England and a subject of that country, but that he is domiciled in this country, and finds here a large market for his manufactured goods; that as early as 1866 he adopted as a trade-mark the word "Parabola," which was printed on the outside of the packages containing his needles; that his goods have acquired a wide celebrity under the name, and an extensive sale; that he has expended large sums of money in advertising and introducing his goods, and that he is entitled, by virtue of having been the first to adopt this word as a trade-mark for needles, to the exclusive use of it. He also alleges that the firm of William Clark & Sons, who are also manufacturers of needles in England, and are competitors of his in the American market, have put upon the market packages of needles in imitation of the packages of complainant's needles, and have used and are using the said word "Parabola" to designate their needles, and are now introducing their packages marked with complainant's trade-mark upon the markets of this country, and especially of the city of Chicago, whereby they are impairing the trade of the complainant, and prays for an injunction.

The defendant makes two points in the demurrer to this bill. The first is that the word "Parabola" is a description of the peculiar quality possessed by these needles—namely, that the eye of the needle is constructed in the form of two parabolic curves brought together at their open ends, and invokes, upon this statement of

fact, the well-known rule in the law of trade-marks that a person will not be allowed to use or adopt as a trade-mark any word which expresses the quality of the goods, such, for instance, as "best," "extra," or "superfine," or any of these adjectives. There are a large number of cases sustaining this position, and the rule, as a principle of the laws of trade-marks, is undoubtedly well established. The second objection taken to the bill by the demurrer is that the packages put up by Clark & Sons, and sold by the defendant Sheldon here as their agent, while they use the word "Parabola," at the same time are not calculated to deceive the public, because they say that the needles are manufactured by William Clark & Sons, and that the public are all notified that the needles made by the defendants Clark & Sons, and sold by Sheldon are "William Clark & Sons" Parabola Needles, not the Roberts "Parabola Needles," and upon this ground it is claimed there is no danger of the public being imposed upon or deceived by reason of the defendants' use of the word.

1. In answer to the first point—namely, that the eye of this needle has a parabolic form—it perhaps would be enough to say there is nothing upon the package tending to show that the word "Parabola" has any reference to the eye of the needle. It might as well be said, if the needle was a little curved, that it was a section of a parabolic curve; but I think it is answer enough to this position to say that there is nothing on the envelope or label of the package which says or tends to show that the eye of the needle is claimed to be made in the shape of a double parabola, or two parabolic curves, and when inspected under the glass it would seem to me, as a question of fact, that the eye of this needle is elliptical rather than parabolic in shape. The word "Parabola," it seems to me is, as stated by the complainant, an arbitrary term adopted by complainant to distinguish his needles from those of other manufacturers, and he has a right to so select and apply it.

It is frequently the case that by close analysis and ingenuity you can find in almost any trade-mark a designation of some quality connected with the goods. An analogous case to this was before this Court and heard before the learned Circuit Judge and myself four or five years since, in regard to what is known as the

“Cream Baking Powder.” The firm of Steele & Price filed a bill against one Richards and his associates, stating that Steele & Price had adopted a trade-mark to designate a certain baking powder which they manufactured, called “Cream Baking Powder.” The defendant had also commenced manufacturing baking powders, and was putting upon the market a commodity under the name of “Star Cream Baking Powder;” and the question was there made that the word “Cream” had reference to the quality of the baking powder—that is, that it was the best in the market. The position was argued very strenuously by the defendants’ counsel that it was a term of quality, not an arbitrary term; but in that case, which was decided by Judge Drummond, the Court held that the defendants had no right to use the word “Cream,” and that any prefix or suffix they used with it would not give them the right to use it in connection with the manufacture of goods similar to those made by the complainants; that the complainants had the exclusive right to use that term to designate goods of their manufacture.

It seems to me the case was, in all respects, analogous to this. I do not recollect that the case has ever been reported. An oral opinion was delivered by Judge Drummond immediately on the close of the argument, and I presume it never got into the reports.

2. In regard to the last point made, that by reason of the defendants using their own name upon the wrapper or envelope the public are not deceived, it would perhaps be enough to say that when goods acquire a specific name the purchaser rarely looks to see who has manufactured the goods. As, for instance, if, as a matter of fact, these needles have acquired among the trade and among consumers or users the designation of “Parabola,” to the extent that the purchaser would simply ask for “Parabola needles,” he might be supplied with the parabola needles manufactured by Clark & Sons, instead of those manufactured by the complainant, to the direct injury of the complainant and the abridging of his trade. Another case very analogous to this, upon this point, was also before this Court. A suit was brought by Procter & Gamble against McBride & Co., of this city, to enjoin the use of a trade-mark which had been adopted by Procter & Gamble for a certain

brand of soap which they manufactured. Procter & Gamble claimed that they had introduced to the public, under a trade-mark of their own, a brand of soap under the term and designation of "Mottled German Soap," and they had adopted as a trade-mark upon their packages those words with a circle, with a moon and stars in the middle. The defendants, McBride & Co., who were manufacturers in this city, had put upon the market a brand of soap which they termed "S. W. McBride's German Mottled Soap," and they had marked these words upon the outside of their packages in combination with a crescent, within which was a single star instead of a number of stars. That, I think, was the distinction, so that it presented a stronger case for the defendants than this, because we find upon inspection that the defendant's labels are almost identical to the eye—that is, the reading upon them is essentially the same. In one case it is "Roberts' Parabola gold burnished sharps." Upon the other label or package, upon the same colored paper and with the same colored ink, is printed "William Clark & Sons' Parabola gold burnished sharps," so that there is a similar use of terms or letters, and the same use of the word "Parabola," and the only distinction is that between "Roberts" and "William Clark & Sons."

Now, in the case I mentioned, the defendants had departed much more widely from the complainant's trade-mark. They had changed the arrangement of the words, so instead of its being "Mottled German Soap" it was "German Mottled Soap," and instead of a circle containing several stars it was a crescent containing a single star, prefixed by the name of each maker; and it was argued in that case there could be no possibility of intelligent consumers being deceived. So strong was the case made before me, on an application for an injunction, that I refused the injunction; but after the proofs were taken, and the case brought to hearing before Judge Drummond, he sustained the infringement and ordered a perpetual injunction against the defendants. It was also shown in that case that "mottled German soap" or "mottled soap" had been in common use in the trade for nearly fifty years, and that "mottled soap" was a commodity well known to the trade; but Judge Drummond sustained that trade-mark as the

exclusive property of the complainant, and held that the defendants' infringed.

3. In the light of that case, which has never been questioned, it seems to me that the mere fact that the defendants in this case have used the words "William Clark & Sons," so as to designate them as the manufacturers, does not defeat the complainant's right to the exclusive use of this word "Parabola" as designating his manufacture, and that there is a liability to impose upon the trade and on the public, from which the complainant has a right to be protected.

With these views I shall order an injunction on the complainant's filing a bond in the penal sum of \$5,000, conditioned for the payment of any damages which the defendant may sustain by reason of the issuing of the injunction, and also require complainant to put in his proof within thirty days after the answer in this case is filed as a condition of the granting of the injunction.

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SUPREME COURT, STATE OF NEW YORK.
SPECIAL TERM. IN EQUITY.

ENOCH MORGAN'S SONS' COMPANY

vs.

BENJAMIN F TROXELL, AND OTHERS.

DECIDED FEBRUARY, 1879.

REPORTED 57 HOWARD'S PR. REP., 121.

Sapolio vs. Troxell's Pride of the Kitchen.

Trade-mark. When injunction will be granted. When proven that the public has been deceived. What damages will be given.

The plaintiffs were the manufacturers and vendors of a new article of soap, put up in the form of a pressed cake, wrapped in silver-foil paper, encircled with an ultramarine blue colored paper band, printed in gold letters. The defendants manufactured a similar article, and introduced it to the market in an ordinary envelope. It did not sell well, and they therefore enveloped their soap in a wrapping substantially the same as the plaintiffs, though having minute variations. **HELD:**

1. That an injunction will be granted, where the differences between the trade-mark and an infringement can be detected upon a brief, though careful comparison, if it be apparent that the object in putting up the infringing articles, was simply to gain custom by general resemblance to the genuine article.

2. That where it is proven that the public, asking for the genuine article in buying from retail grocers, are supplied with an article in the simulated wrapping, and take it without detecting the simulation, it is sufficiently proven that the public have been fraudulently deceived.
3. That damages will be given only for such sales as have taken place after the commencement of the action, where it is shown that the plaintiffs knew of the infringement, but took no steps to arrest it.

THIS was an action for the infringement of a trade-mark of "Sapolio," in the dress, or manner of putting up the same for sale. It was referred to a referee, with power to hear and determine.

Clarence A. Seward and John Henry Hull, for plaintiffs.
E. More, for defendants.

J. S. BOSWORTH, *Referee*.

There are firmly settled rules of law applicable to trade-marks and the infringement thereof. The difficulty which is encountered in new cases lies in the application of these rules to the facts presented for the consideration of the Court.

Judge Allen, in his opinion in *Popham agt. Cole*, (66 *N. Y.*, 74), says: "The imitation of a trade-mark, with a design to deceive the public, and which is liable to deceive them, and enable the imitator to pass off his goods as those of him whose trade-mark is imitated, is a fraud upon the latter; and a false representation to the public, and the injured party may have relief to the extent that the imitation is deceptive and liable to mislead. *

* * * The question in this, as in every other case, is whether there is such resemblance between the two as to deceive a person using ordinary caution."

The same learned Judge in his opinion in *Coleman agt. Crumb*, (70 *N. Y.*, 578), said, "It is an infraction of that right to print or manufacture or put on the market for sale and sell for use upon articles of merchandise of the same kind as those upon which it is used by the proprietor, any device or symbol, which, by its resemblance to the used trade-mark, will be liable to deceive the public and lead to the purchase and use of that which is not the manufacture of the proprietor, believing it to be his. It is not neces-

cessary that the symbol, figure or device used or printed and sold for use, should be a *fac-simile*, a precise copy of the original trade-mark, or so close an imitation that the two cannot be distinguished except by an expert, or upon a critical examination by one familiar with the genuine trade-mark. If the false is only colorably different from the true, if the resemblance is such as to deceive a purchaser of ordinary caution, or if it is calculated to deceive the careless and unwary, and thus to injure the sale of the goods of the proprietor of the trade-mark, the injured party is entitled to relief."

In *Goldman agt. Hunt*, (122 Mass., 148), the Court said: "All the authorities agree that the Courts will not restrain a defendant from the use of a label on the ground that it infringes the plaintiffs' trade-mark, unless the form of the printed words and the words themselves, and the figures, lines and devices are so similar that any person, with such reasonable care and observation as the public generally are capable of using and may be expected to exercise, would mistake one for the other."

Where there is such a resemblance between the two as to deceive a purchaser using ordinary caution, or whether that resemblance is such as is calculated to deceive the careless and unwary, or whether the "figures and lines and devices are so similar that any person, with reasonable care and observation, such as people are capable of using and as people are expected to exercise, would mistake one for the other," would seem to be answered satisfactorily by clear proof that a person, desiring to obtain "Sapolio," mistook for it articles manufactured by the defendants, and bought and paid for the latter, believing that they were furnished with the former.

In *Woolam agt. Ratcliff*, (1 H. & M., 259), the plaintiff put up bundles of silk, manufactured by him, in a particular form, which the case describes, and he used to place under the centre string a label containing the following words:

"St. A*****" which represented 'St. Albans,' where the plaintiff's manufactory was and, which was well-known in the trade as the plaintiff's trade-mark. The defendant, in that suit, made up a quantity of silk in bundles, in exact imitation of the

plaintiff's bundles, and affixed a label exactly like that of the plaintiff, except that the mark 'St. A*****' was omitted. The Chancellor, Sir W. Page Wood, in his opinion, said: "Then it is said that the plaintiff has a very striking mark, by which any one could be satisfied, whether any particular goods were supplied by the plaintiff or not, and we have not attempted to imitate that mark, and this would be no answer. If I had any proved instance, in which goods supplied by the defendant had been actually sold as goods of the plaintiff, a case which might very well happen, at least in a foreign market, &c., &c." The Vice-Chancellor deemed it established that in the English market, "St. A*****" would have been necessary and sufficient as the *indicia* of the plaintiff's goods, and he did not think that in their absence the goods could have been sold in England as the plaintiff's manufacture, notwithstanding the circumstances of suspicion. He concluded by saying: "still, I have no evidence that any one has, in fact, been deceived. I do not feel myself justified in holding that such has been the case."

The leading facts established by the evidence in this case, are in brief as follows:

The firm of Enoch Morgan's Sons were engaged in business in 1861. The survivors of that firm made an assignment of its business to the plaintiffs in 1869. Enoch Morgan's Sons, the plaintiffs' predecessors, manufactured a compound for cleaning and scouring, commonly called, "scouring soap," to which they gave the name of "Sapolio." It was in the form of a pressed and stamped cake, inclosed in a tin-foil paper wrapper, encircled by an ultramarine blue and gold band, and packed in a box containing half a gross. On this band were printed in gold letters, the words, "Sapolio, for cleaning and scouring;" and there was upon the band, also a human face reflected by a polished pan. This band went round the cake lengthwise.

This was the first scouring soap put up in this form or style, or to which this name was given, or to which this device was affixed. In their advertisements they state, in substance, the style in which Sapolio was put up.

In 1872, William S. Troxell, now deceased, manufactured a scouring soap which he called "the Pride of the Kitchen." At that time it was made in the form of a thick paste, and was put up in tin boxes. The result of this manufacture being unsatisfactory, Troxell had a conversation with one Wood, who was then in his employ, in respect to getting up something different. Troxell bought a cake of "Sapolio," took it to his office and kept it there, and finally came to the conclusion that to ordinary observation, both on its face, and in its appearance, a sample cake which Wood made was the same as "Sapolio."

Wood procured one Bliven to engage with Troxell in the manufacture of this scouring soap. Bliven testified that, after Troxell had come to terms with him, he had conversations with him as to the manner of putting up the soap. Troxell wished to make two kinds—one like the "Sapolio" manufactured by Enoch Morgan's Sons, and another which he called "toilet soap."

They commenced to manufacture mineral soap and made several tons of it in the form of bars, which Troxell attempted to put upon the market. After a few days, he said to Bliven, "I think it best to put it up in cakes as I find objection among the dealers to buy it in bars. I think we better put it up as near the style of Sapolio as possible." He then asked Bliven if he would have the die procured, and Bliven told him that he would not do so as he thought it would be an infringement on the soap already in the market: Troxell said that he would take the responsibility. Bliven thereupon had the die made, and manufactured several hundred weight of soap, and put it up tightly pressed with the die.

In the spring of 1873, the conclusion was reached to make the soap in the form of a pressed cake, and the question of wrapping them then came up,—what should be the style of the wrapper? Bliven said, "I told Troxell I did not see the utility of putting a binding around it; he suggested a red band and blue band, but he wanted to get a soap which he could put on the shelf beside 'Sapolio,' so that persons could not see the difference between the two. Troxell, in all his conversations, seemed to

desire to imitate, as closely as possible, 'Sapolio,' without making himself absolutely liable. He used that language."

Wood testified, substantially, that Troxell said that he wanted to get up a trade-mark similar to the face looking into a pan, and, during the time Wood was with him, produced several sketches of a monkey looking at his reflected image in a pan. Troxell finally concluded that his device was as near as he could get it, and it was subsequently placed upon the defendants' manufacture.

The plaintiff has proved that in some thirty different stores kept by retail grocers, when the article "Sapolio" was asked for, "Pride of the Kitchen" was delivered to the customer without any explanation. In several of these stores repeated occurrences of this character have been proven. Many of these witnesses were housekeepers, who had used "Sapolio" for years, and did not know there was such an article as "Pride of the Kitchen" in the market, although they had used it so long. The only things in their recollection, and impression as to the exterior appearance of it were the size and the form of the cake, and its being in a foil wrapper surrounded by a band of *ultramarine* blue. They did not have in mind whether the blue band went around lengthwise, or around its sides. When "Pride of the Kitchen" was delivered to them in reply to a request for "Sapolio," they did not discover the deception until they began to use the article, when they discovered, on taking off the wrapper of the cake, that it crumbled, which they had never known "Sapolio" to do, also, that it scratched articles which they tried to clean and polish with it.

Grocers were induced to do this because they made more money on "Pride of the Kitchen" than on "Sapolio."

The defendant Parshall purchased a half interest in "Pride of the Kitchen," and became partner with Troxell about July 1st, 1874, under the firm name of W. L. Troxell & Co. Parshall at this time was interested in the profits of the firm of H. K. & F. B. Thurber, and bought and held their half interest. They paid for this half interest. They were capitalists in business, making sales of "Pride of the Kitchen" to grocers who retailed it. After-

wards W. L. Troxell died, and B. F. Troxell, the present defendant, as his administrator, sold the business out to Parshall, and then bought a half part in his own name. When Parshall became a partner, the defendants' article was put up with bands of three or four different colors, orange, red, blue and green. The defendants afterwards discontinued entirely the use of all colors, except red and blue, and in 1876 they discontinued the use of the red bands, and from that time have continued to use the blue band alone. The reason they assign for this is that they had used up the red paper, and were informed by grocers that it faded more than the blue; that it was more trouble to put up soap in that color than in bands of the first color; but the defendants conceded that it was no more trouble to put the first colored band around their soap than the one which they have latterly used, and I think it clear on the evidence that paper for the band of permanent red color could be obtained for substantially the same price as blue paper, and it is evident that, with a red band, the manufacture of the defendants would much less resemble "Sapolio."

1. A careful, though brief, inspection and comparison of the two styles of soap would disclose differences to the eye in the two articles.

On the "Sapolio" the blue bands go around the cake lengthwise. On "Pride of the Kitchen" the blue band is wider, and goes around the sides of the cake. On the latter are printed the words "Troxell's Pride of the Kitchen—trade-mark—soap for scouring and polishing." Between the word "trade" and the word "mark" is the device of a monkey with his head reflected in a pan. On the blue band, which goes around the cake of "Sapolio," are printed the words "for cleaning and polishing—manufactured by Enoch Morgan's Sons' Company, 440 West Street." There is also on it a device of the human face reflected in a pan.

It is very obvious, therefore, that any person who can read, on carefully comparing the two, not only could, but would detect differences between the imprints upon the labels; and, if they could not read, they would discover differences in the width of the blue band, and that one went around the length of it, and the other

around the sides of it, yet it may be true that as "Sapolio" has become well-known in the market, and is regarded with favor, that the defendants might believe that their "Pride of the Kitchen" had such a general resemblance to "Sapolio," both in respect to the size of the cake and as to its dress, that any grocers who kept "Sapolio" could place it by "Pride of the Kitchen" and deliver it to persons applying for "Sapolio;" such persons would not discover the differences, and would take it supposing that they were receiving "Sapolio."

2. It is established by the evidence that persons who bought of grocers, although they called for "Sapolio," and wanted it, on having "Pride of the Kitchen" handed to them in answer to their application did not discover the difference, but took "Pride of the Kitchen," believing it was "Sapolio."

The evidence tends strongly to the conclusion that "Pride of the Kitchen" was put up as it is put up, after it was produced in the form of a pressed cake, with a view to make it resemble "Sapolio," with the intent that it might be, and in the expectation that it would be, delivered by retail grocers for "Sapolio," and in the belief that, as to its general resemblance, such purchasers would not discern the differences between the two, and would take one for the other. An effect has been given to this intent. The defendants have realized their expectations. There was an intent on the part of the defendants to mislead the public, and the public has been misled, and the plaintiffs have been subjected to loss and damage thereby. Fraud and damage are thus coupled together as cause and effect.

3. The defendants object to the plaintiffs' right to any damages, on the ground that, knowing of the defendants putting up "Pride of the Kitchen," they have not complained or objected to it otherwise than by bringing this action. That, of course, cannot excuse the defendants from putting up subsequently thereto any cakes of "Pride of the Kitchen," calculated to mislead the purchaser, and in fact misleading them. Enoch Morgan's Sons did not anticipate any result adverse to their business from any attempt to introduce "Pride of the Kitchen," so long as it was put up with bands of various colors, and was attempted to be sold on its merits.

'The defendants discontinued the red band in October, 1875, but this fact did not become known until the winter of 1876 to the present plaintiffs. They did not have any information until the winter of 1876-7, which led them to suspect that any such deception was used to make sales of the "Pride of the Kitchen." On being satisfied by proof that it was so used, they put their inquiries, and, when they had collected such evidence as they supposed would enable them to establish an intent on the part of the defendants to mislead the public, and that the public had been misled, they commenced this suit, and about the same time commenced another action against the manufacturers of a soap called "Saphia," and notified others who had put up scouring soap in imitation of "Sapolio." All abandoned voluntarily, except those who were enjoined, and these defendants. Nevertheless, Enoch Morgan's Sons could have notified the defendants, on discovering what they had done and were doing, that the plaintiffs objected to an infringement of their rights. For all practical purposes, I think the plaintiffs must be presumed to have known, at and from the time of their purchase, what persons comprising the firm of Enoch Morgan's Sons' Company knew in this regard: and, under the circumstances, though with some hesitation, I conclude that the defendants should not be required to account for sales made prior to the commencement of this action. An objection to this conclusion arises from the fact that prior sales are found, upon the evidence, to have been effected by a designed attempt to mislead the public, which was successful, and, since the commencement of this suit, the defendants have omitted from the blue bands placed around the cake put up the design of the monkey looking at and reflected from the pan. In their testimony it is alleged that they abandoned this device, because they considered it did not amount to anything, and did not believe it had been the means of selling a cake of soap: yet it is declared, in words printed on their blue band to be their "trade-mark."

If the conclusions on this subject are correct, it justifies the opinion that "Sapolio," in the recollection and impression of purchasers, was regarded as a cake of soap of certain form and size, and inclosed in a silver-foil paper wrapper, surrounded by

an ultramarine blue band, and that, in ignorance of there being other soap put up in like form and appearance, they would take, from the grocers giving them "Pride of the Kitchen," in answer to a call for "Sapolio," the article handed to them, without discovering that they had not received what they asked for and wished to purchase.

It is also possible that not only careless and unwary purchasers but purchasers of ordinary caution, using such care as such purchasers ordinarily exercise, may have been deceived and received from grocers, "Pride of the Kitchen," having on it a band of orange red, instead of "Sapolio," believing that they were receiving the latter.

The evidence tends to show that some purchasers were in fact misled; but I give the defendants the benefit of all doubts on this question, and charge them with only those sales proved to have been made of soaps made by them since the suit was brought, and actually sold.

3. The amount thus sold appears to have been 1,901 boxes, and I compute and allow the damages thereon at \$4,752.58, for which the plaintiff is entitled to judgment, with relief by injunction also, to the extent that the imitation prepared by the defendants is deceptive and calculated to mislead.

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UNITED STATES CIRCUIT COURT, FOR THE
EASTERN DISTRICT OF VIRGINIA.
IN EQUITY.

YOUNG

vs.

JONES BROS. & Co.

DECIDED 18 FEBRUARY, 1879.

REPORTED 3 HUGHES, 274.

*Smith, Snyder & Co's Case.*RIGHTS OF PARTNERS IN TRADE-NAME AND MARKS OF
DISSOLVED FIRM.

The exclusive right to use the trade-mark of a firm does not pass to any member of the firm by mere implication; but such member may use it, provided he do so in a manner not to deceive the public.

HUGHES, J.:

A bill was filed by the plaintiff on the 15th of January last, complaining of a violation of his trade-mark by the defendants, and making a case for a temporary restraining order under section 718 of the Revised Statutes; and the order was given, to stand until the 12th instant. A rule was given against the complainant, returnable on the 12th instant, which is now heard.

The defendant files his answer and affidavits. The complainant files affidavits, and the case is heard on the defendant's motion to dissolve the temporary restraining order, and on the complainant's motion for a preliminary injunction until the cause shall be finally heard on plenary proofs.

Smith, Snyder & Co. was a firm which established a valuable European reputation for a certain manufacture of sumac and bark, and their brand became valuable as a trade-mark. They were succeeded by the firm of Jones, Snyder & Young, which acquired an exclusive right to their trade-mark or brand, "Smith, Snyder & Co." The firm of Jones, Snyder & Young was composed in part of the firm of Jones, Bros. & Co., which was engaged in another business. This latter firm became insolvent, and went into bankruptcy. Previously to doing so, and in contemplation thereof, and by consent of all parties concerned, this firm of Jones, Bros. & Co. sold to N. J. Young, senior member of the firm of Jones, Snyder & Young, "all their right, title, interest, property, claim, and demand in or to the assets of the firm of Jones, Snyder & Young, as set forth in an itemized schedule" annexed to the assignment. This schedule contained a list of property and shipments of the firm, and did not enumerate either the good-will or trade-mark, either of the firm of Jones, Snyder & Young, or of the original firm of Smith, Snyder & Co.

The question in this case is, whether the name and business of the firm was an asset of Jones, Snyder & Young.

The interests of trade-mark and good-will are omitted from express mention in this or any oral contract which accompanied the assignment to Young of the effects of Jones, Snyder & Co.

It is well-settled law that upon the dissolution of a partnership each partner has a right, in the absence of stipulation to the contrary, to use the name and style of the partnership in any way consistent with the facts of their business which does not have the effect of deceiving the public. He may say, "successor to the late firm," and may make like representations. In the absence of express stipulations each partner may use the good-will of the former partnership. It is also held that rights in the trade-mark are analogous to rights in the good-will of a partnership. In the

absence of express stipulation at the time of dissolution, each partner may go on and use the trade-mark of the firm. This does not pass inferentially under a general assignment; but it is like a man's skill in any kind of pursuit, it remains with him. See for this principle *Banks v. Gibson*, 11 *Jurist*, (N. S.), 680. It has been a matter of some debate and contrariety of decision by the Courts, whether one surviving partner after the death of the other succeeds to the good-will of the firm; the better opinion now being that he does not. *Hammond v. Douglass*, 5 *Vesey*, 539. Even where the good-will of a prosperous business of eight years' duration has been sold by its proprietor along with the lease of the premises, and all the stock, wagons, and fixtures used in the business, which consisted of "Howe's bakery," it was held in a leading case that the vendee had not the right to use the name "Howe" of the vendor, that not having been expressly mentioned in the contract of sale. *Howe v. Searing*, 10 *Abb. Pr. R.*, 264; *Collyer on Partnership*, last edition, 236; 2 *Kent's Commentaries*, 372, in notes.

On the want of right in the complainant, and not on the title to the trade-mark of the defendants, the injunction must be dissolved.

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COURT OF APPEALS OF MARYLAND.

CAROLINE V. ROBERTSON

vs.

MILLON A. BERRY AND OTHO SWINGLEY, COPART-
NERS, AND OTHERS.

DECIDED 28 FEBRUARY, 1879.

REPORTED 50 MD., 591.

"Hagerstown Almanack" Case,

Property right of an author or publisher in the title, name, or particular marks of his work. Protection in equity against their use and imitation by another. What constitutes a fraudulent or colorable imitation. Property right in the devices, emblems and title-pages of an almanac.

1. On appeal from an interlocutory order granting an injunction, the Court in determining whether the order shall be affirmed or reversed, is confined to the case made by the bill and exhibits, without reference to the averments of the answer which appears in the record.
2. A publisher or author has either in the title of his work, or in the application of his name to the work, or in the particular marks which

designate it, a species of property similar to that which a trader has in his trade-mark, and may, like a trader, claim the protection of a Court of Equity against such a use or imitation of the name, marks, or designation, as is likely in the opinion of the Court, to be a cause of damage to him in respect of that property. This doctrine, in cases where the facts are sufficient to sustain it, has been held applicable to such periodical publications as newspapers, magazines and almanacs. To entitle a complainant to relief, he must clearly show a property right in himself, and a fraudulent or colorable imitation by the defendant.

3. It is impossible to lay down any general rule as to what degree of resemblance between the symbols, marks and devices used on one publication and those on another, is necessary to constitute a fraudulent or colorable imitation. All that can be done is to ascertain in every case as it occurs, whether there is such a resemblance as that ordinary purchasers, purchasing with ordinary caution, are likely to be misled.
4. A property right may be acquired in the devices, emblems and title-pages of an almanac, by adoption and user.

APPEAL from the Circuit Court of Baltimore City.

The facts of the case are stated in the opinion of the Court.

The cause was argued before BARTOL, C. J., BRENT, MILLER, ALVEY, and ROBINSON, J.

S. T. Wallis, for the appellant.

Upon the general law of trade-marks, the appellant's counsel referred to *Stonebraker v. Stonebraker*, 33 Md., 263, 268; *Canal Co. v. Clark*, 13 Wallace, 322.

No person has a right to monopolize the name of a place or a geographical district, as an element in a trade-mark. (*Canal Co. v. Clark*, *ubi supra*).

The registration of a trade-mark is not conclusive, in favor of the right to claim it. *Moorman v. Hoge*, 2 Sawyer, 78. And, indeed, the whole trade-mark legislation of Congress is unconstitutional. (*Leidersdorf v. Flint*, 6 Reporter, 737).

Gruber's title to his trade-mark, if he had any, and if it were assets, could only pass by way of administration. (*Cecil v. Rose*, 17 Md., 101, 102; *Same v. Clarke*, *Ibid*, 520, 521).

And the recent and ancillary administration by Mr. Gans on the estates of Gruber and his descendants, *post litem motam*, were too long after Gruber's death to give any validity retroactively to the trade-mark claims set up by his descendants as derived from him.

But the good-will of a printing office, which is all that the parties really claimed, until of late, and with a view to this controversy, is not assets, (*Seligman v. Marshall*, 17 Md., 569).

The appellees, having derived no title or right lawfully from Jacob Gruber, and having printed their almanac for many years under a false pretence of such title, and sometimes as individuals, now one, now many, have no right under Gruber upon which they can maintain their present proceeding or appeal to a Court of Equity. They have no standing in Court, upon the ground of a violation of their own original rights created and secured by their own dealing with the alleged trade-mark, and their own skill and labor since Gruber's death; for that is not the case made by their bill, and to maintain their interlocutory injunction they must rest on their bill only.

Edgar H. Gans and *John P. Poe*, for the appellees.

The marks used by the appellees can in their own nature be trade-marks, either singly or in their collection, for a trade-mark may consist in any sign or symbol, or a picture made up of many objects, that can distinguish the goods of one man from those of another. (*Browne on Trade-Marks*, secs. 87, 259, 269).

The only possible objection that can be urged against these marks, being trade-marks, is, that the thing which they designate, being the subject of a copyright, cannot be protected by a trade-mark. But this objection confounds literary property with merchandise. A book or magazine, as literary property, is protected by its copyright, but as a piece of merchandise may be protected by a trade-mark, just as any other vendible article. (*Browne on Trade-Marks*, secs. 116, 117, 118, 553, 558; *Spottiswoode v. Clark*, 10 Juris., 1043; *Swift v. Day*, 4 Robertson, 611).

The property in these marks, is shown to be in the appellees. An inspection of the will of John Gruber shows that of these

trade-marks he died intestate. After his death his distributees continued to have an inchoate title in said trade-marks until the year 1878, when their title was made complete by the distribution of the administrator, *d. b. n. c. t. a.*, who was appointed in that year. (*Cecil, Adm'r of Owens v. Negro Rose*, 17 Md., 92; *Dixon Crucible Co. v. Guggenheim*, Am. Trade-Mark Cases, 559, 576).

The first aspect of the case treats the alleged wrong as an infringement of property rights, and regards the infringement of the marks as a wrong remediable by injunction, even though innocently done. (*Stonebraker v. Stonebraker*, 33 Md., 252-268, *Amoskeag Mfg. Co. v. Spear*, 2 Sand. S. C., 609; *Browne on Trade-Marks*, sec. 393; *Millington v. Fox*, 3 Mylne & Craig, 338-352).

But the case in its second aspect, is a case of unlawful competition by the use of simulated labels.

The law recognizes the good-will of a business as valuable property. When that good-will is preserved by the use of labels or names which serve the purpose of pointing out to the trade generally the property of the owner of the good-will, a Court of Equity will enjoin the use of a fraudulent imitation of those labels and names, even though they are not and cannot be trade-marks. (*Guerand v. Dandeleit*, 32 Md., 561; *Warfield v. Booth*, 33 Md., 63; *Witthaus v. Mattfeldt & Co., et al.*, 44 Md., 303).

The principle upon which the Court proceeds, that no man has a right to sell his own goods as the goods of another; or in other words, no man has a right to dress himself in the colors, or adopt and bear symbols to which he has no peculiar and exclusive right, and thereby personate another, for the purpose of inducing the public to suppose that he is that other person, or that he is selling the goods of that other person, while he is really selling his own.

The party injured is protected, not on the ground of the infringement of a trade-mark, for he may be protected in the use of that which is not a trade-mark, thus: B may be enjoined from running an omnibus having upon it such names, words and devices as to form a colorable imitation of those which had been previously placed on the omnibus of A,—(*Knott v. Morgan*, 2 Keene, 213); or he may be enjoined from using a name for his

hotel which had been previously appropriated by A, under which A's hotel had become popular and secured a large custom; (*Howard v. Henriques*, *Sandf. S. C.*, 725); or in the use of a geographical name which he cannot honestly use—(*Lea v. Wolff*, 15 *Abb. Pr.*, 1; *Wotherspoon v. Currie*, 22 *L. Times, N. S.*, 260; *Browne on Trade-Marks*, sec. 96); though in all of these cases the name cannot be a trade-mark. His right is to be protected against fraud which entails damage, and fraud may be practiced against him by the imitation of labels and names which cannot be trade-marks, quite as effectually as by the imitation of trade-marks, (*Croft v. Day*, 7 *Beavan*, 84, 88; *Eddleston v. Vick*, 18 *Jur.*, 7; *Browne on Trade-Marks*, secs. 537-539; *Burke v. Cassin*, 45 *California*, 467; *Stonebraker v. Stonebraker*, 33 *Md.*, 252, 262, 263, 268; *Holloway v. Holloway*, 13 *Beavan*, 309; *Matsell v. Flannagan*, 2 *Abb. Pr.*, (*N. S.*), 459; *Williams v. Johnson*, 2 *Bos.*, 1; *Blofield v. Payne*, 2 *B. & Ad.*, 410; *Gillett v. Esterbrook*, 47 *Barb.*, 455).

A comparison of the almanacs shows that the appellant has imitated the appellees' almanac in all its essentials, even in the name "Hagerstown Almanack," and that the only substantial difference is that the appellant calls her almanac "T. G. Robertson's Hagerstown Almanack," whilst the appellees' publication is called "J. Gruber's Hagerstown Town and Country Almanack." This imitation is clearly an infringement, and under the allegations of the bill, a fraudulent simulation. (*Scixo v. Provezende*, 1 *Ch. App.*, 196; *Amoskeag Manuf'g Co. v. Spear*, 2 *Sandf. S. C.*, 305; *Boardman v. Britannia Co.*, 35 *Conn.*, 402; *Millington v. Fox*, 5 *Mylne & Craig*, 338; *McLean v. Fleming*, 6 *Otto*, 245-56 and 7; *Eddleston v. Vick*, 18 *Jur.*, 7; *Lockwood v. Bostwick*, *Am. Trade-Mark Cases*, 535-8; *Kerr on Injunctions*, 483, 485).

MILLER, J., delivered the opinion of the Court.

This appeal is from an order granting an injunction restraining the appellant from publishing and circulating a certain almanac for the year 1879, known as "T. G. Robertson's Hagerstown Almanack," with the same emblems, devices, marks, represen-

tations, title and back, outside pages, style, shape and general appearance as have characterized the publications of the same for previous years, and from printing, publishing and circulating any other almanac in colorable imitation of the almanac of the complainants, known as "J. Gruber's Hagerstown Town and Country Almanack," and calculated to deceive and impose upon the public, and to create in their minds the belief that such almanac is really and truly the almanac of the complainants.

1. In determining whether this order shall be affirmed or reversed this Court is confined to the case made by the bill and exhibits, without reference to the averments of the answer which appears in the record. (*McCann v. Taylor*, 10 Md., 418).

It is immaterial to the decision of the case, in the view we have taken of it, whether the devices, marks, pictures and words, in the manner in which they are collected and combined upon the two outside pages of the complainants' almanac, be regarded as a trade-mark proper or as wrappers or labels, or as the title or the particular external marks which an author or publisher affixes to his work to distinguish it, because the grounds of relief in equity are substantially the same in either case.

2. A publisher or author has either in the title of his work or in the application of his name to the work, or in the particular marks which designate it, a species of property similar to that which a trader has in his trade-mark, and may like a trader claim the protection of a Court of Equity against such a use or imitation of the name, marks or designations, as is likely in the opinion of the Court to be a cause of damage to him in respect of that property. (*Kerr on Injunctions*, 478; *Browne on the Law of Trade-Marks*, sec. 553). This doctrine, in cases where the facts are sufficient to sustain it, has been held applicable to such periodical publications as newspapers, magazines, and almanacs. (*Matsell v. Flanagan*, 2 Abb. Pr., 459; *Hogg v. Kirby*, 8 Ves., 215; *Spottiswoode v. Clark*, 10 Jurist, 1043). But here, as in cases of trade-marks proper, the complainants must show a property right in themselves, and a fraudulent or colorable imitation by the defendant, and we shall therefore proceed to consider whether these two

essential requisites to relief in equity are made out by the bill and exhibits before us.

1st. And first, assuming the complainants or some of them have established their own right to the symbols, marks and devices, as used on their almanac, has there been such an imitation of them by the defendant on her almanac, as to entitle the former to have the publications by the latter enjoined?

3. Upon the question of resemblance, the authorities all agree that it is impossible to lay down any general rule as to what degree of resemblance is necessary to constitute the fraudulent or colorable imitation. All that can be done is to ascertain in every case as it occurs whether there is such a resemblance as that ordinary purchasers purchasing with ordinary caution are likely to be misled. (*Kerr on Injunctions*, 483; *McLean v. Fleming*, 6 *Otto*, 245). In the case last cited there is a very complete review of the authorities, and the Court says: "Much must depend in every case upon the appearances and special characteristics of the entire device: but it is safe to declare, as a general rule, that exact similitude is not required to constitute an infringement or to entitle the complaining party to protection. If the form, marks, contents, words, or the special arrangement of the same, or the general appearance of the alleged infringer's device is such as would be likely to mislead one in the ordinary course of purchasing the goods, and induce him to suppose that he was purchasing the genuine article, then the similitude is such as entitles the injured party to equitable protection, if he takes seasonable measures to assert his rights and to prevent their continued invasion." In the case of *Seixo v. Provezende*, *Law, 1 Ch. Appeals*, 192, Lord Chancellor Cranworth expresses substantially the same views thus: "what degree of resemblance is necessary from the nature of things, is a matter incapable of definition, *a priori*."

"All that Court's of justice can do is to say that no trader can adopt a trade-mark so resembling that of a rival as that ordinary purchasers purchasing with ordinary caution are likely to be misled. It would be a mistake, however, to suppose that the resemblance must be such as would deceive persons who should see the two marks placed side by side. The rule so restricted would be

of no practical use. If a purchaser looking at the article offered him would naturally be led, from the mark impressed on it, to suppose it to be the production of a rival manufacturer, and would purchase it in that belief, the Court considers the use of such a mark to be fraudulent." Among other authorities to the same effect, and as having an important bearing upon the case before us, we refer to (*Holloway v. Holloway*, 13 *Beav.* 209; *Amoskeag Manuf. Co. v. Spear*, 2 *Sandf.*, 599; *Swift v. Day*, 4 *Robertson's Sup. Ct.*, 611; *Williams v. Johnson*, 2 *Bosworth*, 1; *Lea v. Wolff*, 6 *Abb. Pa.*, (*N. S.*), 1; *Gillott v. Esterbrook*, 47 *Bdrb.*, 455; *Burke v. Cassin*, 45 *Cal.*, 467; *Boarman v. Meriden Britannia Co.*, 35 *Conn.*, 402; *Howard v. Henriques*, 3 *Sandf.*, 725; *Knott v. Morgan*, 2 *Keen*, 213, *Perry v. Truefitt*, 6 *Beav.*, 66; *Croft v. Day*, 7 *Beav.*, 84; *Wotherspoon v. Gurrie*, 22 *Law Times*, (*N. S.*), 60; and *Canal Co. v. Clark*, 13 *Wallace*, 322). In the present case we are clearly of opinion the imitation is such as is well calculated to mislead ordinary persons purchasing with ordinary care. It is unnecessary, even if it were practicable, to present a detailed description in words, showing the resemblance of the first or title pages of these two almanacs, as it appears to the eye. It is plain enough to the eye of the observer, but difficult to be described. There is a difference in the names and in some of the words used, and there are several marks of distinction in all symbols or pictures and the border enclosing them, which a careful inspection soon discloses, but there is exact similitude in the color, size, shape, and in the different type in which the more or less prominent words and figures are printed, as well as in the paper and binding of each. These make the resemblance at first sight quite sufficient to deceive the "ordinary run of persons," even if the two were lying side by side on the counter of a bookstore, or in a newspaper stall, while the back outside pages of each are in every respect identical. This part of the complainants' case is, in our opinion, clearly made out.

4. 2nd. As to the property right, On this subject the authorities all declare that the right of property in the plaintiff must be clearly shown. (*Witthaus v. Matfeldt & Co.*, 4 *Md.*, 303). From the averments of the bill, to which we are confined, it

appears that about the year 1835, John Gruber, the ancestor of some of the complainants, commenced the publication of an almanac to which he gave the name of "J. Gruber's Hagerstown Town and Country Almanack," and for the purpose of distinguishing it from all other publications of almanacs he adopted and made use of certain devices, emblems, representations, marks, and pictures, which he combined and collected in a manner entirely new and original, and these are the same as those now used on the almanac of the complainants. He continued this publication annually from 1835 to his death in 1858, and by his skill in the order and arrangement of the calendar; and the variety of the miscellaneous matter inserted therein, he acquired the good-will of the public and a large circulation for his almanac, and it was a source of profit and revenue to him during his life-time, and the emblems and devices before described became identified with his said publication and were the means by which it was known and distinguished by the trade. This, according to the averments of the bill, was the *origin* of the emblems and devices in which the complainants now claims a property right.

In our opinion that right does not depend upon the derivation of a *legal title* from John Gruber, either through his will, or by the administration *de bonis non c. t. a.*, taken out long after his death, for the purpose of obtaining title to, and distributing, as *assets* of his estate, these alleged *trade-marks* and the *good-will* of this printed publication, and we therefore dismiss from consideration all the averments of the bill on this subject. But it seems to us that the claim and right can be well tested upon another ground. The bill shows that in 1854, Gruber being then aged and infirm and unable to perform the manual labor for the printing and issuing of the almanac, continued its publication through the agency of William Stewart and Thomas G. Robertson, by a letter of license and authority to them which was printed on the second page of each issue. For many years prior to his death and before this agency of Stewart and Robertson, the surviving members of his family had contributed their labor in the publishing and preparation of these almanacs for the market. After his death his widow and executrix continued the

annual publication *during her life*, on account of herself and the other surviving members of the family, and did so through the business management of Robertson, notice of which was printed on each number, and during her life it was a source of revenue to her and her family and was their only means of support. The widow died in 1866, and the annual publication was continued by the family, also under the business management of Robertson, notice of which was also printed in each number. In 1874, one of the daughters died, after which two other daughters, for the use of themselves and the surviving members of the family of John Gruber, continued the publication and are now by their assignees, (who are also complainants,) printing and publishing this almanac. During all this period from the death of Gruber, nearly twenty years, the publication was continued in his name and two of his daughters sue in this case as copartners trading under the name and style of "J. Gruber."

It was so continued, and is now annually published by the complainants in the same style, with the same emblems, pictures and devices, with the same title pages, distribution and arrangement of matter, which had distinguished it during the life of Gruber. His family, by the manner in which they have conducted the publication, have retained the good-will of the public, increased its circulation, and at the present time under their management, and that of their assignees and agents, its circulation is extensive, and good-will attendant upon it valuable, and since Gruber's death it has always been, and is now known to the trade and public generally by the same emblems, devices, marks and representations before stated.

The sole and exclusive right of Gruber's family so to publish and sell this almanac was acknowledged and acquiesced in by all persons, and especially by Robertson, the husband of the defendant, who was the agent of Gruber and his family, as before stated, and afterwards by his widow, the defendant; for, upon Robertson's death in 1869, his executors contracted with the members of the Gruber family for its publication for the period of five years, and the latter authorized and permitted the executors to publish it for the time, and they did so up to the year 1875, and

during this period Mrs. Robertson and her children received all the revenues and profits arising from its sale, except the sum of \$450 per annum, which was paid to the family of Gruber as a royalty for the license so to print and publish. After this and during the years 1876, 1877 and 1878, Mrs. Robertson commenced and continued the publication of her almanac, which the bill charges to be a fraudulent imitation of that of the complainants. Without noticing at length many other allegations of the bill, the facts thus stated show that the complainants have acquired a property right in the devices, emblems and title pages in question by adoption and user. That such right may be so acquired appears to be well established by authority. Thus in *Eddleston v. Vick*, 18 *Jurist*, 8, it was held and expressly decided by the Vice-Chancellor, Sir W. Page Wood, that the right of property in certain labels or engraved papers or wrappers in which pins manufactured by the plaintiffs were put up, could be acquired by user alone. "If," says his lordship; "the plaintiff or those under whom he claims, has used this label continuously for a certain space of time, that is enough to enable him to prevent others from using it and making a profit out of the reputation which that label has acquired in the market." The plaintiff in that case was not the original inventor or proprietor of the labels or engraved papers or wrappers, but claimed from the assignees in bankruptcy of a former partner of the original proprietor and inventor. He had, however, carried on the business and used the labels for a period of more than eleven years, and by this alone he was held to have acquired a right of property in them.

So in *Canal Company v. Clark*, 13 *Wall.*, 322, the Supreme Court say: "Undoubtedly, words or devices may be adopted as trademarks, which are not original inventions of him who adopts them, and Courts of Equity will protect him against any fraudulent appropriation or imitation of them by others."

In such cases the adoption and use must be under such circumstances of good faith, as to satisfy the Court that the plaintiff is not himself practicing a fraud upon the public. He must explain how he came to such adoption and use, or in other words, he

must come into Court with clean hands. It seems to us very clear that such explanation is abundantly given by the bill in this case, and the adoption and user thus made out entitle the complainants to the injunction prayed for. It is scarcely necessary to add that a Court of Equity interferes in such cases to prevent fraud, and this is the broad ground upon which its jurisdiction rests.

3rd. It was suggested and contended in argument, that the averment that the complainants *are credibly informed and verily believe, and therefore charge*, that the defendant has printed, published and issued, or caused to be printed, published and issued, within the last few days, an edition of her almanac for the year 1879, in the same fraudulent and colorable imitation of that of the complainants, is not sufficient to justify the granting of the injunction. But without stopping to inquire whether this averment by itself would be sufficient, we find referred to in the bill, and filed as an exhibit with it, a copy or number of the defendant's almanac for the year 1879, exhibiting precisely the same appearance and characteristics as those of the two previous years, and equally resembling that of the complainants. This is quite sufficient to satisfy the Court upon the point suggested.

The order appealed from will therefore be affirmed; and in so doing we must be understood as intimating no opinion upon any other question than the one directly before us, viz., that the averments of the bill are sufficient to justify the granting of the injunction prayed for.

*Order affirmed, and
cause remanded.*

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IN THE UNITED STATES PATENT OFFICE.

FRANCIS WRIGHT, ET AL.

vs.

T. J. SIMPSON.

DECIDED 17 MARCH, 1879.

REPORTED 15 OFFICIAL GAZETTE, 968.

"Pond Lily Wash" Case.

1. Upon the dissolution of a copartnership terminable at the pleasure of either partner, neither is entitled to the exclusive use or to the registration of its trade-mark, unless by virtue of special stipulations.
2. Under a partnership agreement which provides that a firm may be dissolved at the pleasure of either partner, and that one of the partners shall retain his exclusive knowledge of the formula for the manufacture of the article sold by the firm, neither partner is entitled, upon a dissolution, to the exclusive use of a trade-mark adopted and used by the firm.
3. While such an agreement does secure to the possessor of the formula, the secret which was his own property and not the property of the firm, it does not confer upon him the trade-mark, which was the property of the firm, and not his own.
4. The title to the trade-mark having originated in its adoption by the firm for the merchandise manufactured and sold by the firm, and not in the

possession of the formula, the exclusive knowledge of such formula, by one of the copartners, is not decisive of his right to the exclusive use of the firm trade-mark. His right to use the trade-mark after the dissolution of the firm, whatever it may be, he holds as a former member of the firm, and it is not an exclusive right.

5. In such case, neither party can, after the dissolution of the firm, separately register its trade-mark.
6. The fact that an illegal registration has been granted to one of the copartners, will not justify a grant of a second illegal registration to the other.
7. The case would be different if either copartner had sold his entire interest in the firm to the other, or acquiesced in an assertion by the other of entire ownership of the business and exclusive right to the trade-mark as successor of the firm; but an attempt by the partner not in possession of the formula, to use the trade-mark by affixing it to an article manufactured without the formula, and therefore either spurious in fact or genuine by accident, if it be an unlawful use of the trade-mark, and a fraud upon the public, is none the less evidence of a purpose not to relinquish the party's interest in the trade-mark, nor to recognize the exclusive right of the other party.

APPEAL from the Board of Examiners-in-Chief.

TRADE-MARK, (Pond Lily Wash.) Wright's trade-mark registered July 31, 1877. Simpson's application filed October 6, 1877.

Mr. L. Hill, Mr. P. B. Stillson, and Mr. G. W. Balloch, for Wright, et al.

Mr. G. W. Dyer and Mr. D. Breed, for Simpson.

PAINE, Commissioner :

On the 6th day of August, 1875, T. J. Simpson and Francis Wright entered into partnership under written articles, of which the following only are material to the question presented by this case :

“The object of this agreement is to form a copartnership for the general manufacture and sale of a preparation of washing-fluid (now known as Pond Lily Wash) in the United States.

“The name and title of said firm shall be T. J. Simpson & Co.

“Said Simpson, owning solely the receipt for said washing-fluid, and being skilled in the art of making said fluid, in consideration of the engagements and services of said Wright, as hereinafter stated, doth contribute to said firm the use of said receipt, (but in no way further conveys said receipt apart, or parts with it,) and to advance at the beginning of the business such sufficient sum of money as may be needed to start the same.

“And said Wright, on his part and in consideration of the foregoing, doth agree to devote his time and energies to the business of the firm.

“And it is mutually agreed that said Wright shall attend to the sale of the goods so manufactured as aforesaid, keep the books of the firm, collect its dues, and settle its accounts, and generally attend to the usual office duties, and in all ways in his power devote himself to the business, and that he shall have one-fourth ($\frac{1}{4}$) part of the net profits of the business.

“And it is likewise agreed that said Simpson shall give his skill and time in and to the manufacture of the goods, as aforesaid, and contribute any improvement he may make or discover in the art aforesaid to the use and benefit of the concern, and he shall take and have three-fourths ($\frac{3}{4}$) part of the net profits of the business.

* * * * *

“Either partner wishing to withdraw from the business engagement may do so upon making a written statement of the reasons for his withdrawal; also, a statement of his interest, based upon a cash valuation, which shall not be placed upon the market before offering it to his partner upon such terms as he will take or give.

* * * * *

“This agreement shall continue for the space of time agreeable to both parties.”

Under this contract Simpson & Wright, as copartners, manufactured the article in question, and adopted as their trade-mark for this manufacture of the firm the words “Pond Lily Wash;” but they did not register the trade-mark. They might have done so during the existence of the firm, for as co-partners they were entitled to its exclusive use.

Simpson alone had knowledge of the formula by which the merchandise was manufactured; but that did not determine the ownership either of the merchandise or trade-mark applied to it. The secret was Simpson's, not the firm's; but the business, the merchandise, and the trade-mark were the firm's and not Simpson's. Simpson, as partner, held a three-fourths interest in the business in the merchandise and in the trade-mark, and Wright, as copartner, held a one-fourth interest in each. The exclusive possession of the formula by Simpson had no more bearing upon the copartnership rights than the exclusive possession of the formula by an employee of the firm would have had.

If a workman who possessed the secret of mixing this "Pond Lily Wash" had been employed by the firm to prepare the mixture at a stipulated compensation for his labor and the use of his formula, under a contract which secured to him the possession of his secret, such workman would have had no interest, as owner, in the business or in the merchandise or in the trade-mark. These would have been the exclusive property of the copartnership. The trade-mark would have been a trade-mark for the merchandise *as merchandise of the firm*, and not as merchandise in any other condition of ownership.

As between Simpson and Wright the same principles obtain. Simpson held his interest in the trade-mark wholly *as one of the copartners*, and not at all as the possessor of the secret of the mixture. Simpson could not have registered the trade-mark in his own name during the existence of the firm, for he had not the right to its exclusive use. The firm, and the firm only, could have lawfully registered the trade-mark.

If, upon a dissolution of the firm, the workmen had been, under his contract, at liberty to use the formula which he alone possessed, that would not have given him the right to the trade-mark which the firm had owned and used upon their own goods. He would have recovered the use of a recipe which was his own, but would not have appropriated a trade-mark which was not his own.

Now, two modes of terminating this copartnership between Simpson & Wright were marked out in the partnership articles. In the first place, either party might have presented a written

statement of his reasons for withdrawing from the firm, and *sold out* his interest to his partner, if he would buy it on the terms prescribed, and, if not, to any other purchaser. But if neither party chose to *sell out* his copartnership interest under that provision of the contract, he could, at his pleasure, under the concluding clause of the contract, have *terminated the existence* of the firm. In January, 1877, Wright terminated the existence of the firm, not by selling out his interest under the paragraph providing for such sale, but by terminating the copartnership under the last clause of the contract.

1. A trade-mark can only be registered by a person, firm, or corporation entitled to its exclusive use. Upon the dissolution of a copartnership terminable at the pleasure of either partner, neither is entitled to the exclusive use or to the registration of its trade-mark, unless by virtue of special stipulations.

2. Under a partnership agreement, which, like this, provides that a firm may be dissolved at the pleasure of either partner, and that one of the partners shall retain his exclusive knowledge of the formula for the manufacture of the article sold by the firm, neither partner is entitled upon a dissolution to an exclusive use of a trade-mark adopted and used by the firm.

3. While such an agreement does secure to the possessor of the formula the secret which was his own property, and not the property of the firm, it does not confer upon him the trade-mark, which was the property of the firm, and not his own. The fact that Simpson kept his secret did not, after the dissolution of the firm, entitle him to the trade-mark, or its exclusive use, any more than would the exclusive knowledge of the formula by one of the employees of the firm have entitled such employee to the trade-mark, or its exclusive use, after its dissolution.

4. The title of the trade-mark originated in its adoption by the firm for the merchandise manufactured and sold by the firm, and not in the possession of the recipe for its manufacture.

After the dissolution of the firm Wright had no claim to the exclusive use of the trade-mark. His right to it was only the right which one of two partners has to the trade-mark of a dissolved copartnership. It was not an exclusive right. It was, at the most,

only a right which he could enjoy in common with the other partner; but, as I said, the law prohibits the registration of a trade-mark by any person, firm, or corporation not entitled to the exclusive use of the trade-mark. Wright's registration, therefore, was illegal. Besides, he could not manufacture the article to which the trade-mark belonged, unless by accident, for he was ignorant of its composition. Whatever right Simpson, on the other hand had to use the trade-mark after the dissolution of the firm he held as late member of the dissolved firm. It was not an exclusive right. The circumstance that he alone knows the secret, and alone has the *power* to manufacture the "Pond Lily Wash," is not decisive of *his right* to use the firm trade-mark. So far as that element of the case is concerned, his attitude is not different from that of a former employee remaining in possession of the secret after the dissolution of the firm. His *right* is as good as that of the registrant, and no better.

5. Whatever they might have been able to do if they *joined* in an application for registration, neither Wright nor Simpson can separately register this trade-mark.

6. The fact that Wright & Brother have already obtained an illegal registration cannot justify the grant of an illegal registration to Simpson, who has not an exclusive right to the use of the trade-mark.

7. This would all be different if Wright had either sold his entire interest in the firm to Simpson, or acquiesced in an assertion by Simpson of entire ownership of the business and exclusive right to the trade-mark as successor of the firm of T. J. Simpson & Co. In that case the principle correctly stated by the Assistant Commissioner in his decision of November 2, 1878, would have been applicable. But Wright did not sell his interest in the firm to Simpson; nor did he acquiesce in any pretensions on the part of Simpson to an exclusive right to the trade-mark of the firm. On the contrary, he attempted to use it himself by affixing to it an article manufactured without the formula, and therefore either spurious in fact or genuine by accident. If this was an unlawful use of the trade-mark, and also, as is alleged, a fraud upon the public, it was none the less evidence of a purpose, on the part of

Wright, not to relinquish his own interest in the trade-mark, nor to recognize Simpson's right to its exclusive use.

Neither of these claimants has any right to the registration of the trade-mark in question. *On the merits* of the case, neither party is entitled to an award of priority, either of adoption or of right. Not on account of the essential validity of their title, but solely by virtue of their actual registration, Wright & Brother are able to maintain their precedence, so far as this office is concerned. If it were in my power it would be my duty to cancel their registration. But although registration has been unlawfully granted to Wright & Brother, it cannot be granted to Simpson.

The judgment of the Board of Examiners-in-Chief is reversed.

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CIRCUIT COURT UNITED STATES, NORTHERN
DISTRICT OF ILLINOIS. IN EQUITY.

JAMES B. WILLIAMS, ET AL.*vs.*CHARLES L. ADAMS, ET AL.

DECIDED APRIL, 1879.

REPORTED 8 BISSELL, 452.

“Yankee Soap” Case.

1. TRADE-MARK. ABANDONMENT. Abandonment of a trade-mark is not made out by showing numerous infringements in which the owners of such trade-mark have not acquiesced.
2. “YANKEE.” The term “Yankee,” applied as the name or label upon soap. HELD:
To be a valid trade-mark.

BILL TO RESTRAIN THE USE OF A TRADE-MARK.
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The alleged trade-mark is the use of the word “Yankee,” as a label or mark to designate the complainants’ manufacture of a certain kind of shaving soap. The bill set up that the firm of

Williams Brothers, in 1846, commenced at Manchester, Connecticut, the manufacture of a superior article of shaving soap, or toilet soap, to which they gave the name "Yankee Soap," or "Yankee Shaving Soap." That shortly afterwards the business place of the firm was removed from Manchester to Glastonbury, Connecticut, and the complainants' firm, as successors of the original manufacturers, have succeeded to all the rights of the original firm of Williams Brothers; and that the defendants were putting upon the market an inferior article of shaving soap, which they labeled "Yankee Williams' Shaving Soap." The complainants claimed the exclusive right to use the word "Yankee," having adopted it at an early day as a trade-mark, designating their manufactured goods.

H. B. Hurd, for complainants.

Banning & Banning, for defendants.

BLODGETT, J.:

I am satisfied that the complainants' case is fairly made out. The proof shows that they did enter upon the manufacture of this class of soap, as the bill alleges, and adopted this word "Yankee" as the mark or designation of their goods, and have used it from the time of its adoption to the present.

The defendants, on the contrary, claim that the complainants have abandoned the use of this word as their trade-mark; that they have allowed other manufacturers to infringe upon it by putting their soaps upon the market under the designation of "Yankee," as, for instance, "Yankee Jim," "Yankee Sam," and under other labels in which the word "Yankee" is the controlling or leading term, whereby complainants' exclusive claim of right to the use of the word "Yankee" has been infringed; and that complainants have so acquiesced in these infringements as to have abandoned their exclusive right to the use of the word "Yankee."

I do not find this position sustained by the testimony. The complainants seem to have been diligent in prosecuting all persons who infringed upon their rights within a reasonable time after

they became aware of such infringement. It is true that the proof shows that quite a large number of manufacturers are putting shaving soaps upon the market under the term or description of "Yankee," such as "Yankee Sam Soap," "Yankee Jim Soap," and the "Yankee Soap," which last is precisely like the complainants, and there are various other imitations of the complainants' goods, shown in the proofs.

1. But I do not understand the rule to be, that if a party infringes upon another's trade-mark there is any fixed time in which he must bring suit in order to save his rights. Certainly there is no such neglect on the part of the complainants proved here, as would show an intention to abandon their trade-mark.

The other point, that the word "Yankee" cannot be adopted by any person as a trade-mark, is presented with a good deal of vigor and ingenuity by defendants' counsel, and with a show of authority. A Mr. Browne has written a book on trade-marks, which to some extent, I think, is accepted by the profession as an authority, in which he sums up his own conclusion as to the principle decided in a certain trade-mark case, and says: "It clearly appears from the foregoing case, that words designating localities, places or persons, such as London Dock Gin, Yankee Soap, etc., cannot be adopted or used as a trade-mark." (*Browne on Trade-Marks*, sections 119-125, 597).

It is sufficient to say in reference to this paragraph, that Mr. Browne is not a Court; that he was simply enforcing his own individual views or conclusions from certain adjudged cases. Now, it seems to me by all the analogies, that a manufacturer, especially a manufacturer thirty years ago, would have had the right to adopt the term "Yankee" as applicable to some specific kind of goods, and make it a valid trade-mark.

We must remember that the term was not as generally applied then as it is now. At that time, certainly, the term "Yankee" was applied to the inhabitants of but a small portion of the United States—to a small portion of the New England States. For instance, in Western Massachusetts they would speak of the inhabitants of the eastern part of that State, and along the coast from Boston to Portland, Maine, as "Yankees." The eastern

shore people were called "Yankees" in New England. In the Southern, and perhaps some of the Western States, all people in the New England States were spoken of as "Yankees," and since our unfortunate national rebellion, it has been quite common at the South to speak of all persons who remained loyal to the Federal Government as "Yankees." The term has been enlarged by use, undoubtedly, very much within the last fifteen or twenty years. In 1846, the time the complainants entered upon this manufacture, the term "Yankee" was restricted, and applied solely as a nickname or epithet to the inhabitants of some parts of the New England States, but it was not a term describing a specific locality, or place, or person. It is not a geographical term, nor a proper name, but a designation applied by the dwellers in one locality to the dwellers in another place. It was not the name of any *certain* locality, and it seems to me complainants had the right to adopt it as their trade-mark. If it has since that time, by a more general use and definite application, come to designate any certain locality—which is not conceded—such subsequent events cannot defeat complainants' right. The complainants have made such a case as entitles them to an injunction, perpetually restraining defendants from using the word "Yankee" in any label or mark upon their soaps, and the case will be referred to the Master to take proof as to the damages which the complainants have sustained.

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UNITED STATES CIRCUIT COURT, DISTRICT
OF NEW JERSEY. IN EQUITY.
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ENOCH MORGAN'S SONS' CO.

*vs.*HUNKELE.

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DECIDED 30 APRIL, 1879.

REPORTED 16 OFFICIAL GAZETTE, 1092.

—*Demurrer to bill charging fraud.*

1. Differences between the original and the simulated trade-mark, which, in the absence of fraud, may be sufficient to repel the charge of infringement, will not be regarded upon demurrer.
2. To demur is to confess the allegations of fraud and of deceptive intent, in the use of the imitation mark charged by the bill, and upon overruling the demurrer, an injunction will be allowed, and defendant ordered to answer on the merits.

Mr. John Henry Hull and *Mr. A. Q. Keasbey*, for plaintiffs.*Mr. Wm. G. Cummins* and *Mr. E. More*, for defendant.

NIXON, J.:

The demurrer admits all the allegations of the bill of complaint. The only question, therefore, before the Court is whether a sufficient cause of action appears upon the face of the bill.

The complainant, a corporation created and organized under the laws of the State of New York, avers that it is the successor of the firm of Enoch Morgan's Sons; that the said firm invented and prepared a new manufacture of soap, especially designed for cleansing and polishing; that to indicate the genuineness of their manufacture they devised and for the first time applied as a trade-mark the word "Sapolio," a device of a human face reflected by a polished pan, a uniform size, form and color of cake, the stamp thereon of the words "Enoch Morgan's Sons' Sapolio," an envelope or wrapper therefore of argentine-foil-colored manila paper, having printed on the inside thereof certain words and devices in black type upon a cream-colored ground, a band of ultramarine blue paper for encircling the cakes when so enveloped and wrapped, with printing in gold letters; that large sums of money were expended by the firm in advertising the said manufacture, whereby it became widely known under the trade-mark aforesaid, and was so largely purchased and used by the public that its manufacture and sale under the said mark became pecuniarily valuable to the complainant; that, well knowing these facts, certain manufacturers in New York and elsewhere, since January 1, 1874, have fraudulently endeavored, and are still endeavoring, to avail themselves of the benefits of the said advertisements and of the popularity and reputation of the said manufacture, and of the trade-mark under which the same is sold, by fraudulently simulating the cake and appropriating the trade-marks, and are daily engaged in unlawfully and fraudulently selling the same as for the genuine manufacture of the complainant; that said simulated manufacture and appropriated trade-mark have a tendency to deceive, and do deceive, the public, exercising all the caution which purchasers usually exercise, and induce it to purchase said simulated manufacture as and for the genuine manufacture of the complainant, to the deception of the public and to the injury of complainant; that the defendant, designing to aid the manufacturers in their attempt to defraud the complainant and deceive the public, has purchased soap of these fraudulent manufacturers, and kept the same on hand as the genuine "Sapolio" made by complainant, with the design to impose the same upon purchasers as the genuine article, and

when applied to by customers for "Sapolio," which was well known to them and the public as an article manufactured by the complainant, has sold and delivered to such customers, without explanation, the simulated cake, and has given to them bills for the same as "Sapolio," so that customers, deceived by the general appearance thereof and not observing the difference, which might be detected on a closer observation, have accepted the same as the genuine article of the complainant; and that the said acts have been intentional, willful, and fraudulent.

Stripped of all verbiage, the charge is that the defendant has fraudulently simulated the manufacture of the complainant, and that he has successfully deceived the public by inducing it to purchase the simulated for the genuine article. It is not a question whether the defendant has in all respects imitated the trade-mark of the complainant, but whether he has so imitated it that the purchaser has been imposed upon.

1. The defendant insists that there are such differences in his mode of using and combining the colors on the wrapper that no careful purchaser need be deceived if he exercise ordinary care and prudence.

This may be true, and, in the absence of fraud, and upon the merits, the Court may not be willing to hold that an infringement has been shown. But the fraud has been confessed by the demurrer, and such confession entitles the complainant to an injunction.

2. The counsel for the defendant says that the demurrer was filed after duly considering the authority of *Ellis v. Zuillen*, (42 *Geo.*, 91), and *Barrons v. Knight*, (6 *R. I.*, 434), and yet it was held in both of these cases that where a fraudulent intent was admitted the imitation need only be partial to sustain the action.

The demurrer is overruled, and twenty days' time is given to the defendant to answer the complainant's bill on the merits.

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32

SUPERIOR COURT OF NEW YORK.

THE INDIA RUBBER COMPANY, PLAINTIFF AND
RESPONDENT,

vs.

THE RUBBER COMB AND JEWELRY COMPANY, ET
AL., DEFENDANTS AND APPELLANTS.

DECIDED 16 MAY, 1879.

REPORTED 45 N. Y. SUP. CT., 258.

“Rubber Comb Co.” Case.

FRAUDULENT SIMULATION OF LABELS. INJUNCTION.

1. In this case the following facts appeared:

The labels used by defendants in their business, were in undoubted imitation of those used by plaintiff, and the greater part of the details were so like the corresponding details of plaintiff's labels, that it was plainly defendants' intention to represent that the goods upon which the same were to be placed, were made by plaintiff. **HELD:**

That the plaintiff was entitled to protection against this.

2. The manner in which defendants printed their name upon the labels in question, was likely to draw attention, from the difference between it and plaintiff's name, and lead the ordinary reader to believe it to be plaintiff's name. **HELD:**

That in such case, the intent*being evident, the plaintiff is responsible for the effect produced, *though the name used was its proper corporate name.*

3. As to that part of the judgment herein against the use of portions of the labels, *the Court HELD:*

Whether a name can be a trade-mark or not, there is no doubt that a defendant may be enjoined from using a plaintiff's name. It was contended that plaintiff's name really expressed a kind of trade, and that, as the trade is open to all, there can be no exclusive right to words that intelligibly designate the same. But it appeared that there had been a purpose to use a name, in imitation of plaintiffs, on a label, and the case made it proper to consider whether there was not danger of a use of it apart from the same. No closeness of reasoning, based on the fact that it has never been used by itself, is called for in a case which discloses a meditated general wrong. Nor is it material that the name is described in the pleadings and findings as a trade-mark.

4. As to the use of the numbers "2," "101" and "32," the principles of *Gillott v. Esterbrook*, (48 N. Y., 375), apply. In that case, and this, the numbers were selected arbitrarily, and were used to distinguish one pattern or character of goods from another, and the plaintiff is entitled to protection in his use of the same.
5. *The Court further HELD*, as to the continuance of the injunction: such an actual use and danger or threat of further use, appeared that the plaintiff, if otherwise entitled, would not be deprived of his remedy by injunction, though shortly before the service of summons, &c., the defendant had stopped using the labels in question.
6. So far as the right to an injunction is concerned, there is no need of proof that any one has been, or is likely to be deceived by the simulated label. If a Court cannot judge, from the resemblance, the effect likely to be produced, it certainly may infer, from a fraudulent intent in circumstances which would permit its consummation, that it is likely that the intent will be successful.

Before SEDGWICK and VAN VORST, JJ.

This is an appeal from an interlocutory judgment entered upon the decision of the Special Term of this Court, perpetually enjoining the defendants from using any and all of the plaintiff's labels and trade-marks set forth in the complaint, and ordering a reference to ascertain the amount of the plaintiffs' damages sustained thereby.

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The action was for an injunction against the defendants using plaintiff's labels and trade-marks, and for damages.

Jacob & Koch, attorneys, and *Yeaman & Curtis*, of counsel for appellants, urged :

I. The words "The India Rubber Comb Company," the only trade-mark claimed or described in the complaint, are not and cannot become or be made a trade-mark, (*Browne on Trade-Marks*, secs. 138, 161, 162, 164, 350, and cases cited). The complaint has not been amended, to claim that anything else enters into the composition of the trade-mark, (see also, *In re Simpson*, 10 *Off. Gaz. Pat.*) The numerals cannot of themselves be a trade-mark, such as 101, 2 and 32, (*Browne on Trade-Mark*, secs. 225-233, 443). If the engraving or picture of plaintiff's factory may be used as a trade-mark, so may the engraving or picture of the defendant's factory, especially as they are so unlike as never to deceive or mislead. If the trade-mark claimed be valid, then the defendants have not used it. The plaintiffs use the words "India" and "N. Y.," the defendants do not. The defendants use the word "Jewelry," which the plaintiffs do not. The defendants use the monogram, while the plaintiffs do not. The plaintiffs use the words, (expressing a fraud and falsehood), "sole manufacturers of Goodyear's Gutta Percha Combs," which the defendants do not. The defendant company has the right to use its own corporate name, and has done so. The plaintiffs never had any trade-mark or property in the numerals 101, 2 and 32, as claimed. It was not the first or only one who used them, and if it ever acquired any such right, it has been abandoned to the public by acquiescence in their long use by other traders and manufacturers. Fifteen years' public, open and notorious use by others, is an insurmountable obstacle to the present assertion of exclusive right.

II. If a liberal construction of the complaint would make it a cause of action for fraudulent simulation of labels as distinguished from trade-marks, what some writers call unfair and immoral competition, (a case not claimed in the complaint), then the plaintiff cannot recover, for the reasons above expressed, espe-

cially the differences, pointed out under figure 4 of point I, and also for the following reasons: 1. No intent to defraud has been shown, which must be done to entitle plaintiff to injunction. 2. No actual or successful fraud or deceit has been shown by a single instance of sale of defendants' goods as and for plaintiff's, nor of any one calling for or ordering plaintiff's goods and getting defendants' instead, which is necessary to entitle plaintiff to judgment for damages or for an accounting. 3. No attempt was made to show either such fraudulent intent, or such actual fraudulent sales. 4. It has not been shown, nor has any attempt been made to show, that any ordinary purchaser looking at either the goods or the labels would mistake the defendants' for the plaintiff's. 5. Neither the plaintiff nor the defendants retail goods. They both sell to jobbers, who supply retail dealers, who supply consumers. They each sell at wholesale, in large, paper-wrapped packages, as exhibited in Court, the plaintiff putting on these large packages a green label with black letters, and the defendant a white label with blue letters. Nothing could be more distinctly and even glaringly different. If any witness had come into Court and said he had been deceived or could be deceived by mistaking one of these labels for the other, the Court would simply not have believed him.

III. The case of *Gillott v. Esterbrook*, (48 N. Y.), does not hold that numbers by themselves may be a trade-mark, but only that they can be used in connection with other things. The plaintiff's trade-mark is described as "The India Rubber Comb Co.," without numbers. When this was offered for registration at Washington, and rejected, as stated by plaintiff's counsel, the engraving of the factory was added, and it was then registered. The trade-mark and specifications as registered not claiming the right to the use of numbers 101, 2, 32, nor in any way alluding to them, is conclusive evidence that they had never been relied upon as a trade-mark, or, if so relied on, had been abandoned. The claim and sworn application state "our trade-mark" consists of the words "India Rubber Comb Company, arranged in connection with a representation of our factory at College Point, Long Island." The document further states that this trade-mark

may be accompanied by a border, but proceeds to allege that the essential features are the words "India Rubber Comb Company, arranged in connection with a representation of the India Rubber Comb Company's factory at College Point, Long Island." Thus the numbers 101, 2 and 32 are expressly excluded in two ways; by stating what may accompany the trade-mark, and by stating the essential features of the trade-mark. They further say "this trade-mark we have used in our business for three years last past." The plaintiff cannot have two trade-marks, nor dozens or hundreds of them, as it would have if each label with a different number on it be a different trade-mark. In its complaint it describes one without number, sues the defendant on that description, and to sustain the cause of action puts in evidence a certificate of registration making no claim to numbers as a part of its trade-mark, and containing a specimen label with numbers not mentioned in the complaint or the evidence, to wit: 1 doz.,—No. 4,—7½ inch. The plaintiff must abide by its own description and registration. It cannot register one thing and claim another.

IV. There was an element, a finding of fact, in *Gillott v. Esterbrook*, that broadly distinguishes it from this case. The trial Judge found, and the Court of Appeals expressly rely upon the finding, "that the said use by the defendants of said numerals 303, was with a knowledge by them of the rights of the plaintiff to the same, and with the intent to obtain for themselves the profits and advantages to which the plaintiff was exclusively entitled in the use of his said trade-mark, and to mislead the public, and to defraud the plaintiff in that respect." In this case we have not the knowledge by defendants of plaintiff's rights, if it had any, and any such knowledge, as well as the right, is negatived by the long and general use by others. Neither have we the intent to obtain plaintiff's profits; nor the intent to mislead the public and defraud the plaintiff, all which are found in the case of *Gillott*, and none of which are proved in this case.

V. Particular attention is called to the case of *Singer Manufacturing Co. v. Wilson*, 2 Ch. Div. App., 434), a late English case, which perhaps, more nearly than any other case, contains the whole law of trade-marks and fraudulent imitations of labels.

The case of *Boardman v. Meriden Britannia Co.*, (*Cox Trade-M.*, *Cas.*, 490), is not similar in its facts. The case, like Gillo's No. 303, holds that a number can only be a part of a trade-mark in connection with other things. When any mark, symbol or device is used merely to indicate the name, quality, style, or size of an article, it cannot be protected as a trade-mark, (see also *Coddington's Digest of Trade-M.*, 265).

VI. Although, by the long-continued use of certain letters, figures, words, marks or symbols, which do not of themselves and were not designed to indicate the origin or ownership of the goods to which they are attached, but only to designate the nature, kind, or quality of the different varieties of the article, and because so marked the goods have become known as those of the manufacturer who first used them, such fact cannot alter the original meaning of the words or symbols, or the intent with which they were first used as denoting the name of the thing or its general or relative quality, or take from others the right to employ them in the same sense. (*Camdee v. Deere*, 64 Ill., 439).

VII. There is no case to be found in which a plaintiff has been allowed to sell the same goods under more than one trade-mark. The idea of identity, oneness, is necessary to and so embraced in the conception of a trade-mark, as applicable to a certain kind or line of goods, that divisibility or plurality at once destroys both the conception and the thing. The same trader or manufacturer may have one trade-mark for his woolen goods, another for his cotton goods, another for his silk goods, and another for his combs, if he makes so many articles. But he cannot have three trade-marks for the same comb. In this case the plaintiff has declared on one trade-mark, its corporate name: "The Indian Rubber Comb Company;" it has put in evidence eight, all differing in some respects from each other, and has recovered on five, three being always annexed to one article.

VIII. The motion to dismiss plaintiff's complaint, and again, at conclusion of plaintiff's testimony, should have been granted. And even if there had been any grounds for retaining the complaint as to the defendant company, the motion to dismiss as to the individual defendants, Sonneborn, Dittenhoefer and Cohn,

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should have been granted. There was no evidence whatever upon which to base a judgment against them. It is proved, and no attempt made to contradict it, that they were not in the business, individually or personally. That they were officers of the defendant, the Rubber Comb and Jewelry Company, can in no way make them personally responsible. If they had been manufacturers, on their own account, they could not be joined, It would be a case of alleged wrongs by different parties, Therefore the objection of improper joinder of parties should have been sustained, and all these three defendants should have had judgment for costs.

Abbott & Fuller, attorneys, and *Messrs. Fuller & Gilhooly*, of counsel for respondent, urged:

I. The plaintiff's name, "The India Rubber Comb Company," used on or in connection with its manufacture, is a valid trade-mark, of which the plaintiff is entitled to the exclusive use (*Newby v. Oregon Central Rw. Co.*, 1 Dedy, 609). In the *Matter of the India Rubber Company*, (*Off. Gaz. Pat.*, November 30, 1875), the opinion of the Commissioner contains a citation and discussion of the cases on this point, and he holds that said words constitute a valid trade-mark. (See, also, *Colman v. Crump*, 70 N. Y., 578). This particular trade-mark, to wit: the words "The India Rubber Comb Company," has been sustained by the Superior Court in the case of *India Rubber Co. v. Meyer*.

II. The plaintiff is entitled to the exclusive use of the numbers "101" and "32," as applied to combs, and the number "2," as applied to hair-pins, (see *Gillott v. Esterbrook*, 48 N. Y., 374, 377).

III. The plaintiff is entitled to the exclusive use of the cut or representation of a building, as shown in the exhibits annexed to the complaint, in connection with combs, and any simulation of such cut should be enjoined. Such a device is a good trade-mark, (*Smith v. Reynolds*, 10 Blatchf., 100; *Kinney v. Basch*, [unreported;] *Coddington Dig. Trade-M.*, 85; *Faber v. Hovey*, *Id.*, 242; *Colman v. Crump*, 70 N. Y., 573).

IV. The defendants are joint *tort feasors*, and as such may be sued jointly. The defendant, Dittenhoeffer, is the president of the Rubber Comb and Jewelry Company; the defendant, Sonnenborn, is secretary and treasurer; and the defendant, Cohn, is a salesman and corporator, (see *Goodyear v. Phelps*, 3 *Blatchf.*, 91; *Poppenhusen v. Falke*, 4 *Id.*, 493).

V. Where the imitation of plaintiff's trade-mark is close, and the manner in which defendant's articles are put up nearly resembles the plaintiff's, the law must presume it to have been resorted to for the purpose of inducing the public to believe the article is that of the plaintiff, whose trade-mark is imitated and for the purpose of supplanting him in the good-will of his business. (*Curtis v. Bryan*, 2 *Daly*, 312; *Taylor v. Carpenter*, 11 *Paige*, 292; *Braham v. Bustard*, 9 *Law Trials, N. S.*, 199; *S. C.*, 2 *New R.*, 572; *Amoskeag Manuf'g Co. v. Spear*, 2 *Sandf.*, 599-608; *Edelsten v. Edelsten*, 9 *Jur. N. S.*, 479; *Colman v. Crump*, 70 *N. Y.*, 593). And in order to entitle plaintiff to relief, it is not necessary that the imitation should be so close as to deceive persons seeing the two trade-marks side by side, (*Seixo v. Provezendo*, *Law R.*, 1 *Ch.*, 192). In a recent case in the House of Lords. (*Wotherspoon v. Currie*, 42 *Law J. R. N. S. Ch.*, 130), Lord Chelmsford lays down the rule, that, to establish a case of infringement, it is sufficient if the resemblance is such as to be likely to make unwary purchasers suppose that they are purchasing plaintiff's articles. See, also, in the case of *Blackwell v. Armistead*, 5 *Amer. Law Trials*, 85), decided in 1872.

VI. In the case of *Gillott v. Esterbrook*, (45 *N. Y.*, 374), the Court of Appeals held that the use and advertisement of a trade-mark by others for a period of fifteen years, where plaintiff had no knowledge of such practice, or acquiesced in the same, did not preclude the owner from enforcing his sole right. And in a suit to enjoin defendants from selling "Charter Oak" stoves bearing a certain trade-mark, the fact that parties in other localities manufactured "Charter Oak" stoves, and sent them into the market to compete with plaintiff's manufactures, in no way aids the defence, unless it appears that the plaintiff assented to or acquiesced in such infringement of his rights. (*Supreme Ct. of Mo., Filley*

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v. Fassett, 44 *Mo.*, 168). So, in the case of *Kinahan v. Bolton*, 15 *Irish Ch.*, 75), the Lord Chancellor held that in order to prove acquiescence by a firm in the piratical use of their trade-mark, knowledge of such use must be proved, and that is not accomplished by the proof of publication of advertisements, which could have been an invasion of the rights of the firm if those advertisements have been issued, not steadily or uniformly, but interchangeably with other advertisements in some respects similar, but not infringing the rights of the firm,

VII. In the case of *Dale v. Smithson* (12 *Abb. Pr.*, 237), the General Term of the Common Pleas expressly held that the plaintiff is entitled to protection in the exclusive use of his trade-mark, although it contains a fictitious name as the name of the manufacturers of the article, provided it does not misrepresent the quality and substance of the manufactured article, and it is not used with fraudulent intent. In the case of *Curtis v. Bryan* (36 *How. Pr.*, 33) the General Term of the Common Pleas held that false and exaggerated statements in advertisements of the manufactured article, not contained in the label sued on, do not deprive the owner of his right to protection in his exclusive use of his trade-mark.

VIII. The main inquiry in such cases is, are the ultimate customers deceived? (*Coats v. Holbrook*, 2 *Sandf. Ch.*, 586; 3 *Barn. & Cress.*, 541; 5 *Dowl. & R.*, 292).

IX. A reference was properly ordered to ascertain the amount of damages sustained by the plaintiff (*Blackwell v. Armistead*, 5 *Amer. Law Times*, 85, decided in 1872; *Taylor v. Carpenter*, *Cox Amer. Trade-M. Cases*, 32; *Blofield v. Payne*, 4 *Barn. & A.*, 410; 3 *Mylne & Cr.*, 338; *Bailey v. Taylor*, 1 *Russ. & M.*, 73; *Whittington v. Woolen*, 2 *Swanst.*, 428). See also a decision of the General Term, Supreme Court, first department, Dec. 30, 1875, in the case of *Faber v. Horsey* [unreported]; *Coddington Dig. Trade-M.*, 242).

X. The well-known case of *Boardman v. Meriden Britannia Co.*, (35 *Conn.*, 402, and *Cox Amer. Trade-M. Cas.*, 490) resembles in almost every particular the one at bar.

BY THE COURT,—SEDGWICK, J.:

The answer of the defendant corporation admits that it is, and since its organization, has been, engaged in the sale of combs and hair-pins, "and that it has affixed thereto labels similar to those shown in plaintiff's Exhibit A 1, and used Exhibits B 1, C 1, and D 1, for only a short time, and but few of them; but denies that the same were fraudulent imitations of plaintiff's labels."

5. This answer was sworn to December 14, 1877. The corporation defendant was incorporated January 16, 1877. The testimony bearing on the time through which the defendant used the labels, and the admissions of the answer, sufficiently showed such an actual use, and danger or threat of further use, that the plaintiff, if otherwise entitled, would not be deprived of his remedy by injunction, even if the Court were satisfied that shortly before the service of summons the defendant had stopped using them.

The labels, Exhibits C 1 and D 1, seem to have been those not used by the defendant corporation. The defendant, Sonneborn, in his answer, alleges that these labels were devised and used before, but not after, the incorporation of defendant. His evidence did not clearly show that these labels had not been used after the incorporation, and on the whole case it appeared that the admission of the answer of the defendant corporation was correct.

1. These labels were in undoubted and designed imitation of plaintiff's labels, Exhibits C and D. The defendants used as their name, which it was not, the words, "The India Rubber Comb and Jewelry Co.," and the greatest part of the other details were so nearly like the corresponding details of plaintiff's labels that there could be no doubt that defendant's intention was to represent by their labels that the goods on which they were to be in some fashion placed were goods made by the plaintiff, and in the nature of things it was likely that the intention would be successfully carried out.

2. With these facts in their minds the defendants proceeded to devise or use for combs the labels Exhibit A 1 and Exhibit B 1, and made as much of an imitation as the first, excepting the word "India" is left out. The right to use their name, as changed into "The Rubber Comb and Jewelry Co.," is maintained, on the

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ground that the defendant, having been incorporated by the latter name, there was a clear legal right to use it upon their goods. Without adverting to an important consideration that they, under the statutes of this State, took and composed that name according to their pleasure, with perhaps a view to the future, which may lead to different rights to those that refer to a name involuntarily bestowed upon a natural person, it is certain that there is some limitation of the use of a lawful name. If a right name is used intentionally in a manner that draws attention from a difference between it and another name, so that the effect produced is that of the other name, there is a responsibility for the effect. It is, as to the effect, not the use of the right name. In the present case the way in which the defendants printed their name: "The Rubber Comb and Jewelry Co.," viz., upon pieces of paper like those used by the plaintiff, in ink of a like color, and at the top of several colorable imitations of a picture of factory, of description of goods, and of the words, "warranted not to warp or split, and can be cleaned in warm water," was likely to draw the attention from the difference of name, and to lead the ordinary reader not to perceive it, but to think that it was plaintiff's name. The labels themselves, and the testimony in the case, keeping in mind that the labels were made shortly after what was beyond doubt an intentional imitation, prove that the use of defendant's name on the later ones was intended to produce an impression that it was the plaintiff's name. A little fact is very significant to show that the defendants had in mind the character of plaintiff's labels when they made theirs. On plaintiff's labels was "warranted not to warp or split, and can be cleaned in warm water." The defendants, on their first label, copied this in its very words. On their later, they placed, "warranted not to warp or split, and can be cleaned in hot water." It would seem as if the change of "warm" to "hot" was a preparation of evidence.

2. In such case it is so easy to give a distinguishing mark that shall have no doubt about it, that it can almost be said that merely the failure to do it shows an actual purpose not to do it. The sum of this part of the case is, that the plaintiff proved that the labels of defendant, when placed upon goods, were a representation that

the goods were the manufacture of plaintiff. The law gives protection against this.

Here may be noticed the allegation that plaintiffs had abandoned any exclusive right they may have had by acquiescing in the use of this kind of labels by others, for years. The facts did not sustain the allegation. If there were proof (which was not clear) that there was such a use by others, there was no proof of acquiescence by plaintiffs in it.

As to the sale of goods by the plaintiffs, under the name of the United States Company, the defendant's requests to the Court do not claim that the labels or marks in question were used. I cannot ascertain from the evidence that the defendants attempted to prove it.

Another allegation is that the label of plaintiff should not be protected, because it had on its face the words "sole manufacturers of Goodyear's India Rubber and Gutta Percha Combs," and that this was false and fraudulent to purchasers. Whether it was or was not false was a question of fact. The Court could not take judicial cognizance of what Goodyear's India Rubber and Gutta Percha Combs were. It was possible that a party should be the only manufacturer of such combs, and that at least a claim to be so was not fraudulent. The burden was upon defendant to show the falsity and fraudulent intent, but no testimony as to them was given.

6. It is also claimed that there was no proof that any one in the market had been, or by an expert, that any one was likely to be deceived into the belief that goods having defendants' labels were made by plaintiff. So far as a right to a preventive remedy by injunction is concerned, I do not think that such proof was necessary.

If a Court could not judge from a resemblance that it was likely to produce the effect that the original or true one would produce, and which, I think, it can, certainly it may infer from a fraudulent intent of a person in circumstances which would admit the consummation of it, that it is likely that the intent will be successful, and others will be deceived.

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For these reasons, the judgment against the use of the labels must be sustained, and I proceed to that part against the use of portions of it.

3. Whether a name can be a trade-mark, technically, is doubted by the learned counsel; but I do not understand them to doubt that a defendant may be enjoined from using the plaintiff's name. The position was not taken, if it be sound; and as to this, impression is given that what the words of plaintiff's name really expressed is a kind of trade, and that, as the trade is open to all, the plaintiff can have no exclusive right to words that intelligibly designate the trade. On the facts, I think it was shown that there had been a purpose to use a name in imitation of plaintiff's on a label, and the case made it proper to consider whether there was not danger of a use of it apart from the labels. No closeness of reasoning, based on the fact that it has never been used by itself, is called for in a case which discloses a meditated general wrong. It does not seem to be material that the name is said, in the pleadings and findings, to be a trade-mark. The material thing is stopping its use by defendants.

4. As to the use of the numbers, "2," "101," and "32," I am not able to see that the principles of *Gillott v. Esterbrook*, (48 N. Y., 375), should not be applied. In that case and in this, the numbers were used to distinguish one pattern or character of goods from other patterns. In this case, the defendant's labels prove that the numbers were useful in the market to designate these patterns. The numbers were selected arbitrarily, and of themselves expressed no size or quality. The findings as to defendant's knowledge of the plaintiff's use of the numbers to designate their goods, and of the fraudulent intent as to plaintiffs and third persons, were substantially the same in the two cases. It was not shown in this case that the plaintiff had acquiesced in the use of these numbers by others. I am of opinion, however, that the terms of the judgment were too broad in restraining the defendants from using in any way the cut or representation of a factory, on their goods. The plaintiff had never used that as a trade-mark by itself, in the same sense that the numbers were used. The defendants are still at liberty to use a picture of a factory in

a proper manner. The judgment should have been confined to the use of an imitation, colorable or other, of the picture of a factory, used by plaintiff. This is, however, hardly more than a matter of form, which could have been corrected upon suggestion, on the settlement of the judgment. The judgment should be modified by striking out the absolute prohibition of the use of a picture of a factory, and confining the imitation to a picture like that used by the plaintiffs.

The case disclosed individual acts by the defendants other than corporation, jointly with the corporation, and there was a joint liability to the plaintiff.

The judgment, after being modified in the manner that has been stated, is affirmed, with costs.

VAN VORST, J., concurred.

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COURT OF COMMON PLEAS, PHILADELPHIA.

SHEPPARD & CO.

*vs.*STUART & PETERSON.

DECIDED 3 JUNE, 1879.

REPORTED 13 PHIL., 117.

"Excelsior Stove" Case.

1. The principle is well settled that a manufacturer may, by priority of appropriation of names, letters, marks or symbols of any kind to distinguish his manufacture, acquire a property therein as a trade-mark, but said mark must indicate the "true origin or ownership" of the goods to which the mark is applied.
2. In cases involving the question of *trade-mark*, the evidence must show the first appropriation of the device by the claimant; its application by him to his goods or business; and that the trade or public recognize the article or business by that device as made or sold by him or belonging to him. In no other way can a mark or device indicate "*true origin or ownership*."
3. Although a man may not intend to injure another, yet he will not be allowed to adopt the marks by which the goods of such other person are designated, if the effect of adopting them would injure such other person.
4. Permission to one who is merely a dealer to place his name on articles bearing the *trade-mark* of the manufacturer, especially if such permis-

sion was in accordance with the custom of the trade, is no indication of an abandonment of the trade-mark by the manufacturer.

5. The plaintiffs have the right to use the word "Excelsior" as a trade-mark.

Leonard Myers, Esq., attorney for Isaac A. Sheppard & Co.
P. K. Erdman and *George W. Thorn*, Esqs., attorneys for
 Stuart, Peterson & Co.

FINLETTER, J.:

In 1860 the plaintiffs commenced business. Their establishment was designated the "Excelsior Stove Works." In 1864, they began to manufacture the "Excelsior" range. They advertised largely, and it came into general use. It became very popular; so much so that parties advertising houses for sale would name the "Excelsior" range as one of the conveniences to recommend the property; and builders in Philadelphia frequently stipulated for the "Excelsior" range in their specifications. More than forty thousand were sold in fifteen years.

In 1877, the defendants began to make a range with similar characteristics, and placed upon it the words "New Excelsior," "Improved Excelsior," and "Excelsior." It differs only in external ornamentation from the plaintiffs', and is substantially the same. Its component parts correspond in size and shape with the component parts of the plaintiffs' range. The plaintiffs' range can be repaired by castings made from the patterns of the defendants' range. Upon the several parts of the defendants' range the word "Excelsior" is imprinted.

The defendants advertised in the *Public Ledger* as follows:

"Excelsior Ranges for sale. Excelsior Ranges of the different kinds and sizes, double ovens, single ovens, right and left; and hot air Excelsiors always on hand for sale to dealers and builders.

"Grates, cross-pieces, water-backs, or cast-iron fire plates, to fit all Excelsior ranges, always on hand.

"STUART, PETERSON & CO.,

"*Broad and Noble Streets.*"

In addition they placed a sign-board over their office at Broad and Willow streets, with the words "Excelsior Ranges" upon it.

It is clearly established that "Excelsior" upon plaintiffs' ranges indicated to the trade, and to the public, that such ranges were made by them. Their range is widely known to the trade and to the public as the "Excelsior" range. Builders generally connect it with the firm of Sheppard & Co., and it is generally known as Sheppard's "Excelsior."

There can be no doubt that direct injury has resulted to the plaintiffs from the conduct of the defendants. It has suggested the idea that plaintiffs had ceased to manufacture the "Excelsior" range; and that their range had been improved by the defendants.

The defendants deny that the use of the words "New Excelsior" and the "Improved Excelsior" is either intended or calculated to deceive the public or to induce them to purchase as, and for, the ranges of the plaintiffs. It may be that the defendants did not intend to deceive the public; but it can scarcely be said that these devices were not calculated to do so. What other idea is suggested by the words, "New Excelsior" and "Improved Excelsior," than that a newer improved "Excelsior" is made? It can be neither a "New Excelsior," nor an "Improved Excelsior," without suggesting an important and valuable change in the old "Excelsior." Of what use can these names be unless they call to mind the old "Excelsior?" And of what use would that be unless it also recalled the usefulness and popularity of the old? It should not be forgotten in this connection that the defendants say their "object was simply to produce a light, cheap range, which could be sold in competition with the cheap ranges of the plaintiffs."

If this were otherwise it may not be said that the assumption of the name "Excelsior" was not calculated to deceive the public, and injure the plaintiffs. It may be that the defendants did not intend to injure the plaintiffs; but if their conduct produced injury they must be held to have intended that injury. In *Horn v. Last*, 10 *Jur.*, 106, it was held, refusing a motion to dissolve an injunction, that defendants having made so complete a copy of plaintiffs' mark, must be taken to have done so with an intent to give an

advantage to which they were not entitled. Judge Paxson, in *Dixon Co. v. Guggenheim*, 7 *Phila. R.*, 408, cites English cases which held that: "A man though not intending an injury to another should not be allowed to adopt the marks by which the goods of another are designated, if the effect of adopting them would be to prejudice the trade of such other person. It is not necessary to aver or prove wrongful intent on the part of another." If, therefore, the plaintiffs are entitled to use the word "Excelsior" as a trade-mark, it would follow that the defendants should be enjoined.

The defendants contend that the plaintiffs are not entitled to claim the word "Excelsior" as applied to their ranges as a trade-mark, because—

1. Hicks, Wolf & Co., of Troy, New York, have used the same word upon flat top ranges since 1861, continuously.

2. The word is a fancy title for stoves of various kinds in the trade generally.

3. Orr, Painter & Co., made and sold similar ranges with the word "Excelsior" upon them.

4. The ranges of defendants have improvements.

5. That defendants' ranges are different.

6. The word Excelsior as used by plaintiffs does not indicate that they are owners of the ranges.

7. The plaintiffs have placed other names upon some of their ranges.

8. The plaintiffs have put the names of buyers upon the ranges in near connection with the word "Excelsior," and have thereby abandoned the word to general use.

9. Defendants have been making them for two years, and the plaintiffs did not forbid them until about a year ago.

The first and second reasons may be disposed of by the remark that the evidence shows that the ranges referred to were not the same as plaintiffs. The plaintiffs do not claim property in the word "Excelsior." Their claim is that they have first appropriated that word to a specific article of their manufacture.

To the third it may be said that it does not appear that plaintiffs permitted or acquiesced in the use of the word "Excelsior"

by Orr, Painter & Co.; or that they knew of such use of it as would imply acquiescence or permission.

It is perhaps sufficient to say that no improvement in the range or difference in appearance would justify the defendants in the use of the word "Excelsior." If the improvements and changes make a different kind of range they would have the right. But the improvement and changes have not substantially altered the character and appearance of defendants' ranges from that of the plaintiffs'.

1. It is also contended that the word "Excelsior," as used by the plaintiffs, is not a trade-mark, but a fancy name to indicate a particular kind of stove, because it does not indicate origin or ownership. To sustain this position many authorities were cited, but that which was most relied upon was *Ferguson v. Davol Mills*, 7 *Phila.*, 256, in which Allison, P. J., says: "The simplest case of a trade-mark is the name and address of the claimant, and it is absolutely requisite that a device or symbol should perform the office of a finger-board; should indicate the name and address of the manufacturer to invest it with the attribute and entitle it to the protection of a trade-mark." This language is clear, vigorous and decisive; and there can be no doubt that the cause was determined upon this principle alone. It will be seen from an examination of the authorities cited by the learned Judge, that he is not fully sustained by them in this advanced position. They affirm only that a trade-mark should indicate the "true origin or ownership of the article offered for sale." The learned Judge was justified, perhaps, in thus giving a sensible form to what was before a meaningless phrase, adopted and continued in almost every trade-mark case without necessity, without application to the cases, and without definition or explanation.

In the *Dixon Co. v. Guggenheim*, 7 *Phila.*, 408, Judge Paxson adopts as "well sustained by reason and authority," the doctrine of "true origin or ownership." In justice to him it should be observed that it was not raised in the case before him, and his attention was not directed to its full import. In his very able and carefully prepared opinion, he cites the decisions which declared "Revere House," "New York Hotel," "The Captain's Live and

Let Live Oyster and Dining Rooms," to be trade-marks. He also says: "The name of a newspaper is a trade-mark;" and with proper judicial indignation adds: "Can it be supposed that if some one were to commence the publication in this city of a *Public Ledger* of the same size, price and style as the one published by Mr. George W. Childs, that a Court of Equity, upon a proper application, would not promptly arrest the career of such a piratical craft by an injunction!" And yet neither of these words indicate "origin or ownership."

It is not now important to ascertain how and when this doctrine originated. It has been followed as an axiom. And yet to the thoughtful it must always have been a perplexing enigma.

It is submitted that in neither of the cases cited by Judge Allison is the question of "the true origin and ownership" raised, or discussed, or defined. The question raised and decided was, that words which designated the article itself, or its attributes, were not trade-marks. This is so in all the cases which we have been able to examine. As illustrative of all we may take the language of C. J. Duer, in *Amoskeag Co. v. Spear*, 2 Sand. S. C. R., 509: "A mark can only be protected as a trade-mark when it is used merely as indicating the true origin and ownership of the article offered for sale; never when it is used to designate the article itself." We may be allowed in this connection to say, that we have not been able to find any case except *Ferguson v. Davol Mills*, in which the doctrine of "true origin or ownership" is distinctly avowed.

It might, perhaps, be useful at this stage to ascertain what a trade-mark is, and what it indicates. *Stokes v. Landgraff*, 17 Barb., 608, Strong, J., says: "The principle is well settled that a manufacturer may, by priority of appropriation of names, letters, marks, or symbols of any kind to distinguish his manufacture, acquire a property therein, as a trade-mark."

"The right of trade-mark is said to be best termed an exclusive right arising from first use." *Bouvier*.

"The rule sometimes laid down on this subject is: that if a name, sign, mark, brand, label, word, or device of any kind, can be advantageously used to designate the goods, property, or

particular place of business of a person engaged in trade, manufacture, or any similar business, he may adopt and use such as he pleases, which have not before been appropriated.' *Story's Equity*, sec. 951.

"The physiology of a thing called a trade-mark must be examined and carefully analyzed. It has an individuality of nature. Meaningless in itself, when placed in a certain juxtaposition, it involves an idea. It virtually says that the vendible object to which it is attached is the workmanship or the selected article of the owner of the mark. It is intended to strike the eye, and sometimes the ear by its sound when spoken of, and thus excite inquiry. It should possess such salient features as might at once arrest attention, and put the intended purchaser on the alert." *Browne on the Law of Trade-Marks*, sec. 88.

In *The Amoskeag Manuf. Co. v. Spear*, Chief Justice Duer says: "Every manufacturer has an undoubted right to distinguish his goods by a peculiar mark or device, in order that they may be known to be his."

How is a mark or device to indicate "true origin or ownership;" or to indicate the name and address of the manufacturer? In and by itself alone this is impossible. It is only by use as the device of him, who distinguishes his goods by it, in order that they may be known as his, that it can ever indicate "true origin or ownership."

In *Allegheny Fertilizer Company v. Woodside*, 1 *Hughes*, 115, Giles, J., says: "But it is argued that the name adopted ('Eureka') did not sufficiently indicate 'origin or ownership' to be regarded as a trade-mark. This was a mistake. It served to distinguish the complainant's manufacture as effectually as names ever serve to distinguish things."

In the *Meriden Britannia Co. v. Parker*, 39 *Conn.*, 450, the trade-mark consisted of the words "1847, Rogers Bros., A. 1." The Rogers Bros. were superintendents of the petitioners. The respondents contended that the said trade-mark did not indicate the true origin of the goods. *Held*, that the representation that the Rogers Bros. were the manufacturers was true in a certain sense, but that the petitioners were in another sense the manufac

turers. "Like all other symbols and devices used as trade-marks its import was not at first perhaps fully understood. The effect as well as the value of a trade-mark is the work of time and expense. This probably was no exception to the rule. However this may be, it seems to have been well understood by the trade at the date of this petition, that goods bearing that stamp were manufactured by the petitioners. *Held*, that the trade-mark sufficiently indicated the origin and ownership of the goods."

In the *Delaware and Hudson Canal Company v. Clark*, 13 *Wallace*, 311, Strong, J., says: "Hence the trade-mark must either by itself or by association point distinctly to the origin or ownership of the articles to which it is applied. The first appropriator of a name or a device pointing to his ownership, or which by being associated with articles of trade has acquired an understood reference to the originator or manufacturer of the articles, is injured whenever another adopts the same name for similar articles."

2. In other words, the evidence must show the first appropriation of the device by the claimant, its application by him to his goods or business; and that the trade or public recognize the article or business by that device as made or sold by him, or belonging to him. In no other way can a mark or device indicate "true origin or ownership."

The evidence in this case is conclusive that the plaintiffs first appropriated the word "Excelsior" to a specific article of their manufacture; that they have continuously used it for the last fifteen years, during which time they have made and sold more than forty thousand; that the whole trade recognized them as the makers of the articles to which the word "Excelsior" was attached. This device therefore pointed out the "true origin and ownership" of the goods, and thereby became a trade-mark.

It would be useless to waste time in collating the single and collective words and devices which have been held to be trade-marks. The word "Excelsior" alone has been repeatedly held to be a good trade-mark. In *Winsor v. Clyde*, 9 *Phil.*, 513, (affirmed by the Supreme Court), "Keystone Line" was held to be a good trade-mark.

3. It is further contended that inasmuch as the plaintiffs, at the request of a few purchasers, placed another name upon a few of their ranges, and erased the word "Excelsior," they thereby abandoned their right to the use of the word as a trade-mark. These instances can only be regarded as special contracts for the goods without the trade-mark. They can in no sense be regarded as a representation to the public of the abandonment of the trade-mark and the adoption of another. It is the purchaser who changes the name, and it is nowhere held that the purchaser of an article protected by a trade-mark is bound to maintain the name upon the article. He buys for use and consumption, and may retain the mark or not as he pleases.

The province of a trade-mark is to bring seller and buyer together, that the one may sell his merchandise, and the other obtain the particular goods the reputation of which has won his confidence. When this is done the office and object of the trade-mark is accomplished. The seller has no longer any control over or interest in the article. It belongs wholly to the purchaser, and with it the incident, the trade-mark. As he may consume or destroy, or alter or change the article, so may he its name. What he may do himself, he may do by another; what he may do by another, he may do by the seller. If he can do this after purchase, he may certainly contract to have it done before purchase. This is a matter in which the general public can have no interest, and therefore have no interest or concern which should be considered. It in no way affects the usefulness of the article.

But why should it be held that the manufacturer must place the trade-mark upon all of his goods? He may prefer, for his own advantage and the protection of the public, to place it only upon his best, and leave the inferior nameless, or give them another name. Honesty and fair dealing and his own interest would suggest this. And if this be done it should not be regarded as an abandonment.

4. The evidence discloses the fact that the plaintiffs in some cases, when requested by dealers, placed the dealer's name upon the range in proximity to the word "Excelsior." It is shown, however, that this is a custom of the trade known to and acted upon

by all dealers and manufacturers. It is proved that even when the names of dealers were thus placed upon the ranges, they were still known and recognized by the trade, dealers and manufacturers, as ranges made by the plaintiffs.

It is contended that this was permitting those dealers to hold themselves out as the manufacturers of such ranges, and was therefore an abandonment.

It must be observed that there is nothing in connection with the names of these dealers to indicate that they are the manufacturers, and there is no evidence that any one ever supposed they were the manufacturers. On the contrary, there is ample evidence even in the affidavits of the defendants, that they were still regarded as manufactured by the plaintiffs. Why then should we force the inference that these names indicated the names of the manufacturers, for the benefit of one who wrongfully appropriates to himself another's industry, enterprise and property?

1 In considering acts from which acquiescence or abandonment are or may be inferred, it should not be forgotten that a trade-mark is property. In all cases of litigation, it may fairly be said to be valuable property. The man who lends his horse frequently or permits another to use it is never said to have abandoned his horse to the public, or to acquiesce in any claim to use the horse at pleasure. Much less can these acts justify the stranger who breaks into the stable and steals the horse.

What injury can arise from this practice? Who can be deceived or betrayed into any error or injury thereby? The public who buy for consumption have the article they expected, and bargained for, with its name, the trade-mark, upon it. They have in addition, as a further security, the name and indorsement of the dealer. They therefore have no cause of complaint, and the public who do not purchase, have no right to complain. What is it to the man who does not buy, or want to buy, that these names may possibly indicate that the owners of the names have the right to manufacture the ranges?

Such acts do not denote abandonment. The owner of a store does no injury to his right of property in his store, or its con-

tents, or his business, by permitting the names of some of his employees to be placed on the inside or outside of the building, as is customary in this city. The rights of property are not so easily frittered away.

It might be that acts like these, might betray a person into a violation of the right of property in a trade-mark. If they did he would be excusable, but it would confer upon him no right to further use the mark against the protest of the owner. The defendants make no such pretence as this. They do not pretend that they were induced to believe that plaintiff had conferred upon these dealers the right to manufacture the range and use the trade-mark. On the contrary, they have shown by their own evidence that they knew all about the matter, and that it was done in pursuance of a well established custom of their trade. How can the probability that the public might believe these dealers to be the manufacturers with the right to use the trade-mark, give the defendants the right to use the trade-mark when they know the fact to be otherwise.

In considering a question of trade-mark the customs of trade should not be ignored. The true doctrine, perhaps, should be to consider them in the light of and in aid of such customs.

4. What the customs of trade allows, the law should allow: for such customs must be for the general good as well as the good of the special trade, commercial custom made a promise in writing to pay in thirty days a promise to pay in thirty-three days. It is suggested then that the custom, which the plaintiffs recognized, should not work a forfeiture, especially when no one was thereby betrayed into the belief that any one, other than the plaintiffs, had manufactured the articles.

An explanation of this custom may be found in the fact that the ranges as made both by the plaintiffs and defendants are not complete for use as they make and sell them. They are not ranges to the public or to the consumer until they are set up and encased in brick, as the movements of a watch are not a watch until encased. It is the dealer who makes them fit for use. It is his trade and business to build in the ranges. When the range is completed it is his manufacture. The plaintiffs and defendants

have furnished him with only one of the component parts—one of the materials.

The manufacture of the movements of a watch may have a trade-mark for his own work; it is or may be, so far as he is concerned, a completed work. Can it be said that he loses his right to that trade-mark because he permits another manufacturer, whose business it is to extend his work to make it fit for use, to place his name upon the thing called a watch? Why then should it be said that the plaintiffs lose their right to their trade-mark for the article they furnish to the trade, because they permit the dealer who uses their article, to furnish for the public a completed range, to place his name upon it.

To the plaintiffs and the defendants the dealers are the public. The evidence shows that they are the sole purchasers. And it also shows that no dealer or other person has been deceived by the dealer's name upon the ranges into believing that he was the manufacturer of the parts made by the plaintiffs. On the contrary, the evidence of the respondents shows that even when such names are upon the ranges, they are still recognized and regarded as the ranges of the plaintiffs.

It would therefore be stretching an inference to the bounds of probability, to infer from such a license that plaintiffs had abandoned their right in the trade-mark to this community.

Even if we are altogether in error in all this, it will be observed that it is conceded that the exercise of this custom of the trade by the plaintiffs was simply a license. It needs no citation of authorities to show that a license is not an abandonment—not even evidence of abandonment. It is perhaps the highest evidence of the assertion of the right and acquiescence therein. This doctrine was recognized in *Winsor v. Clyde*, 9 *Phil.*, 513.

It has been strongly urged that the plaintiffs have lost their right of action by their delay in bringing suit, or in asserting their claim. It may be that even a wrong-doer may sometimes successfully defend upon this ground. It must, however, be such a delay as would lead a reasonable person to suppose that the owner had abandoned his device, or such as induced the defendants to act, or under such circumstances as required the owner

to assert his right. Even in such cases the title in the trade-mark is not lost or deemed abandoned, but the owner is estopped from asserting it to prevent another from using the device. It is evident therefore that each case must be decided upon its own facts. There can be no fixed rule, and time is only a matter of evidence to be considered with all others. There is no evidence in this case that the defendants were encouraged or misled into their wrongful acts, or that the plaintiffs were silent when they were called upon to speak. The evidence shows that they moved with as much celerity as was consistent with a proper vindication of their right. The delay seems to have been no greater than was necessary for a prudent, careful preparation for the legal conflict.

5. The conclusions to which we have come are, that the plaintiffs have a right to the word "Excelsior" as a trade-mark; that the defendants have wrongfully used that trade-mark to the injury of the plaintiffs, and should be enjoined therefrom.

The motion to continue the special injunction is therefore allowed.

34

IN THE UNITED STATES PATENT OFFICE.

EX PARTE HALLIDAY BROS.

DECIDED 18 JUNE, 1879.

REPORTED 16 OFFICIAL GAZETTE, 500.

"Striped Barrel" Case.

1. A "representation of a barrel consisting of light and dark wood, the staves being alternately composed of each color," cannot be registered as a trade-mark for flour packed in barrels similar to that represented in the picture, because in such application it is descriptive, not, indeed, of the quality of the flour itself separated from its package, and, therefore, not in marketable form, but of the marketable commodity, the barrel of flour. But when applied to sacks of flour, or to barrels of flour having staves all of one color, it is an arbitrary symbol, and is registrable as a trade-mark.
2. If the applicant shall by amendment exclude from the subjects of the trade-mark, flour packed in barrels with staves of different colors, they will be entitled to registration, provided they were the first to adopt the trade-mark.

INTERLOCUTORY APPEAL.

TRADE-MARK.—Application filed April 26, 1879.

Messrs. Prindle & Co., for appellants.

PAINE, *Commissioner* :

The applicants seek to register as a trade-mark for wheat flour the—

Representation of a barrel constructed of light and dark wood, the staves being alternately composed of each color.

The trade-mark is to be affixed to packages containing wheat flour manufactured by them, by stamping, printing, branding, or in any well-known manner, and is also to be used in circulars, illustrated catalogues, labels, brands, &c.

The Primary Examiner refuses registration of the trade-mark on the ground that "it does not amount to an arbitrary symbol."

1. Such a representation cannot constitute a trade-mark for flour packed in barrels similar to that represented by the picture. Such a trade-mark is inadmissible, not because the construction of a barrel is incapable of protection by a trade-mark applied to it, although it is true that it cannot be so protected, as was decided in the cases of *Moorman v. Hoge*, (1 *Sawyer*, 79), and *Harrington v. Libby*, (12 *Official Gazette*, 188), but because when applied to the flour-barrel which it represents it becomes descriptive—descriptive not of the quality of the flour itself separated from the package, and therefore not in marketable form, but of the marketable article, the barrel of flour. All who have a right to sell flour in such barrels have a right to use in their trade pictorial representations of the same barrels. But when such a representation is applied as a trade-mark to sacks of flour, or to barrels of flour having staves of one color only, it is not descriptive, but is an arbitrary symbol. And while it is true that all who have the right to vend flour in such variegated barrels have a right to place this representation on such packages and to use it in the sale of flour so packed, it is not true that all who have the right to vend flour in several different packages have a right to use a representation of one of those packages as a trade-mark for another, to the exclusion of the right of registration of such a trade-mark for such a package in favor of the applicant who first adopted it.

If the applicants shall by amendment exclude from the subjects of the trade-mark flour packed in barrels with staves of different

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colors they will be entitled to registration, provided they were the first to adopt the trade-mark.

The decision of the Primary Examiner refusing to register the representation of the trade-mark for "wheat flour," without regard to the packages in which it may be sold, is affirmed.

35

IN THE UNITED STATES PATENT OFFICE.

EX PARTE CONSOLIDATED FRUIT JAR COMPANY.

DECIDED 26 AUGUST, 1879.

REPORTED 16 OFFICIAL GAZETTE, 679.

Mason's Fruit Jar Case.

1. The name of a patented article which was a valid common law trade-mark in 1870, cannot be registered for a period to extend beyond the expiration of the patent in favor of an applicant who is not the owner of the trade-mark or the patent.
2. The word "Mason," in the collocation "Mason's Fruit Jar," was a valid trade-mark at common law in 1870.
3. The validity of a common law trade-mark is not affected by the fact that the owner of the trade-mark is also the owner of a patent covering the article to which the trade-mark is applied. The expiration of the patent does not terminate the existence of the trade-mark.
4. An assignee of a common law trade-mark which was in use before 1870, and of a patent covering the article to which the trade-mark was applied, is protected by the statutory provisions, which preserves the right to register common law trade-marks which were in use before 1870.
5. While the fact that a term has become generic is fatal to its subsequent adoption as a trade-mark, it is not fatal to its continued use, nor to its registration by the lawful assignee of those whose use rendered it gen-

eric any more than to its continued use or registration by the assignors themselves.

APPEAL from the Examiner of Trade-Marks.—Rehearing.

TRADE-MARK.—Application of Consolidated Fruit Jar Company, filed April 12, 1877.

Messrs. Foster & Co., for appellants.

PAINE, *Commissioner* :

Applicant demands registration of trade-mark consisting of the word "Mason" in the collocation "Mason's Fruit Jar." The application has been rejected on two grounds: First, that the name of a patented article is incapable of use as a lawful trade-mark after the expiration of the patent; and second, that the name "Mason" had by long use, become generic in its application to fruit-jars.

The denial of registration by the Examiner and Assistant Commissioner, based upon these grounds, was authorized by the record of the case as it stood at the time of the rejection, and as it now stands. While the sworn application showed that the applicants had adopted this trade-mark, it did not then, and does not now, show that they had used it a single day. It not only did not show that they had obtained the trade-mark by assignment from those who had used it before 1870, but by the averment that the applicants had adopted the trade-mark, it negated such an acquisition.

It is true the application sets forth that the trade-mark has been used seventeen years, but the applicants do not aver that it has been used by them or by their assignors. The averments taken together are consistent with an authorized adoption of a trade-mark which had been used by others, and the word "adopt," is inconsistent with the idea of an assignment. The applicants, therefore, occupy on the record the attitude of third persons seeking the registration as a trade-mark of the name of a patented

article for a period of time which would extend beyond the life of the patent, which name had become generic by long use.

1. But now the applicants assert that by assignment they have become the owners, not only of certain patents with which this trade-mark has been associated, but also of the trade-mark itself, and that it has been used by their assignors seventeen years; that it was used as a common law trade-mark nearly eight years before 1870.

2. This was a valid trade-mark at common-law, subject, of course, to the rights of other persons of the same name, whatever they might be.

3. The fact that the owners of the trade-mark also owned certain patents with which it was connected did not change its character as a common law trade-mark. Nor would the expiration of these patents, even if they had covered the article as a whole, and not merely certain parts of it, have terminated the existence of the trade-mark which had been used during the life of the patent.

4. If the applicants are the legal assignees of the patents and of the trade-mark, they are protected by the statutory provision which preserves the right to register common law trade-marks which were in use before 1870.

5. While the fact that the term has become generic would be fatal to its subsequent adoption by these or any other applicants, it certainly is not fatal to its continued use or to its registration by the lawful assignees of those whose use rendered it generic, any more than to its continued use or registration by the assignors themselves. Otherwise a trade-mark, as soon as it should become valuable enough to be generic, would expire.

If the applicants shall so amend their application as to show in their oath that they are the assignees of this trade-mark; that it has been used by their assignors for seventeen years, and that they are also the lawful assignees of the patents relating to parts of this fruit-jar, under which the jar bearing the trade-mark in question has been sold, they will be entitled to registration.

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CIRCUIT COURT UNITED STATES, DISTRICT
OF CALIFORNIA. IN EQUITY.

JAMES S. TAYLOR

vs.

HENRY E. BOTHIN.

DECIDED 1 SEPTEMBER, 1879.

REPORTED 5 SAWYER, 584.

"Mrs. Mills' Cream" Case.

- I. JOINT TRADE-MARK. Where two persons, associated in business for the manufacture and sale of a commodity, jointly adopted a trade-mark for it, they are equally entitled to its use after the dissolution of their connection; and if one of the parties obtain letters of registration in his own name, he may be compelled to transfer an equal interest to his associate.

THIS was a suit in equity to compel the defendant to transfer to the complainant letters of registration by which a right to use a certain trade-mark was obtained. The facts appear in the opinion of the Court.

John L. Boone, for complainant.

David Freidenrich, for defendant.

MR. JUSTICE FIELD :

It appears from the evidence in this case that, previous to the first of August, 1876, the complainant had discovered a process for making a valuable yeast powder, and that during that year he was engaged under a contract with other parties in its manufacture and sale in the City of San Francisco, designating the powder as Sea Moss baking powder; that his contract with his associates having come to an end from their inability to furnish the required means, he applied to the defendant and proposed a connection with him in its manufacture and sale. At the time the defendant was engaged in the business of selling coffee and spices, and knew nothing about the manufacture of yeast powders. After satisfying himself of the quality of the powder, the defendant agreed to give the complainant space in his establishment for its manufacture, the defendant to sell it as sole agent. As the complainant was without means and had a family to support, it was stipulated that he should receive an advance of ten dollars a week for four weeks, and if the business proved a success he was afterwards to receive one-half of the profits. The business proved a success, and at the end of the first year the parties agreed to continue their connection for another year, with a stipulation that the complainant should relinquish his half interest in the profits of the yeast powder business, and receive in return one-fourth of the profits of the entire business of the defendant, including that arising from the manufacture and sale of the yeast powders and that arising from dealing in coffee and spices.

After the first arrangement was made between the parties, and before any powders were manufactured, the complainant informed the defendant that another designation than that of Sea Moss should be given to the powder, as his former associates might lay some claim to the use of that designation. The name of "Mrs. Mills's cream" for that of Sea Moss was accordingly suggested and adopted. The powders manufactured and sold under the name of "Mrs. Mills's cream yeast powders" came into general use, and the business accordingly became very profitable.

During the second year of the connection, after a large demand for the powders had been created, the defendant, apparently apprehensive that the complainant might withdraw the manufacture from his establishment, secretly applied to the Patent Office at Washington and obtained letters of registration, giving him an exclusive right to the use of the name, "Mrs. Mills's cream," as a trade-mark of the powders. The complainant, therefore, brings this suit, and prays the Court to adjudge the trade-mark to be his property, and to order the defendant to transfer the letters of registration to him, or that such other and further relief may be granted as the nature of the case may require.

Upon the statement of these facts, the only serious question for deliberation is whether the complainant is entitled to the exclusive use of the trade-mark or only to a joint or equal use of it with the defendant. Had the name been suggested and used by the complainant before the business connection with the defendant, there would be no doubt of his exclusive right to it. But having been suggested and adopted after that connection was formed, upon a consultation of the parties on the subject, and then used for their joint benefit, we are led to the conclusion that they are equally entitled to its use after that connection ceased. Clearly the defendant has no such exclusive right, and the representations which he must have made to obtain the letters of registration required by law, "that no other person, firm or corporation" had the right to use, are inconsistent with the facts. It matters not whether the arrangement between the parties constituted a partnership, or whether the complainant was to receive a portion of the profits of the business as his salary; in either case, it was his process of making a valuable powder, which was to be used, and it was to his discovery that the name was to be given. We do not understand that when the complainant said he gave his process to the defendant he intended to abandon all right to the use of it, and to the manufacture of the powder designated by its new name, but only that he made the defendant acquainted with the secret of the process—the manner in which the powder was to be made. Having imparted that knowledge, and the two, in conjunction,

having subsequently adopted the name, they must be regarded as equally having the right to use it.

A decree must be entered for the complainant, adjudging him equally entitled with the defendant to the use of the trade-mark in question, and directing the defendant to execute a transfer to the complainant of an equal interest in the letters of registration, and it is so ordered.

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IN THE UNITED STATES PATENT OFFICE.

EX PARTE PACE, TALBOT & CO.

DECIDED 17 SEPTEMBER, 1879.

REPORTED 15 OFFICIAL GAZETTE, 909.

"Bayard" Tobacco Label Case.

1. The name "Bayard" and portrait of a United States Senator by that name held to be proper matter for a trade-mark in chewing tobacco.
2. Any proper word or phrase, whether the name of a person, firm or corporation, or a geographical term; may be registered as a trade-mark unless the same is descriptive of the quality of the goods, or is the name of the applicant or manufacturer, or place of manufacture, or is deceptive.
3. The name of the applicant or the firm manufacturing the goods cannot be registered as an essential part of the mark.

APPEAL from the Examiner of Trade-Marks.

TRADE-MARK.—Application of Pace, Talbot & Co., filed July 21, 1879.

Mr. Wm. H. Brown, for appellant.

DOOLITTLE, Acting Commissioner:

The applicants' alleged trade-mark is described as consisting—

1. Of the name "Bayard," in connection with the portrait within an oval, intended to represent a Senator of the United States of that name, from the State of Delaware, and beneath it is our firm-name. Said name "Bayard" and portrait may be transposed, as may also our firm-name, without materially changing the character of our trade-mark, the essential features of which are "Bayard" and the portrait.

The mark is to be applied to chewing tobacco manufactured by Pace, Talbott & Co., of Danville, Virginia.

Section 4939 of the Revised Statutes provides that—

The Commissioner of Patents shall not receive and record any proposed trade-mark which is not and cannot become a lawful trade-mark, or which is merely the name of a person, firm, or corporation, unaccompanied by a mark sufficient to distinguish it from the same name when used by other persons.

In regard to the phrase "merely the name of a person, firm, or corporation," *Browne* in his work on *Trade-Marks*, holds as follows:

2. This has been construed to mean the name of the party applicant. In some instances the Courts have held that the names of historical persons of note could be used as fancy names, and, therefore, be valid trade-marks. In one instance the proposed mark consisted of the word "Alexina." The Special Examiner refused registration because "Alexina" is merely the name of a woman, and cited instances. This decision was reversed on appeal to the Commissioner in person, who held that the name was an arbitrary symbol as used by the applicant.

In another case, where an applicant had used for the period of twenty-one years, as a trade-mark for bridle-bits and stirrups, the word "Daniel," as a fanciful name, it was admitted to registry. If this word "Daniel" were the name of the applicant, it would not be valid for the purpose, but being a pure designation of fancy—meaning, mayhap, him who was thrown into the den of lions—these is no objection to it. Even if another person, whose real name is Daniel, were to set up in a similar business, he would not be permitted to stamp his goods with the simple name adopted as

above stated, but would be compelled by a Court of Equity, if he used it at all, to use with it some distinguishing mark, or his initials, to avoid the possibility of confusion. (Secs. 348, 349).

I regard this a correct construction of the statute. In decisions cited by the Examiner, especially *Porrier's Case*, the names of the applicants and manufacturers of the goods were sought to be incorporated as an essential part of the mark, and it was not held that the name of an individual, firm, or corporation, when merely arbitrary and fanciful in its signification, could not be the proper subjects of a trade-mark. It is not intended that any proper word, whether the name of a person, firm, or corporation, or a geographical or other term, be denied registration as a trade-mark, unless the same is descriptive of the quality of the goods, or is the name of the applicant or manufacturer, or place of manufacture, or is deceptive.

It would render the statute ridiculous to construe it literally. Although the name Socrates and Plato have been and may be the names of persons, yet, when applied to soap and chewing tobacco, for instance, would hardly be regarded as objectionable trade-marks, if it appeared that they were not the names of the applicants or manufacturers.

The United States Supreme Court in *Canal Co. v. Clark* (13 Wallace, 311) announces the general doctrine, as follows :

“Words in common use, with some exceptions, may be adopted, if at the time of their adoption they were not employed to designate the same or like articles of production. The office of a trade-mark is to point out distinctively the origin or ownership of an article to which it is affixed, or, in other words, who are the producers. This may in many cases be done by a name, a mark, or a device well known, but not previously applied to the same article.”

In mentioning the exceptions to this rule, the Court held that a person has no right to the exclusive use of any words, letters, or symbols which are meant to indicate their names or quality, or which, from the nature of the fact they are used to signify, others may employ with equal truth, and, therefore, have an equal right

to employ for the same purpose; and that these objections applied with equal force to geographical and other words and names.

No individual or firm can prevent others of the same name from applying that name to the same class of goods actually made by them, unless the effect in the particular instance is to deceive the public.

The distinction made by the statute between the mark which is to accompany the name of the person, firm; or corporation, and the name itself, is clear, and it is entirely inconsistent with its plain language to hold that such arbitrary mark and the name are on the same footing, and that both are essential parts of the mark. Of course the mark must always be accompanied by the name of the person, firm, or corporation using it, or intending to use it, otherwise neither the office nor the public would be informed of the origin or ownership of the goods to which the trade-mark is to be applied, and this is its sole office.

The peculiar arbitrary, selected matter constituting the essential mark is in itself the subject of assignment. It may pass from one hand to another—be to-day borne by one firm and to-morrow by another—but the mark itself remains the same and is not changed by the company it keeps.

3. In conclusion, it is held that the name sought to be registered by applicants is an entirely fanciful and arbitrary designation, and a proper subject of a trade-mark, but the name of the firm must not be represented as constituting an essential part thereof.

Sorg vs. Welsh.

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IN THE UNITED STATES PATENT OFFICE.

PAUL J. SORG

vs.

HENRY WELSH.

DECIDED 19 SEPTEMBER, 1879.

REPORTED 16 OFFICIAL GAZETTE, 910.

“Tidal Wave” Tobacco Label Case.

1. A concession of priority of adoption, use and right of a trade-mark amounts to an acknowledgment of ownership by the one giving it, in the one to whom it is given.
2. Where one who has obtained the registration of a trade-mark for an entire class of merchandise is found to be the proprietor of the mark for part only of the class, it would seem that his registration was void, in view of the doctrine of *Smith v. Reynolds*, (3 *Official Gazette*, 214).
3. Different persons may apply the same mark to different kinds of goods in the same class, provided their nature and resemblance are not so nearly the same as that the identity of the trade-mark would deceive the public as to origin or ownership.
4. Where the registered trade-mark covered the class of manufactured tobacco broadly, and the later applicant confined his application to plug-tobacco, the declaration, as in other interference cases, should have been confined to the issue made by the later applicant.

5. If there is not sufficient distinction between fine cut chewing-tobacco and plug-tobacco to justify registration of the same mark for both kinds by different parties, then a concession of adoption for plug-tobacco would be an acknowledgment of ownership of the mark on chewing-tobacco.

APPEAL from the Examiner of Trade-Marks.

TRADE-MARK.—Application of Paul J. Sorg, filed March 27, 1879. Registration of Henry Welsh, July 15, 1879.

Mr. Jas. L. Norris, for Sorg.

Mr. Edwin H. Brown, for Welsh.

DOOLITTLE, *Acting Commissioner*:

July 15, 1879, there was registered in behalf of Henry Welsh, of New York, a trade-mark upon tobacco consisting of the words "Tidal Wave." The registration appears to have been for the entire class of manufactured tobacco, as the specification states that it is appropriated to long and short cut smoking-tobacco, plug and other chewing-tobacco, cigars and cigarettes.

March 27, 1879, Paul J. Sorg, of Middletown, Ohio, applied for the registration of the same trade-mark, restricting his application to plug chewing-tobacco; whereupon the Examiner of trade-marks declared an interference June 25, 1879.

July 14, 1879, Welsh, the registrant, filed the following document signed by himself:

I hereby concede to Paul J. Sorg, priority of adoption, use and right on the word symbol "Tidal Wave" as a trade-mark for plug-tobacco.

Both parties now seek to give this concession force, and avoid the further continuance of the interference, by a motion to "reform the issue" and restrict the same to "plug chewing-tobacco."

The concession was dated New York, July 8, 1879.

1. It is something more than a mere concession of priority as generally understood, and amounts to an acknowledgment of ownership by Welsh in Sorg of the trade-mark for one species of

the general class of manufactured tobacco to which Welsh had appropriated the same.

It is manifest, therefore, that Welsh had, at the time of the registration of the words "Tidal Wave" as a trade-mark for manufactured tobacco generally, no right to the broad use of it, as claimed. Such being the case, the doctrine applied by the Court in the case of *Smith v. Reynolds and Jacobs* (3 *Official Gazette*, 214) to a similar state of facts is here pertinent.

2. It having been shown that the plaintiffs had registered their trade-mark for the class of "paints" generally, but that the defendants were the prior owners and users of the trade-mark upon a particular description of paints, the Court held :

The plaintiffs have not restricted themselves to any particular description of goods comprised in such class. Their registration must stand or fall as a whole for that to which they declare in their registration they intend to appropriate it. There is no provision in regard to trade-marks, such as there has been and is in regard to patents for inventions, that the suit may be maintained where the grant is valid as to a part but not as to the whole. It follows, therefore, that the registration of this trade-mark in the form in which it was made conferred no right on the plaintiffs in respect to anything purporting to be covered by it.

It would follow, it seems, from this doctrine, that Welsh, not being the owner of the trade-mark for all the species of manufactured tobacco on which he received registration, procured an invalid registration; and, as the statute contemplates registration to the rightful owner only, the mark in question should be registered as the property of Sorg on the article of plug-tobacco. But it is not necessary to rest the case upon the above doctrine.

3. Applicants are not compelled to register a trade-mark upon a whole class of goods, but may restrict it to a particular description of goods within that class. The law requires, in fact, that an applicant shall state the particular description of goods comprised in the class to which he applies, or intends to apply, his trade-mark.

Different persons may apply the same mark to different sorts of goods in the same class, provided the nature and resemblance of

the goods are not so nearly the same as that the identity of the trade-mark would deceive the public as to their origin or ownership.

Now, the later applicant, Sorg, had restricted himself to use of the trade-mark on plug-tobacco. There is a well recognized distinction in the trade and among consumers between fine-cut chewing-tobacco and plug-tobacco, and as the interference arose solely on the last application, the issue, as declared by the Examiner of Trade-marks, was unnecessarily broad.

4. It should have been confined, as all other interferences should be, to the precise issue made by the later applicant. So confined, the concession of Welsh would have force, and the continuation of an inference undesired by both parties avoided.

5. Or, admitting, as contended by the Examiner of Trade-marks, that there is not sufficient distinction between fine-cut chewing-tobacco and plug-tobacco to justify registration of the same mark for both, then the concession of Welsh should have force, as it would be a substantial acknowledgment of ownership in Sorg to the trade-mark in question on "chewing-tobacco."

Examiner's decision reversed.

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SUPREME COURT OF THE UNITED STATES.

MANUFACTURING COMPANY*vs.*TRAINER.

DECIDED OCTOBER, 1879.

REPORTED 101 U. S., 51.

“Amoskeag” Case.

1. Letters or figures affixed to merchandise by a manufacturer, for the purpose of denoting its quality only, cannot be appropriated by him to his exclusive use as a trade-mark.
2. An injunction will not be granted at his suit to restrain another manufacturer from using a label bearing no resemblance to the complainants, except that certain letters, which alone convey no meaning, are inserted in the centre of each, the dissimilarity of the labels being such that no one will be misled as to the true origin or ownership of the merchandise.

APPEAL from the Circuit Court of the United States for the Eastern District of Pennsylvania.

The facts are stated in the opinion of the Court.

Mr. George M. Dallas and *Mr. James E. Gowen*, for the appellant.

Mr. Samuel Dickson, contra.

Mr. JUSTICE FIELD, delivered the opinion of the Court:

This is a suit in equity to restrain the defendants, D. Trainer & Sons, from using on ticking manufactured and sold by them the letters "A. C. A." in the sequence here named, alleged by the complainant to be its trade-mark, by which it designates ticking of a particular quality of its own manufacture; and to compel the defendants to account for the profits made by them on sales of ticking thus marked.

It appears that the complainant, the Amoskeag Manufacturing Company, a corporation created under the laws of New Hampshire, commenced the manufacture of ticking at Amoskeag Falls, in that State, some time prior to 1834, and marked its products with a label or ticket consisting of a certain device, within which were printed, in red colors, the name of the company, its place of manufacture, the words "Power Loom," and in the centre the single letter "A" or "B" or "C" or "D," according to the grade of excellence of the goods, the first quality being indicated by the first letter and the decreasing quality from that grade by subsequent letters in the alphabet. The device, apart from the words mentioned, was a fancy border in red colors, square outside and elliptical within, and the words in the upper and lower lines of the label were printed in a line corresponding with the inside curve of the border.

In the year 1834, or about that time, the company introduced an improvement in its manufacture, by which it produced a grade of ticking superior to any which it had previously manufactured. For the goods of this quality it used in its label or ticket, in place of the single letter "A," the three letters "A. C. A." The original device, with its colored border and printed words, indicating the company by which and the place where the goods were manufactured and retained; the alteration consisting in the substitution of the three letters "A. C. A." in place of the single letter "A." Subsequently the company changed its place of manufacture from

Amoskeag Falls to Manchester, in the same State, and a corresponding change was then made in the label. The three letters mentioned were placed in the label or ticket on all goods of the very highest quality manufactured by the complainant, the single letter being retained in the labels placed on other goods to indicate a lower grade or quality. The combination of the three letters was probably suggested, as is stated, by the initials of the words in the company's name,—Amoskeag Company,—with the letter “A” previously used, to denote the best quality of goods it manufactured. It is contended by the complainant that the combination was adopted and used to indicate, not merely the quality of the goods, but also their origin as of the manufacture of the Amoskeag Company. It is upon the correctness of this position that it chiefly relies for a reversal of the decree dismissing the bill.

On the part of the defendants the contention is that the letters were designed and are used to indicate the quality of the goods manufactured and not their origin; that it was so adjudged many years ago in a case to which the company was a party in the Superior Court of the City of New York, which adjudication has been generally accepted as correct, and acted upon by manufacturers of similar goods throughout the country: and that the letters, as used by the defendants on a label or ticket having their own device, and in connection with words different from those used by the complainant, do not mislead or tend to mislead any one as to the origin of the goods upon which they are placed.

The general doctrines of the law as to trade-marks, the symbols or signs which may be used to designate products of a particular manufacture, and the protection which the Courts will afford to those who originally appropriated them, are not controverted. Every one is at liberty to affix to a product of his own manufacture any symbol or device, not previously appropriated, which will distinguish it from articles of the same general nature manufactured or sold by others, and thus secure to himself the benefits of increased sale by reason of any peculiar excellence he may have given to it. The symbol or device thus becomes a sign to the public of the origin of the goods to which it is attached, and an

assurance that they are the genuine article of the original producer. In this way it often proves to be of great value to the manufacturer in preventing the substitution and sale of an inferior and different article for his products. It becomes his trade-mark, and the Courts will protect him in its exclusive use, either by the imposition of damages for its wrongful appropriation or by restraining others from applying it to their goods and compelling them to account for profits made on a sale of goods marked with it.

The limitations upon the use of devices as trade-marks are well defined. The object of the trade-mark is to indicate, either by its own meaning or by association, the origin or ownership of the article to which it is applied. If it did not, it would serve no useful purpose either to the manufacturer or to the public; it would afford no protection to either against the sale of a spurious, in place of the genuine article. This object of the trade-mark and the consequent limitations upon its use are stated with great clearness in the case of *Canal Company v. Clark*, reported in 13 *Wallace*. There the Court said, speaking through Mr. Justice Strong, that "no one can claim protection for the exclusive use of a trade-mark or trade name which would practically give him a monopoly in the sale of any goods other than those produced or made by himself. If he could, the public would be injured, rather than protected, for competition would be destroyed. Nor can a generic name or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, be employed as a trade-mark, and the exclusive use of it be entitled to legal protection." And a citation is made from the opinion of the Superior Court of the City of New York in the case of the present complainant against Spear, reported in 2 *Sandford*, that "the owner of an original trade-mark has an undoubted right to be protected in the exclusive use of all the marks, forms, or symbols that were appropriated as designating the true origin or ownership of the article or fabric to which they are affixed; but he has no right to the exclusive use of any words, letters, figures, or symbols which have no relation to the origin or ownership of the goods, but are only meant to indicate their names or quality."

1. "He has no right to appropriate a sign or symbol, which from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose."

Many adjudications, both in England and in this country, might be cited in illustration of the doctrine here stated. For the purpose of this case, and in support of the position that a right to the exclusive use of words, letters, or symbols, to indicate merely the quality of the goods to which they are affixed cannot be acquired, it will be sufficient to refer, in addition to the decisions mentioned in *Wallace* and *Sandford*, to the judgment of the Vice-Chancellor in *Raggett v. Findlater*, where an injunction to restrain the use by the defendants upon their trade label of the term "Nourishing Stout," which the plaintiff had previously used, was refused on the ground that "nourishing" was a mere English word denoting quality. *Law Rep.*, 17 *Eq.*, 29. Upon the same principle letters or figures which, by the custom of traders, or the declaration of the manufacturer of the goods to which they are attached, are only used to denote quality, are incapable of exclusive appropriation; but are open to use by any one, like the adjectives of the language.

If, now, we apply the views thus expressed to the case at bar, we shall find the question involved to be of easy solution. It is clear from the history of the adoption of the letters "A. C. A." as narrated by the complainant, and the device within which they are used, that they were only designed to represent the highest quality of ticking which is manufactured by the complainant, and not its origin. The device previously and subsequently used stated the name of the manufacturer, and no purpose could have been subserved by any further declaration of that fact. And besides, the letters themselves do not suggest anything, and require explanation before any meaning can be attached to them. That explanation when made is that they are placed in the device of the company when it is affixed to the finest quality of its goods, while single letters are used in the same device when it is attached to goods of an inferior quality. They are never used by themselves, but merely as part of a device containing, in addition to the

border in red, several printed terms. Alone the letters convey no meaning; they are only significant as part of the general device constituting the trade-mark. Used in that device to denote only quality; and so understood, they can be used by others for a similar purpose equally with the words "superior" or "superfine," or other words, or letters, or figures having a like signification.

We are aware that there is in the record the testimony of several witnesses to the effect that they understood that the letters were intended to indicate the origin as well as the quality of the goods to which they were attached, but it is entirely overborne by the patent fact that the label previously disclosed the name in full of the manufacturer and by the history of the adoption of the letters, as narrated by the complainant. As it was pertinently observed in the case in *Sandford*, if purchasers of the ticking read the name of the company, the letters can give no additional information, even if it be admitted that they are intended to indicate the name of the company. And if they do not read the name as printed, the letters are unintelligible. If an explanation be asked of their purpose in the label, the only reasonable answer which can be given is the one which corresponds with the fact that they are designed merely to indicate the quality of the goods.

But there is another and equally conclusive answer to the suit.

2. The label used by the defendants is not calculated to mislead purchasers as to the origin of the goods to which it is attached. It does not resemble the device of the complainant. Its border has a different figure; it is square outside and inside. It has within it the words "Omega," and "Ring Twist," as well as the letters "A. C. A." Neither the name of the complainant, nor of the place where its goods are manufactured, nor the words "Power Loom" are upon it. The two labels are so unlike in every particular, except in having the letters "A. C. A." in their centre, that it is impossible that any one can be misled in supposing the goods, to which the label of the defendants is attached, are those manufactured by the complainant. The whole structure of the case thus falls to the ground. There is no such imposition practised upon the public, and no such fraud perpetrated upon the manufacturers, in attempting to dispose of the goods of one

as those of another, as to call for the interposition of a Court of Equity.

Decree affirmed.

Mr. JUSTICE CLIFFORD, dissenting:

Symbols or devices used by a manufacturer or merchant to distinguish the products, manufactures, or merchandise which he produces, manufactures, or sells, from that of others, are called and known by the name of trade-marks. They are used in order that such products, manufactures, or merchandise may be known as belonging to the owner of the symbol or device, and that he may secure the profits from its reputation or superiority. (15 *Am. Cyclopaedia*, 832).

Equity Courts in all civilized countries have for centuries afforded protection to trade-marks, the object of such protection being not only to secure to the individual the fruits of his skill, industry, and enterprise, but also to protect the public against fraud.

Property in a trade-mark is acquired by the original application to some species of merchandise or manufacture, of a symbol or device not in actual use, to designate articles of the same kind or class.

Devices of the kind, in order that they may be entitled to protection in a Court of Equity, must have the essential qualities of a lawful trade-mark; but if they have, the owner becomes entitled to its exclusive use within the limits prescribed by law, the rule being that he who first adopts such a trade-mark acquires the right to its exclusive use, in connection with the particular class of merchandise to which its use has been applied by himself or his agents.

Prior use is essential to any such exclusive claim, as the right to protection begins from such actual prior use; nor does the right to protection extend beyond the actual use of the device. Hence the use of it on one particular article of manufacture or merchandise will not prevent another from using it on another and different class of articles, the rule being strictly applied that

the right to protection in equity is limited to the prior use of the symbol by the owner.

Sufficient appears to show that the plaintiffs, at an early period in the fourth decade of the present century, engaged in the manufacture of a fabric known as ticking, of various grades and quality, and that subsequently they made a valuable improvement in the mode of manufacturing the fabric, which enabled them to produce a very superior article. Before the introduction of the improvement they had been in the habit of marking their products in that species of manufacture with one of the first four letters of the alphabet, to designate the different grades of their manufacture when offered for sale in the market. Thirty-four years ago or more they introduced the new improvement in the manufacture of the fabric, and adopted the distinctive trade-mark, of which a fac-simile is exhibited in the transcript. When examined, it will be seen that it consists of the corporate name of the complainants, with a rough engraved surrounding, and the letters "A. C. A." plainly and conspicuously printed in the centre of the circular outside edge.

Conclusive proof is exhibited that the peculiar combination of letters adopted by the complainants as a symbol of trade originated with them, and that it suggested itself to them as comprising the initial letters of their familiar corporate name, with the addition of the letter "A" at the close, which had previously been used by them as indicating the best quality of the fabric manufactured by them before they made the alleged improvement,

Single letters of the kind are frequently used as a mark of quality; but the proofs in this case show to a demonstration that the peculiar combination of letters adopted by the complainants at the period mentioned, were not adopted to denote quality merely, but as an appropriate and distinguishing trade-mark, symbol, or device, to indicate to the public and to purchasers that the fabric which bears the mark was of the manufacture of the manufacturing company of the complainants. Beyond all doubt, they adopted the symbol or device, and affixed it to the fabric of their trade to indicate the origin and ownership of the article.

Few manufactured products bear in their own external appearance sufficient evidence of their real character to protect the purchaser against fraudulent imitations. Integrity in manufacture and uniformity in quality are high recommendations to purchasers, and manufactured goods falling within that category are much preferred, both by the purchasers and consumers of the same; and when by long experience the public have learned to associate these elements of recommendation with a special symbol or brand, the wide and profitable sale of the articles bearing the same is assured, and the exclusive possession and use of the symbol or brand becomes of great value to the real owner. Purchasers are also interested that such a trade-mark should receive protection, as it is a guaranty of genuineness, and its value is proportioned to the business reputation of the owners of the same and of the excellence of their manufactures. 4 *Johns. Cyclopaedia*, part 2, p. 916.

Infringement by the respondents is charged, and the complainants pray for an injunction and for an account. Service was made, and the respondents appeared and set up various defences, as follows: 1. That the alleged trade-mark was never designed or used as such, but merely to designate one of the grades of the fabric which the complainants manufactured. 2. That the complainants are estopped by a prior decision of a Court of competent jurisdiction to set up that the alleged symbol is a trade-mark. 3. They admit that they mark their goods with the letters "A. C. A.," but they deny that the mark is fraudulent or that it is calculated to deceive the public. 4. They deny that their conduct is in the slightest degree fraudulent or inequitable, or that the sale of their goods injures the complainants.

Proofs were taken, hearing had, and the Circuit Court entered a decree dismissing the bill of complaint. Prompt appeal was taken by the complainants to this Court, and they assign the following causes of error: 1. That the Circuit Court erred in entering a decree dismissing the bill of complaint. 2. That the Court erred in not granting the injunction as prayed. 3. That the Court erred in not decreeing that the complainants are entitled to an account. 4. That the Court erred in not sustaining the bill of complaint.

Attempt is made in argument to show that the symbol of the complainants was not adopted by them for any other purpose than to designate the grade or quality of the fabric which they manufacture and sell in the market; but it is a sufficient answer to that proposition to say that it is wholly unsupported by evidence, and is decisively overthrown by the proof introduced by the complainants.

Words or devices, or even a name in certain cases, may be adopted as a trade-mark which is not the original invention of the party who appropriates the same to that use. Phrases, or even words or letters in common use, may be adopted for the purpose, if at the time of their adoption they were not employed by another to designate the same or similar articles of production or sale. Stamps or trade-marks of the kind are employed to point to the origin, ownership, or place of manufacture or sale of the article to which it is affixed, or to give notice to the public who is the producer, or where it may be purchased. *Canal Company v. Clark*, 13 Wall., 311, 322.

Subject to the preceding qualifications a trade-mark may consist of a name, symbol, figure, letter, form, or device, if adopted and used by a manufacturer or merchant in order to designate the goods he manufactures or sells, or to distinguish the same from those manufactured or sold by another, to the end that the goods may be known in the market as his, and to enable him to secure such profits as result from his reputation for skill, industry, and fidelity. *Upton, Trade-Marks*, 9; *Taylor v. Carpenter*, 2 Sandf., (N. Y.), Ch., 603.

Brands or stamps called trade-marks, says Waite, may consist of a name, figure, letter, form, or device, adopted and used by a manufacturer or merchant in order to designate the goods that he manufactures or sells, and to distinguish them from those manufactured or sold by another, to the end that they may be known in the market as his, and thus enable him to secure such profits as result from a reputation for superior skill, industry, or enterprise. 6 *Waite, Actions and Defences*, 21.

Such a manufacturer or merchant who first adopts such a trade-mark, and is accustomed to affix the same to a particular fabric

of his manufacture or sale to distinguish it from all others, has a property in it, and may maintain an action for damages if used by another, or he may restrain another from using by application to a Court of Equity. *Hall v. Barrows*, 4 De G., J. & S., 140, 156; S. C., 12 W. R., 322, 323.

Judicial protection is granted in such a case upon the ground that the honest, skillful, industrious manufacturer or enterprising merchant who has produced or brought into the market an article of use or consumption that has found favor with the public, and who by affixing to it some name, mark, device, or symbol which serves to distinguish it as his and from that of all others, shall receive the first reward of his honesty, skill, or enterprise, and shall in no manner and to no extent be deprived of the same by another who to that end appropriates the same, or a colorable imitation of the same to his production, so that the public are or may be deceived or misled. *Wolfe v. Barnett & Lion*, 24 La. An., 97; *Newman v. Alvord*, 15 N. Y., 189, 196; *Lee v. Haley*, Law Rep., 5 Ch. Ap., 155; *Blackwell v. Wright*, 73 N. C., 310, 313.

Nothing can be better established, says the Master of the Rolls, and nothing ought to be otherwise than fully established in a civilized country, than that a manufacturer is not entitled to sell his goods under the false representation that they are made by a rival manufacturer. *Singer Manufacturing Co. v. Wilson*, 2 Ch. D., 434, 440; *Browne, Trade-Marks*, sec. 385; *Osgood v. Allen*, 1 Holmes, 185, 194,

“When we consider,” says Duer, “the nature of the wrong that is committed when the right of property in a trade-mark is invaded, the necessity for the interposition of a Court of Equity becomes more apparent. He who affixes to his own goods an imitation of an original trade-mark, by which those of another are distinguished and known, seeks by deceiving the public to divert to his own use the profits to which the superior skill and enterprise of the other had given him an exclusive title, and endeavors by a false representation to effect a dishonorable purpose by committing a fraud upon the public and upon the true owner of the trade-

mark. *Amoskeag Manufacturing Co. v. Spear*, 2 Sandf., (N. Y.), 599, 605; *The Collins Company v. Brown*, 3 Kay & J., 223, 428.

Thirty years and more before the suit was commenced the plaintiff company adopted the trade-mark in question and affixed the same to their improved manufacture of ticking, and it appears from the evidence that they have continuously from that date to the day the bill of complaint was filed, used the same as the symbol to designate that peculiar manufacture, which of itself is sufficient to show, if any thing in the nature of proof can be, that the first defence set up in the answer ought to be overruled.

Much discussion of the second defence cannot be required, as the statement of the proposition that the complainants are estopped to ask relief in this case, because they were partially unsuccessful in a prior suit against another party, is quite sufficient for its refutation. Neither argument nor authority is necessary to show that it has no foundation in law or justice, and it is equally clear that the supposed analogy between an admiralty decree *in rem* and a decree dismissing a bill in equity for the invasion of a trade-mark is illusory, unfounded, and without the slightest legal effect.

Suppose that is so, still the respondents deny that the trade-mark which they use is in the slightest degree fraudulent, or that it is calculated to deceive the public. They admit that they use the letters "A. C. A.," but they deny that in any other respect they have used the trade-mark adopted by the complainants.

Manufacturers and merchants have severally the unquestioned right to distinguish the goods they manufacture or sell by a peculiar mark or device, so that the goods may be known in the market as the product or sale of the owner of the trade-mark or device, in order that they may thus secure the profits which the superior repute of the goods may be the means of giving to the producer or seller. *Gillott v. Esterbrook*, 48 N. Y., 374, 376.

Confirmation of that proposition is found in all the reported cases, and it is equally true that the owners of such trade-marks are entitled to the protection of a Court of Equity in the exclusive use of the symbols they have thus adopted and affixed to their goods, the foundation of the rule being that the public interest as

well as the interest of the owner of the trade-mark requires that protection. 2 *Story Eq. Jur.*, sec. 951.

Such a party has a valuable interest in his trade or business, and having appropriated a particular label or trade-mark indicating to those who wish to give him their patronage that the article is made or sold by him, or by his authority, or that he carries on business at a particular place, he is entitled to protection against any other person who attempts to pirate upon the good-will of his customers or of the patrons of his trade or business by sailing under his flag without his authority or consent. *Partridge v. Meuck*, 2 *Barb. (N. Y.)*, Ch., 101.

Redress is given in such cases upon the ground that the party charged is not allowed to offer his goods for sale, representing them to be the manufacture of the first and real owner of the trade-mark, because by doing so he would be guilty of a misrepresentation, and would deprive the real owner of the profits he might make by the sale of his goods which the purchaser intended to buy.

Compensation for such an injury was in early times given to the injured party by an action of deceit at common law, long before the Court of Chancery attempted to exercise jurisdiction to grant relief for such wrongful acts. In such an action it is doubtless true that the plaintiff is required to allege that the party charged, infringed the trade-mark with a fraudulent intent, and to prove the charge as alleged, in order to secure a verdict and judgment for redress. Certain early cases in equity may be found where it is held that it is requisite that the allegation and proof in a Chancery suit should be the same; but the practice in equity has long been settled otherwise, the rule now being that the injury the owner of the trade-mark suffers by the offering for sale in the market of other goods side by side with his, bearing the same trade-mark entitled the real owner of the trade-mark to protection in equity, irrespective of the intent of the wrong-doer, it being held that the injury done to the complainant in his trade by loss of custom is sufficient to support his title to relief.

Neither will the complainant be deprived of remedy in equity, even if it be shown by the respondent that all the persons who bought goods from him bearing the trade-mark of the real owner

were well aware that they were not of the complainant's manufacture. If the goods were so supplied by the wrong-doer for the purpose of being re-sold in the market, the injury to the complainant is sufficient to entitle him to relief in equity.

Nor is it necessary, in order to entitle the party to relief, that proof should be given of persons having been actually deceived, or that they bought goods in the belief that they were of the manufacture of the complainant, provided that the Court is satisfied that the resemblance is such as would be likely to cause the one mark to be mistaken for the other. *Edelston v. Edelston*, 1 *De G., J. & S.*, 185; *McAndrew v. Bassett*, 4 *Id.*, 380; *Sebastin, Trade-Marks*, 70.

Two trade-marks are substantially the same in legal contemplation, if the resemblance is such as to deceive an ordinary purchaser, giving such attention to the same as such purchaser usually gives, and to cause him to purchase the one supposing it to be the other. *Gorham Company v. White*, 14 *Wall.*, 511; *McLean v. Fleming*, 96 *U. S.*, 245, 256; *Adams, Trade-Marks*, 107.

Difficulties attend the effort to describe with precision what resemblance is necessary to constitute an infringement, and perhaps it is not going too far to say that the term is incapable of exact definition as applied to all cases. Grant that, and still it is safe to say that no manufacturer or merchant can properly adopt a trade-mark so resembling that of another engaged in the same business as that ordinary purchasers buying with ordinary caution are likely to be misled.

Positive evidence of fraudulent intent is not required where the proof of infringement is clear, as the liability of the infringer arises from the fact that he is enabled through the unjustifiable use of the trade-mark to sell a simulated article as, and for the one which is genuine. *McLean v. Fleming*, *supra*.

Unless the simulated trade-mark bears a resemblance to that which is genuine, it is clear that the charge of infringement is not made out, and it is doubtless true that the resemblance of the simulated one to the genuine must be such that the former is calculated to deceive or mislead purchasers intending to buy the genuine goods; but it is a mistake to suppose that the resemblance must

be such as would deceive persons seeing the two trade-marks placed side by side. Exact definition may not be attainable, but if a purchaser looking at the article offered to him, said Lord Cranworth, would naturally be led from the mark impressed on it to suppose it to be the production of the rival manufacturer, and would purchase it in that belief, the Court considers the use of such a mark fraudulent. *Franks v. Weaver*, 10 *Beav.*, 297.

Apply that rule to the cases before the Court, and it is sufficient to control the decision; but the Chancellor went much further, and said, that if the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular name, he thought that the adoption by a rival trader of any mark which would cause his goods to bear the same name in the market, may be as much a violation of the rights of the owner as the actual copy of his device. *Seixo v. Provezende*, *Law Rep.*, 1 *Ch.*, 192, 196,

When the entire trade-mark is copied, the case is free of difficulty, as the rule is universal that the infringer is liable; but the question is, when may it be said that a trade-mark has been taken by another? Answers to that question are found in several cases, of which no one is more satisfactory than that given by the Master of the Rolls in a recent case. He says that a trade-mark to be taken need not be exactly copied, nor need it be copied with slight variations, but it must be a *substantial portion* of the trade-mark, to which he adds, that it has sometimes been called the material portion, but that, as he states, means the same thing, and he then remarks that it means the *essential portion* of the trade-mark, and finally concludes the subject by saying that "what the Court has to satisfy itself of is that there has been an essential portion of the trade-mark used to designate goods of a similar description." *Singer Manufacturing Co. v. Wilson*, 2 *Ch. D.*, 434, 443; *Cod. Dig.*, sec. 342.

Argument to show that the rule is applicable to the case before the Court is unnecessary, as the proposition is self-evident; and if so, it is impossible to see how any one can vote to affirm the judgment of the Circuit Court. Beyond all question, the letters "A. C. A." are the essential feature of the trade-mark adopted

by the complainants, and the defendants admit in their answer and in argument that they use the same three letters in the same combination.

Complete imitation is not required by any of the well-considered cases. Instead of that, it is well settled that the proof of infringement is sufficient if it shows even a limited and partial imitation, provided the part taken is an essential portion of the symbol. None of the cases show that the whole must be taken, nor is it necessary to show that any one has in fact been deceived, if the imitation is such as to prove that it is calculated to deceive ordinary purchasers using ordinary caution. Proof of actual intent to defraud is not required, but it is sufficient if the Court sees that the trade-mark of the complainant is simulated in such a manner as probably to deceive the customers and patrons of his trade and business. *Filley v. Fassett*, 44 Mo., 168, 178; *Coats v. Holbrook*, 2 Sandf. (N. Y.), Ch., 586, 626.

Courts of justice do not always use the same language in defining what is the requisite similarity in the two trade-marks to entitle the complainant to relief; but they substantially concur that if it be such that the public may be led to believe while they buy the goods of the respondent that they are buying "an article manufactured by the complainant, the proof of similarity is sufficient. *Hirst v. Denham*, *Law Rep.*, 14 Eq., 542, 552.

For the purpose of establishing a case of infringement, it is not necessary to show that there has been the use of a mark in all respects corresponding with that which another person has acquired an exclusive right to use, if the resemblance is such as not only to show an intention to deceive, but also such as to be likely to make unwary purchasers suppose that they are purchasing the article sold by the party to whom the right to use the trade-mark belongs. *Wotherspoon v. Currie*, *Law Rep.*, 5 App. Cas., 508-519; *S. C.*, 27 L. T., N. S., 393.

Chancery Courts will protect the property rights of a party in his trade-mark, and for its invasion the law will award compensation in damages. Legal redress will be accorded when it is shown that the symbol or device used by the wrong-doer is of such a character that by its resemblance to the established trade-mark of

the complainant it will be liable to deceive the public and lead to the purchase of that which is not the manufacture of the proprietor, believing it to be his.

It is not necessary that the symbol or device should be a facsimile or a precise copy of the original trade-mark, or that it should be so close an imitation that the two cannot be easily distinguished by one familiar with the genuine device; but if the false or simulated one is only colorably different, or if the resemblance is such as may deceive a purchaser of ordinary caution, or if it is calculated to mislead the careless and unwary, and thus to injure the sale of the goods of the proprietor of the true device, the injured party is entitled to redress. *Colman v. Crump*, 70 *N. Y.*, 573, 578; *Glenny v. Smith*, 11 *Jur. N. S.*, 964.

Trade-marks usually exhibit some peculiar device, vignette, or symbol, in addition to the name of the party, which the proprietor had a perfect right to appropriate, and which, as well as the name, is intended as a declaration to the public that the article is his property. Imitations frequently drop both the name and certain parts of the surroundings, and substitute their own name with a different vignette; but if the peculiar device is copied, and so copied as to manifest a design of misleading the public, the omission or variation ought to be wholly disregarded.

Proof of an intention to defraud is not required; but it is plain that the respondents acted with a design, and it would be absurd to suppose that they had no further object than the mere imitation of the trade-mark which they copied. On the contrary, it is obvious that they expected to gain an advantage in the sale of their goods by attaching their simulated device to fabrics resembling in appearance and quality the fabric of the complainants. Of course they meant to secure to their goods a preference in the market which they otherwise would not have commanded; and it is difficult, if not impossible, to see how any such advantage could be gained unless the simulated trade-mark would enable them to sell their fabrics as that of the injured party. *Amoskeag Manufacturing Co. v. Spear*, *supra*; *Fetridge v. Wells*, 13 *How. (N. Y.)*, *Pr.* 386.

Proprietors of a trade-mark, in order to bring the same under the protection of a Court of Equity, are not obliged to prove that it has been copied in every particular by the wrong-doer. It is enough for them to show that the representations employed, bear such resemblance to their symbol or device as to be calculated to mislead the public who are purchasers of the article, and to make it pass for the one sold by the true owner of the trade-mark. *Walton v. Crowley*, 3 *Blatchf.*, 440-447.

Candid men cannot read the record in this case without being forced to the conclusion that the respondents took the essential feature of the complainants' trade-mark, which they had used for forty years to designate the fabric of ticking which they manufactured, and which had become known throughout the United States as the authorized symbol to indicate that description of goods, and if so, it follows to a demonstration that the decrees of the Circuit Court should be reversed.

United States *vs.* Steffens, &c.40

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SUPREME COURT OF THE UNITED STATES.

UNITED STATES*vs.*

STEFFENS.

UNITED STATES*vs.*

WITTEMANN.

UNITED STATES*vs.*

JOHNSON.

DECIDED OCTOBER, 1879.

REPORTED 100 U. S., 82.

Trade-Mark Law unconstitutional.

1. Property in trade-marks has long been recognized and protected by the common law and by the statutes of the several States, and does derive

its existence from the Act of Congress providing for the registration of them in the Patent Office.

2. A trade-mark is neither an invention, a discovery, nor a writing, within the meaning of the eighth clause of the eighth section of the first Article of the Constitution, which confers on Congress power to secure for limited times to authors and inventors the exclusive right to their respective writings and discoveries.
3. If an Act of Congress can in any case be extended, as a regulation of commerce, to trade-marks, it must be limited to their use in "commerce with foreign nations, and among the several States, and with the Indian tribes."
4. The legislation of Congress in regard to trade-marks is not, in its terms or essential character, a regulation thus limited, but in its language embraces, and was intended to embrace, all commerce, including that between citizens of the same State.
5. That legislation is void for want of constitutional authority, inasmuch as it is so framed that its provisions are applicable to all commerce, and cannot be confined to that which is subject to the control of Congress.

THE first two cases were brought here on certificates of division in opinion between the Judges of the Circuit Court of the United States for the Southern District of New York, the last was brought here on a certificate of division of opinion between the Judges of the Circuit Court of the United States for the Southern District of Ohio.

Steffens was indicted under the fourth and fifth sections of an Act of Congress entitled "An Act to punish the counterfeiting of trade-marks and the sale or dealing in of counterfeit trade-mark goods," approved August 14th, 1876. 19 *Stat.*, 141.

The first count in the indictment charges him with knowingly and willfully having in his possession counterfeits and colorable imitations of the trade-marks of G. H. Mumm & Co., of Rheims, France, manufacturers and sellers of champagne wine.

The second count charges him with knowingly and willfully selling counterfeited representations and colorable imitations of the trade-mark of said G. H. Mumm & Co.

Wittemann was indicted under the fifth section of that Act. The indictment consists of six counts, and they charge: 1st, The

counterfeiting and forging; 2nd, The having in possession colorable imitations of; 3rd, The buying; 4th, The selling; 5th, The offering for sale; and 6th, The dealing in colorable imitations of the private trade-mark belonging to and used by the firm of Kunkleman & Co., of Rheims, France, manufacturers and dealers in wine known as the "Piper Heidsieck" brand of champagne wine.

Johnson, McNamara, and Reeder were prosecuted under that Act by a criminal information containing seven counts, of which the first, fourth and sixth are founded upon a trade-mark consisting of the letters "O K," registered in the United States Patent Office by Charles F. O'Donnell, April 2, 1878, for use upon packages of whiskey, and respectively charge the defendants with counterfeiting, affixing a colorable imitation, and dealing in and selling packages of whiskey to which was attached a colorable imitation of said trade-mark, and the second, third, fifth, and seventh counts are founded upon another trade-mark, consisting of a seal and ribbon, the latter secured by the seal of a package containing whiskey, registered by Charles F. O'Donnell, May 21, 1878, and respectively charge the defendants with counterfeiting, making a colorable imitation, affixing a colorable imitation, and dealing in packages of whiskey to which was attached a colorable imitation of said trade-mark.

Secs. 4 and 5 of the Act of 1876 are as follows:

"SEC. 4. That any person or persons who shall, with intent to defraud any person or persons, knowingly and willfully cast, engrave or manufacture, or have in his, her, or their possession, or buy, sell, offer for sale, or deal in, any die or dies, plate or plates, brands or brands, engraving or engravings, on wood, stone, metal, or other substance, moulds, or any false representation, likeness, copy, or colorable imitation of any die, plate, brand, engraving, or mould of any private label, brand, stamp, wrapper, engraving on paper or other substance, or trade-mark, registered pursuant to the Statutes of the United States, shall, upon conviction thereof, be punished as prescribed in the first section of this Act.

"SEC. 5. That any person or persons who shall, with intent to defraud any person or persons, knowingly and willfully make,

forge, or counterfeit, or have in his, her, or their possession, or buy, sell, offer for sale, or deal in, any representation, likeness, similitude, copy, or colorable imitation of any private label, brand, stamp, wrapper, engraving, mould, or trade-mark, registered pursuant to the Statutes of the United States, shall, upon conviction thereof, be punished as prescribed in the first section of this Act,"

Sec. 4937, Rev. Stat., is as follows:

"Any person or firm domiciled in the United States, and any corporation created by the authority of the United States or of any State or Territory thereof, and any person, firm, or corporation resident of or located in any foreign country which by treaty or convention affords similar privileges to citizens of the United States, and who are entitled to the exclusive use of any lawful trade-mark, or who intend to adopt and use any trade-mark for exclusive use within the United States, may obtain protection for such lawful trade-mark, by complying with the following requirements:

"*First*, By causing to be recorded in the Patent Office a statement specifying the name of the parties and their residences and places of business, who desire the protection of the trade-mark, the class of merchandise, and the particular description of goods comprised in such class, by which the trade-mark has been or is intended to be appropriated; a description of the trade-mark itself, with fac-similes thereof, showing the mode in which it has been or is intended to be applied and used; and the length of time, if any, during which the trade-mark has been in use.

"*Second*. By making payment of a fee of twenty-five dollars in the same manner and for the same purpose as the fee required for patents.

"*Third*. By complying with such regulations as may be prescribed by the Commissioner of Patents."

To each indictment there was a general demurrer. The Judges of the Circuit Court were opposed in opinion upon the following questions: "Can the Act of Congress, approved Aug. 14, 1876, entitled 'An Act to punish the counterfeiting of trade-mark goods

and the sale of or dealing in counterfeit trade-mark goods,' under which this indictment is found, be upheld, wholly or in part, as a law necessary and proper for carrying into execution any of the powers vested in the Congress by the Constitution of the United States?"

To the information against Johnson, McNamara, and Reeder, there was a general demurrer, and thereupon a question arose for decision whether the said Act of Congress "is within the constitutional power of Congress, or whether the same is unconstitutional, null and void;" and the opinions of the Judges of the Circuit Court were opposed.

The *Attorney-General*, for the United States.

The validity of the Act of July 8, 1870, which provides for the registration of trade-marks, and gives remedies by civil actions for infringing them, was recognized by Mr. Justice Clifford, who delivered the opinion of the Court in *McLean v. Fleming*, 96 U. S., 245. The first sentence of the opinion is as follows:—

"Protection for lawful trade-marks may be obtained by individuals, firms, or corporations entitled to the same, if they comply with the requirements prescribed by the Act of Congress;" and the provision is, that a trade-mark duly registered as required shall remain in force thirty years from the date of such registration, subject to an exception not necessary to be noticed. 16 *Stat.*, 210; *Rev. Stat.*, Secs. 4937; 4941."

Here it is clearly intimated that protection for trade-marks is rightfully provided by that Act. If it is invalid, no such protection could be in that mode obtained; but if protection to trade-marks by civil remedies is within the power of Congress, so also are the Statutes punishing as a crime the pirating upon property in them. But in that case, and in several others which are cited on the margin of page 955 of the Revised Statutes, the constitutionality of the Act was not discussed. In them and others (*Smith v. Reynolds*, 10 *Blatch.*, 85; *Smith v. Reynolds*, 13 *Id.*, 45; *Osgood v. Rockwood*, 11 *Id.*, 310; *Moorman v. Hodge*, 2 *Law*, 78), it was assumed rather than directly affirmed.

In the Sixth Circuit, Judge Swing pronounced the law to be constitutional. In the Seventh Circuit, a contrary decision was made. In each case the question was argued and decided upon clause 8th of Section 8, Article 1, of the Constitution, and the opinion was advanced that it is the only provision by which the authority of Congress on the subject of trade-marks is conferred.

The argument drawn from the likeness which property in the use of trade-marks bears to that in patents and copyrights, and from the fact that Congress, in legislating upon these three matters, has, both in the original Act and the Revised Statutes, classed them together, demands careful consideration. Undoubtedly, in the legislative mind they were kindred subjects, and it was thought that the power of Congress over them might be derived from the same source.

I shall, however, not dwell upon this view of the question.

1. I maintain the constitutionality of the statute upon which the indictments and the information are found, upon the ground that it regulates commerce within the power given to Congress by clause 3 of Section 8 of Article 1 of the Constitution, which provides that the Congress shall have power "to regulate commerce with foreign nations, and among the several States, and with the Indian tribes."

"Commerce is a term of the largest import. It comprehends intercourse for the purposes of trade in any and all its forms, including transportation, purchase, sale and exchange of commodities, between the citizens of our country and the citizens or subjects of other countries, and between the citizens of different States. The power to regulate it embraces all the instruments by which such commerce may be conducted. So far as some of these instruments are concerned, and some subjects which are local in their operation, it has been held that the States may provide regulations until Congress acts with reference to them; but where the subject to which the power applies is national in its character, or of such a nature as to admit of uniformity of regulation, the power is exclusive of all State authority." *Welton v. State of Missouri*, 91 U. S., 275. This is a full and clear statement of

what is meant by "commerce," and of the extent of the power of Congress over it.

The purchase and sale of commodities, then, are included in the term "commerce," and the power of Congress over it embraces all the instruments, aids, and appliances by which it is prosecuted. True, such trade and intercourse must be foreign, or among the citizens of the different States, or with the Indian tribes; but if the instrumentalities employed as aids to such trade and commerce are not local in their operation, and are of such a nature as to admit of uniformity of regulation, the power of Congress not only applies to them but is exclusive.

2. *Trade-marks* are important instrumentalities, aids, or appliances by which trade, especially in modern times, is conducted. They are the means by which manufacturers and merchants identify their manufactures and merchandise. They are the symbols by which men engaged in trade and manufactures become known in the marts of commerce, by which their reputation and that of their goods are extended and published; and as they become better known, the profits of their business are enhanced.

Hence the use of trade-marks has become universal, and in all trade and business of any extent they are *necessary* auxiliaries.

Among commercial nations there is a growing tendency to universal recognition of these emblems of commerce. *Browne, Trade-Marks, sec. 302.*

Their use as aids to the exchange of commodities in the great markets of the world is so generally recognized, and they are considered as so vitally important to the protection of commerce, that they have been made the subject of treaties between the United States and France, the German Empire, Belgium, Austria, Russia, and other powers. The English Merchandise Marks Act of 1862, affords the same protection to foreigners that it does to the subject of Great Britain. *Browne, Trade-Marks, p. 565.*

3. The subject of trade-marks is not one of *local*, but of common, interest to all commercial nations. Their operation and the benefits derived from their use are not confined to particular localities, States, or countries. They not only admit, but in order to their efficiency require, uniformity of regulation.

4. Congress has endeavored to effect this uniformity, first, by providing for the registration of trade-marks, and, as remedies for the violation of the owners' rights in them, an action on the case for damages and a bill in equity to enjoin the offending party. *Secs.* 4937, 4941, 4942, *Rev. Stat.* But these civil remedies proved inadequate to effectually prevent pirating upon trade-marks. They do not materially differ from those which previously existed.

Congress, then, following the examples of Prussia, France, and England, (*Browne, Trade-Marks, pp.* 560-572), passed the Act of August 14th, 1876, 19 Stat., 141. The offences therein defined are charged in the indictments and the information. Further specification is unnecessary; for the demurrers are general, and the ground of each is that the entire Act is unconstitutional.

Its constitutionality in its application to the trade-marks of the *subjects of foreign countries* is the question presented by the indictments.

The purpose and the natural and reasonable effect of the Acts are to protect the producer or the importer of foreign goods in his right of selling them in the United States, and thus carry out in good faith and enforce our treaty stipulations on the subject. The Act is a regulation of foreign commerce.

The convention with France of the 16th of April, 1869, (16 Stat., 771), forbids the reproduction, in either of the two countries, of the trade-marks affixed to merchandise in the other, and gives the injured party an action for damages, just as if he were a citizen or subject of the country where the act of counterfeiting was committed.

It provides, in the second article, that the owner of trade-marks residing in either of the two countries, in order to secure their rights in the other, must deposit duplicate copies of their marks in the Patent Office at Washington, and in the clerk's office of the Tribunal of Commerce of the Seine at Paris.

Here is a mutual covenant concerning trade-marks. Whatever protection the laws of either country give to its own citizens or subjects is extended to the citizens or subjects of the other. Such is the intent of the treaty.

The law of France of June 23, 1857, provides not only a civil action, but also a criminal proceeding which prescribes severe penalties against those who counterfeit trade-marks, or in any way fraudulently deal in false representations of trade-marks. It declares that foreigners shall equally enjoy its benefits for their products, if, in their countries, diplomatic conventions have established reciprocity of French marks. *Browne, Trade-Marks*, 569.

Congress, in order to afford an effective remedy for the evil, and extend the same protection to French importers that France gives to our producers and merchants in her markets, has enacted that the forger of trade-marks and the dealer in forged trade-marks shall answer at the bar of criminal justice in the Courts of the United States.

The end is lawful, within the power of Congress; the means are appropriate.

But it is said that, in passing the Statutes of Aug. 14, 1876, and July 8, 1870, Congress has exceeded its power, because in their application they cover cases arising wholly within the several States, and make acts committed within their jurisdiction—acts which are not directed against the operations of the general government—crimes against the United States; that they not only regulate foreign and inter-State commerce, but affect the domestic concerns of the several States.

The fraudulent dealing in trade-marks plainly interferes with and thwarts the power and duty of the United States to protect foreign and inter-State trade. Moreover, it is impossible to limit the effect of the wrong-doing within the confines of a State. It extends to all places where there is a market for the goods which are simulated by the false device.

But the answer to the objection is, that the subject of these Statutes is a general interest of commerce upon which Congress has power to legislate. The operation of trade-marks is co-extensive with trade, and it is no objection to the law regulating them that it touches the internal concerns of a State.

In the *Wheeling Bridge Case* (18 *How.*, 421), it was observed by the Court: "It will not do to say that the exercise of an admitted power of Congress, conferred by the Constitution, is to be

withheld, if it appears or can be shown that the effect and operation of the law may incidentally extend beyond the limitation of the power. Upon any such interpretation the principal object of the framers of the instrument in conferring the power would be sacrificed to the subordinate consequences resulting from its exercise."

The power of Congress to tax imports, is exclusive, and yet this constitutional provision very seriously limits the power of the States over their internal affairs.

It was held in *Brown v. Maryland* (12 *Wheat.*, 419) that the States can in no way or manner tax the sale of imported goods before they are incorporated and mixed up with the mass of the property of the country.

Mr. Justice Strong, delivering the opinion of the Court in *State Tax on Railway Gross Receipts* (15 *Wall.*, 284), construes the ruling in *Brown v. Maryland* as applying to other persons than the importers, who sell foreign goods by unbroken bale or package. See also *Welton v. State of Missouri*, 91 *U. S.*, 275.

Here it is very plain that, by this authoritative exposition of the Constitution, not only the power of a State over its internal commerce, but its right to tax property within its jurisdiction, is interfered with and limited.

So, where States, in the exercise of their power to legislate concerning the police, morals, or health of the community, have endeavored to regulate the sale of particular articles, as of spirituous liquors, their laws are invalid, so far as they affect the sale of imported goods by the importer while they are in the original package and not mixed up with the general mass of salable commodities. *License Cases*, 5 *How.*, 504; *Commonwealth v. Kimball*, 24 *Pick.*, (*Mass.*), 359.

In *License Cases*, the Court decided that a State might regulate the sale of liquors in the original packages *as imported* from another State, *in the absence of legislation by Congress upon the same subject*; but when Congress exercised its power to regulate interstate commerce, State laws, so far as they conflict with the action of Congress, must yield. Here, too, the power of the States over their internal concerns is materially diminished.

So, also, in regard to the regulation of pilotage. That is within the power of Congress. *Cooley v. Board of Wardens*, 12 *How.*, 299. A general law regulating pilotage upon all the navigable waters of the United States materially affects the internal commerce of many States, and yet parties have been indicted and convicted for a violation of its provisions. *United States v. Farnham*, 2 *Black.*, 528; *United States v. Warren*, 4 *McLean*, 463; *United States v. Taylor*, 5 *Id.*, 242.

In the regulation of trade with the Indian tribes the action of the law, especially when the Constitution was adopted, was chiefly within a State; but the Court asserted that "the power of Congress comprehends navigation *within the limits* of every State in the Union, so far as that navigation may be in any manner connected with commerce with foreign nations, or among the several States, or with the Indian tribes." *Gibbins v. Ogden*, 9 *Wheat.*, 1.

In this connection I refer to *United States v. Holliday*, (3 *Wall.*, 407), and *United States v. Forty-three Gallons of Whiskey*, 93 *U. S.*, 188.

Congress having power to legislate upon the subject of trade-marks as a general interest of commerce, it is submitted that the legislation of Congress, the purpose of which is to give them uniform protection throughout the country, is constitutional, however it may affect the internal affairs of the States.

If it be insisted by the defendants that the Act by its terms can also be applied to trade-marks for goods not intended for inter-State or foreign commerce, the reply is, that excluding from operation the provisions which are in that regard objectionable, a valid enactment, susceptible of being enforced in all proper cases, may remain. Where a law which is constitutional under certain limitations exceeds them, it may still be operative within its legitimate sphere, and be void only for the excess.

Mr. George Hoadley, contra.

Mr. JUSTICE MILLER delivered the opinion of the Court.

The three cases whose titles stand at the head of this opinion are criminal prosecutions for violation of what is known as the

trade-mark legislation of Congress. The first two are indictments in the Southern District of New York, and the last is an information in the Southern District of Ohio. In all of them the Judges of the Circuit Courts in which they are pending have certified to a difference of opinion on what is substantially the same question; namely, are the Acts of Congress on the subject of trade-marks founded on any rightful authority in the Constitution of the United States?

The entire legislation of Congress in regard to trade-marks is of very recent origin. It is first seen in secs. 77 to 84, inclusive, of the Act of July 8, 1870, entitled "an Act to revise, consolidate, and amend the statutes relating to patents and copyrights." 16 Stat., 198. The part of this Act relating to trade-marks is embodied in chap. 2, tit. 60, secs. 4937 to 4947, of the Revised Statutes.

It is sufficient at present to say that they provide for the registration in the patent office of any device in the nature of a trade-mark to which any person has by usage established an exclusive right, or which the person so registering intends to appropriate by that Act to his exclusive use; and they make the wrongful use of a trade-mark, so registered, by any other person, without the owner's permission, a cause of action in a civil suit for damages. Six years later we have the Act of Aug. 14, 1876, (19 Stat., 141), punishing by fine and imprisonment the fraudulent use, sale, and counterfeiting of trade-marks registered in pursuance of the statutes of the United States, on which the informations and indictments are founded in the cases before us.

The right to adopt and use a symbol or a device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons, has been long recognized by the common law and the Chancery Courts of England and of this country, and by the statutes of some of the States. It is a property right for the violation of which damages may be recovered in an action at law, and the continued violation of it will be enjoined by a Court of Equity, with compensation for past infringement.

1. This exclusive right was not created by the Act of Congress, and does not now depend upon it for its enforcement. The whole system of trade-mark property and the civil remedies for its protection existed long anterior to that Act, and have remained in full force since its passage.

These propositions are so well understood as to require neither the citation of authorities nor an elaborate argument to prove them.

As the property in trade-marks and the right to their exclusive use rest upon the laws of the States, and, like the great body of the rights of person and of property, depend on them for security and protection, the power of Congress to legislate on the subject, to establish the conditions on which these rights shall be enjoyed and exercised, the period of their duration, and the legal remedies for their enforcement, if such power exist at all, must be found in the Constitution of the United States, which is the source of all the powers that Congress can lawfully exercise.

In the argument of these cases this seems to be conceded, and the advocates for the validity of the Acts of Congress on this subject point to two clauses of the Constitution, in one or in both of which, as they assert, sufficient warrant may be found for this legislation.

2. The first of these is the eighth clause of sec. 8 of the first Article. That section, manifestly intended to be an enumeration of the powers expressly granted to Congress, and closing with the declaration of a rule for the ascertainment of such powers as are necessary by way of implication to carry into efficient operation those expressly given, authorizes Congress, by the clause referred to, "to promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries."

As the first and only attempt by Congress to regulate the *right of trade-marks* is to be found in the Act of July 8, 1870, to which we have referred, entitled "An Act to revise, consolidate, and amend the statutes relating to *patents* and *copyrights*," terms which have long since become technical, as referring, the one to inventions and the other to the writings of authors, it is a reasonable

inference that this part of the statute also was, in the opinion of Congress, an exercise of the power found in that clause of the Constitution. It may also be safely assumed that until a critical examination of the subject in the Courts became necessary, it was mainly if not wholly to this clause that the advocates of the law looked for its support.

Any attempt, however, to identify the essential characteristics of a trade-mark with inventions and discoveries in the arts and sciences, or with the writings of authors, will show that the effort is surrounded with insurmountable difficulties.

The ordinary trade-mark has no necessary relation to invention or discovery. The trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident rather than design, and when under the Act of Congress it is sought to establish it by registration, neither originality, invention, discovery, science, nor art is in any way essential to the right conferred by that Act. If we should endeavor to classify it under the head of writings of authors, the objections are equally strong. In this, as in regard to inventions, originality is required. And while the word *writings* may be liberally construed, as it has been, to include original designs for engravings, prints, &c., it is only such as are *original*, and are founded in the creative powers of the mind. The writings which are to be protected are *the fruits of intellectual labor*, embodied in the form of books, prints, engravings, and the like. The trade-mark may be, and generally is, the adoption of something already in existence as the distinctive symbol of the party using it. At common law the exclusive right to it grows out of its *use*, and not its mere adoption. By the Act of Congress, this exclusive right attaches upon registration. But in neither case does it depend upon novelty, invention, discovery, or any work of the brain. It requires no fancy or imagination, no genius, no laborious thought. It is simply founded on priority of appropriation. We look in vain to the statute for any other qualification or condition. If the symbol, however plain, simple, old, or well-known, has been first appropriated by the claimant as his distinctive trade-mark, he may, by registration, secure the

right to its exclusive use. While such legislation may be a judicious aid to the common law on the subject of trade-marks, and may be within the competency of Legislatures whose general powers embrace that class of subjects, we are unable to see any such power in the constitutional provisions concerning authors and inventors, and their writings and discoveries.

The other clause of the Constitution supposed to confer the requisite authority on Congress is the third of the same section which, read in connection with the granting clause, is as follows:

3. "The Congress shall have power to regulate commerce with foreign nations, and among the several States, and with the Indian tribes."

The argument is that the use of a trade-mark—that which alone gives it any value—is to identify a particular class or quality of goods as the manufacture, produce, or property of the person who puts them in the general market for sale; that the sale of the article so distinguished is commerce; that the trade-mark is, therefore, a useful and valuable aid or instrument of commerce, and its regulation by virtue of the clause belongs to Congress, and that the Act in question is a lawful exercise of this power.

Every species of property which is the subject of commerce, or which is used or even essential in commerce, is not brought by this clause within the control of Congress. The barrels and casks, the bottles and boxes in which alone certain articles of commerce are kept for safety and by which their contents are transferred from the seller to the buyer, do not thereby become subjects of congressional legislation more than other property. *Nathan v. Louisiana*, 3 How., 73. In *Paul v. Virginia*, (8 Wall., 168), this Court held that a policy of insurance made by a corporation of one State on property situate in another, was not an article of commerce, and did come within the purview of the clause we are considering. "They are not," says the Court, "commodities to be shipped or forwarded from one State to another, and then put up for sale." On the other hand, in *Almy v. State of California*, (24 How., 169), it was held that a stamp duty imposed by the Legislature of California on bills of lading for gold and silver transported from any place in that State to another out of the

State, was forbidden by the Constitution of the United States, because such instruments being a necessity to the transaction of commerce, the duty was a tax upon exports.

The question, therefore, whether the trade-mark bears such a relation to commerce in general terms as to bring it within congressional control, when used or applied to the classes of commerce which fall within that control, is one which, in the present case, we propose to leave undecided. We adopt this course because when this Court is called on in the course of the administration of the law to consider whether an Act of Congress, or of any other department of the government, is within the constitutional authority of that department, a due respect for a co-ordinate branch of the government requires that we shall decide that it has transcended its powers only when it is so plain that we cannot avoid the duty.

In such cases it is manifestly the dictate of wisdom and judicial propriety to decide no more than is necessary to the case in hand. That such has been the uniform course of this Court in regard to statutes passed by Congress will readily appear to any one, who will consider the vast amount of argument presented to us assailing them as unconstitutional, and he will count, as he may do on his fingers, the instances in which this Court has declared an Act of Congress void for want of constitutional power.

Governed by this view of our duty, we proceed to remark, that a glance at the commerce clause of the Constitution discloses at once what has been often the subject of comment in this Court and out of it, that the power of regulation there conferred on Congress is limited to commerce with foreign nations, commerce among the States, and commerce with the Indian tribes. While bearing in mind the liberal construction that commerce with foreign nations means commerce between citizens of the United States and citizens and subjects of foreign nations, and commerce among the States means commerce between the individual citizens of different States, there still remains a very large amount of commerce, perhaps the largest, which, being trade or traffic between citizens of the same State, is beyond the control of Congress.

4. When, therefore, Congress undertakes to enact a law, which can only be valid as a regulation of commerce, it is reasonable to expect to find on the face of the law, or from its essential nature, that it is a regulation of commerce with foreign nations, or among the several States, or with the Indian tribes. If not so limited, it is in excess of the power of Congress. If its main purpose be to establish a regulation applicable to all trade, to commerce at all points, especially if it be apparent that it is designed to govern the commerce wholly between citizens of the same State, it is obviously the exercise of a power not confided to Congress.

We find no recognition of this principle in the chapter on trade-marks in the Revised Statutes. We would naturally look for this in the description of the class of persons who are entitled to register a trade-mark, or in reference to the goods to which it should be applied. If, for instance, the Statute described persons engaged in a commerce between the different States, and related to the use of trade-marks in such commerce, it would be evident that Congress believed it was acting under the clause of the Constitution which authorizes it to regulate commerce among the States. So if, when the trade-mark has been registered; Congress had protected its use on goods sold by a citizen of one State to another, or by a citizen of a foreign State to a citizen of the United States, it would be seen that Congress was at least intending to exercise the power of regulation conferred by that clause of the Constitution. But no such idea is found or suggested in this Statute. Its language is: "Any person or firm domiciled in the United States, and any corporation created by the United States, or of any State or Territory thereof, or any person residing in a foreign country which by treaty or convention affords similar privileges to our citizens, may by registration obtain protection for his trade-mark." Here is no requirement that such person shall be engaged in the kind of commerce which Congress is authorized to regulate.

5. It is a general declaration that anybody in the United States, and anybody in any other country which permits us to do the like, may, by registering a trade-mark, have it fully protected. So, while the person registering is required to furnish "a statement of the class of merchandise, and the particular description

of the goods comprised in such class, by which the trade-mark has been or is intended to be appropriated," there is no hint that the goods are to be transported from one State to another, or between the United States and foreign countries. Sec. 4939 is intended to impose some restriction upon the Commissioner of Patents in the matter of registration, but no limitation is suggested in regard to persons or property engaged in the different classes of commerce mentioned in the Constitution. The remedies provided by the Act when the right of the owner of the registered trade-mark is infringed, are not confined to the case of a trade-mark used in foreign or inter-state commerce.

It is therefore manifest that no such distinction is found in the Act, but that its broad purpose was to establish a universal system of trade-mark registration, for the benefit of all who had already used a trade-mark, or who wished to adopt one in the future, without regard to the character of the trade to which it was to be applied or the residence of the owner, with the solitary exception that those who resided in foreign countries which extended no such privileges to us were excluded from them here.

It has been suggested that if Congress has power to regulate trade-marks used in commerce with foreign nations and among the several States, these statutes shall be held valid in that class of cases, if no further. To this there are two objections: First, the indictments in these cases do not show that the trade-marks which are wrongfully used were trade-mark used in that kind of commerce. Secondly, while it may be true that when one part of a statute is valid and constitutional, and another part is unconstitutional and void, the Court may enforce the valid part, where they are distinctly separable, so that each can stand alone, it is not within the judicial province to give to the words used by Congress a narrower meaning than they are manifestly intended to bear, in order that crimes may be punished which are not described in language that brings them within the constitutional power of that body. This precise point was decided in *United States v. Reese*, 92 U. S., 214. In that case Congress had passed a statute punishing election officers who should refuse to any person lawfully entitled to do so the right to cast his vote at an

election. This Court was of the opinion that, as regarded the section of the statute then under consideration, Congress could only punish such denial when it was on account of race, color, or previous condition of servitude.

It was urged, however, that the general description of the offence included the more limited one, and that the section was valid where such was in fact the cause of denial. But the Court said, through the Chief Justice: "We are not able to reject a part which is unconstitutional and retain the remainder, because it is not possible to separate that which is constitutional, if there be any such, from that which is not. The proposed effect is not to be attained by striking out or disregarding words that are in the section, but by inserting those that are not there now. Each of the sections must stand as a whole, or fall together. The language is plain. There is no room for construction, unless it be as to the effect of the Constitution. The question, then, to be determined is, whether we can introduce words of limitation into a penal statute so as to make it specific, when, as expressed, it is general only. * * * * To limit this statute in the manner now asked for would be to make a new law, not to enforce an old one. This is no part of our duty." If we should, in the case before us, undertake to make by judicial construction a law which Congress did not make, it is quite probable we should do what, if the matter were now before that body, it would be unwilling to do; namely, make a trade-mark law which is only partial in its operation, and which would complicate the rights which parties would hold, in some instances under the Act of Congress, and in others under State law. *Cooley, Const. Lim.*, 178, 179; *Commonwealth v. Hitchings*, 5 *Gray*, (Mass.), 482.

In what we have here said we wish to be understood as leaving untouched the whole question of the treaty-making power over trade-marks, and of the duty of Congress to pass any laws necessary to carry treaties into effect.

While we have, in our references in this opinion to the trade-mark legislation of Congress, had mainly in view the Act of 1870, and the civil remedy which that Act provides, it was because the criminal offences described in the Act of 1876 are by

their express terms, solely referable to frauds, counterfeits, and unlawful use of trade-marks which were registered under the provisions of the former Act. If that Act is unconstitutional, so that the registration under it confers no lawful right, then the criminal enactment intended to protect that right falls with it.

The questions in each of these cases being an inquiry whether these statutes can be upheld in whole or in part as valid and constitutional, must be answered in the negative ; and it will be *so certified to the proper Circuit Courts.*

41

NEW YORK SUPREME COURT, FIRST DEPARTMENT. IN EQUITY. SPECIAL TERM.

COLLINS

vs.

THE REYNOLDS CARD MANUFACTURING CO.

DECIDED OCTOBER, 1879.

REPORTED 7 ABBOTT'S NEW CASES, 17.

"35" Case.

TRADE-MARK IN NUMERALS.

1. A manufacturer has the right to distinguish the goods manufactured by him by any peculiar mark or device he may select and adopt by which they may be known as his in the market, and he is entitled to protection in a Court of Equity in the exclusive use of the peculiar mark or symbol appropriated by him designating or indicating the true origin or ownership of the article to which they are affixed.
2. In this case the labels do not contain the name of the plaintiffs as makers but the evidence satisfies me beyond a doubt that the figures "35" were known and recognized by dealers, when employed, as *carte de visite* mounts, as referring to the particular kind of card which was manufactured by the plaintiffs, HELD:

That the plaintiffs have a trade-mark in those figures and are entitled to be protected in a Court of Equity.

3. Rule laid down by Judge VAN BRUNT in *Timiny v. Basch*, 16 *Law Reg.*, N. S., 596, approved and quoted as follows: "If the use of any word, numerals or symbols is adopted for the purpose of defrauding the public, the Courts will interfere to protect the public from such fraudulent intent even though the person asking the intervention of the Court may not have the exclusive right to use the words, numerals or symbols."
4. The plaintiff is entitled to an injunction restraining the defendants from using the figures "35" in designating the cards made by them whether upon the cards themselves, or upon the labels of their boxes.

TRIAL BY THE COURT.

The action was brought by Alfred M. Collins, Henry H. Collins, and Edward Cope, to restrain defendant from using the number "35" and an imitation of the plaintiffs' label.

Plaintiffs manufacture most of the cards used for photographic mounts in this country. Their cards of various sizes and kinds are boxed, each kind by itself, in a paper box, with a label on one end of the box. The cards themselves are perfectly plain in appearance, and the boxes and labels are not marked with the manufacturers' name or with any peculiar device, except that upon the labels, numbers running from 1 to upwards of 50 are printed; a different number being employed for each kind of cards. The numbers are purely arbitrary, and are used by the plaintiffs for the double purpose of distinguishing the different kinds of their cards as among themselves, and also as of designating to the trade cards of their manufacture, and of distinguishing them from cards of all other manufacturers. The numbers were first selected by the plaintiffs, and had been exclusively used by them for this purpose, and with this effect in the photographic card trade, until certain of them were adopted by the defendant.

The plaintiffs' cards are generally ordered, in the trade, simply by the numbers.

Flamen B. Candler and George Richards, (*Van Winkle, Candler & Jay*, Attorneys), for plaintiffs.

Homer A. Nelson and A. Bell Malcomson, (*Cochrane & Malcomson*, Attorneys), for defendants.

LAWRENCE, J.:

This case cannot be distinguished, in any opinion, in principle, from that of *Gillott v. Esterbrook*.

1. In that case the Court held that a manufacturer has the right to distinguish the goods manufactured by him, by any peculiar mark or device he may select and adopt, by which they may be known as his in the market, and that he is entitled to the protection of a Court of Equity in the exclusive use of the peculiar mark or symbol appropriated by him, designating or indicating the true origin or ownership of the article to which they are affixed.

In that case the plaintiff had impressed the figures "303" upon his pens, and the pens were put up in boxes with a label on top, containing the name of the maker and numerals, and the pens were known and ordered by dealers as 303 pens.

2. In the case at bar, the labels do not contain the name of the plaintiffs as makers, but the evidence satisfies me, beyond a doubt, that the figures "35" were known and recognized by dealers, when employed, designating *carte de visite* mounts, as referring to the particular kind of card which was manufactured by the plaintiffs.

And under the authorities, I am of the opinion that the plaintiffs have a trade-mark in those figures, and are entitled to be protected from its infringement by a Court of Equity. (*Gillott v. Esterbrook*, 48 (N. Y.), 374; *Kinney v. Basch*, 16 Am. Law Reg., N. S., 596).

The case presented upon the trial of this action forces me to the conclusion that the defendants deliberately appropriated the figures "35" for the purpose of inducing the public to believe that the goods which are offered for sale by the defendants are the goods of the plaintiffs. Judge Van Brunt, in the case last cited, has well expressed the rule which is applicable to such cases.

3. The learned Judge says: "If the use of any words, numerals or symbols is adopted for the purpose of defrauding the public, the Courts will interfere to protect the public from such fraudulent intent, even though the person asking the intervention of the Court may not have the exclusive right to the use of these

words, numerals or symbols." (See *Lee v. Haley*, L. R., 5 Ch. App., 155; *Wotherspoon v. Currie*, L. R., 5 H. L., 508; *Coleman v. Crump*, 70 N. Y., 573; *Newman v. Alvord*, 51 N. Y., 189; *Enoch Morgan's Sons' Co. v. Schwachofer*, 5 Abb. New Cas., 265).

3. I am of the opinion that the plaintiff is entitled to an injunction restraining the defendants from using the figures "35," in designating the cards made by them, whether upon the cards themselves, or upon the labels of their boxes, but on the proof before me, I cannot say that there is such a resemblance between the boxes used by the defendants and the plaintiffs as will justify me in restraining the defendants from putting up their goods in drab colored boxes after they shall have abandoned the use of the figures "35."

Kidd *vs.* Johnson.

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IN THE UNITED STATES SUPREME COURT.
IN EQUITY.

KIDD*vs.*JOHNSON.

DECIDED OCTOBER, 1879.

REPORTED 100 U. S., 617.

“Magnolia Whiskey” Case.

The owner of a trade-mark which is affixed to articles manufactured at his establishment may, in selling the latter, lawfully transfer therewith to the purchaser the right to use the trade-mark.

APPEAL from the Circuit Court of the United States for the District of Louisiana.

The facts are stated in the opinion of the Court :

Mr. M. F. Morris, for the appellant.

Mr. E. M. Johnson, *contra*.

Mr. JUSTICE FIELD, delivered the opinion of the Court.

The question presented in this case relates to the ownership of a trade-mark used by the complainants on packages and barrels containing whiskey manufactured and sold by them in Cincinnati, and arises out of the following facts :

In 1849, one S. N. Pike, doing business in that city as a wholesale dealer in whiskey, adopted as a trade-mark for his manufacture the words, "S. N. Pike's Magnolia Whiskey, Cincinnati, Ohio," enclosed in a circle, which he placed on packages and barrels containing the liquor. Between that date and 1863 he was in partnership with different persons doing business there under the name of S. N. Pike & Co. In 1863, having dissolved his connection with others, he took as partners two of his former clerks, Tilney and Kidd, continuing he original firm-name, and soon afterwards opened a branch house in New York City. The same trade-mark was used by the new firm, as it had been by the preceding firm, without any change. At this time, and subsequently until its sale in 1868, the real property in Cincinnati, and the stills, tubs, engines, boilers, tubing, and all apparatus in his distillery, for the consideration of \$125,000, to the firm of Mills, Johnson & Co., who were also engaged in the manufacture and sale of whiskey at that place. At the same time, Pike executed and delivered to the purchasers a separate instrument, stating that, having sold his premises to them, he extended to them and their successors the use of all his brands formerly used by him in his Cincinnati house.

Mills, Johnson & Co. continued for some years the manufacture and sale of whiskey on the premises thus purchased, using, without objection from any one, the brands previously used by S. N. Pike & Co. They were succeeded in business by the complainants, who, it is admitted, are entitled to all the rights which they possessed in the trade-mark in question. S. N. Pike died in 1872, and his surviving partners formed a new partnership, under the name of George W. Kidd & Co., which was subsequently dissolved, and to its business Kidd, the appellant in this case, succeeded.

The complainants finding that whiskey bearing this trade-mark, manufactured by the firm of Tyra, Hill & Co., of St. Louis, was

sold in large quantities by dealers in New Orleans, filed the present bill to enjoin the dealers from selling or trafficking in whiskey contained in packages thus marked. By an amendment to the bill the defendant Kidd was made a party. He filed an answer and cross-bill, asserting title to the trade-mark as surviving partner of the firm of S. N. Pike & Co., and setting forth that Tyra, Hill & Co., were acting under a license from him.

The principal question for determination is, whether the complainants, claiming under the sale of Pike to their predecessors, or the defendant Kidd, claiming as survivor of S. N. Pike & Co., have the exclusive right to the trade-mark mentioned. The Court below decided that the complainants possessed the exclusive right, and our judgment approves of the decision.

It is admitted that Pike* was the owner of the trade-mark when he took two of his clerks into partnership and formed the firm of S. N. Pike & Co. He did not place his interest in the trade-mark in the concern as a part of its capital stock. He allowed the use of it on packages containing the whiskey manufactured by them; but it no more became partnership property from that fact than did the realty itself, which he also owned, and on which their business was conducted. He was engaged in the same business before the partnership as afterwards, and taking his clerks into partnership changed in no respect, beyond its terms, their relation to his individual property. Their subsequent conduct, moreover, plainly shows that they claimed no interest in the trade-mark. They knew of his conveyance of its use to Mills, Johnson & Co., on the 1st of October, 1868, when they removed their own business to New York, and made no objection to the transfer. Their subsequent correspondence discloses beyond question their knowledge of the transfer and recognition of his power to make it. That transfer was plainly designed to confer whatever right Pike possessed. It, in terms, extends the use of the trade-mark to Mills, Johnson & Co., and their successors. Such use, to be of any value, must necessarily be exclusive. If others also could use it, the trade-mark would be of no service in distinguishing the whiskey of the manufacture in Cincinnati; and thus the company would lose all the benefit arising from the reputation the whiskey

there manufactured had acquired in the market. The right to use the trade-mark is not limited to any place, city, or State, and, therefore, must be deemed to extend everywhere. Such is the uniform construction of licenses to use patented inventions. If the owner imposes no limitation of place or time, the right to use is deemed co-extensive with the whole country, and perpetual.

The claim of Kidd to the trade-mark as survivor of the partners in the firm of S. N. Pike & Co., is without any merit. Pike, in his life-time, repudiated any ownership in the trade-mark after his sale, and Kidd knew that fact, and never even pretended that the firm had any such right until after Pike's death.

As to the right of Pike to dispose of his trade-mark in connection with the establishment where the liquor was manufactured, we do not think there can be any reasonable doubt. It is true, the pecuniary object of a trade-mark is to indicate by its meaning or association the origin of the article to which it is affixed. As distinct property, separate from the article created by the original producer or manufacturer, it may not be the subject of sale. But when the trade-mark is affixed to articles manufactured at a particular establishment and acquires a special reputation in connection with the place of manufacture, and that establishment is transferred either by contract or operation of law to others, the right to the use of the trade-mark may be lawfully transferred with it. Its subsequent use by the persons to whom the establishment is transferred is considered as only indicating that the goods to which it is affixed are manufactured at the same place, and are of the same character as those to which the mark was attached by its original designer. Such is the purport of the language of Lord Cranworth in the case of *Leather Cloth Company v. American Leather Cloth Company*, reported in 11 *Jur. N. S.* See also *Ainsworth v. Walmesley*, 44 *L. J.*, 355; and *Hall v. Barrows*, 10 *Jur. N. S.* 55.

The present case falls within this rule.

Decree affirmed.

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UNITED STATES CIRCUIT COURT, NORTHERN
DISTRICT OF ILLINOIS. IN EQUITY.

WASHBURN & MOEN MANUFACTURING CO.

vs.

JACOB HAISH.

DECIDED OCTOBER, 1879.

REPORTED 4 FED. REP., 900.

“Barbed Wire Fence” Case.

1. A person has no right to mark his goods with any words or terms indicating that they are manufactured under a patent which he does not own and has no right to use.
2. A defendant, having so marked his goods, will not be allowed to defend himself by denying the validity of such patent.
3. An injunction will be issued to restrain a false and fraudulent libel upon the title of the complainant's patent.

Messrs. Coburn and Thacher, for the complainant.*Mr. J. V. Randall*, for the defendant.

BLODGETT, J.:

The bill in this case charges that complainant is owner of a patent for an improvement in barbed wire for fencing purposes,

No. 74,379, issued by the United States to Michael Kelly, dated the 11th day of February, 1868, and reissued on the 8th day of February, 1876; that defendant, Jacob Haish, under the name Jacob Haish, J. Haish & Co., and Jacob Haish & Co., who is a manufacturer of barbed wire for fencing purposes, has issued circulars and used tags and marks and put upon packages of barbed fence wire, words and terms stating and indicating that the wire manufactured and sold by him is made under said reissued patent, and also that he is owner of one-half of said reissued patent, to the great detriment of complainant's business. Complainant prays injunction restraining defendant from issuing any circulars or using any words or packages indicating that his goods are manufactured under said reissued patent.

Defendant admits the issue of said circulars and the use of tags and markings, substantially as charged in the bill, and also admits that he is not the owner of said reissued patent, and alleges that he is the owner of certain patents for barbed wire, under which he manufactures, and that he marks his goods with words showing that they are made under his said patents. He further alleges that said reissued patent is void, and that complainant has no right to the protection thereof.

1. I am very clear that the defendant has no right, upon the admitted facts in the case, to mark his goods with any words or terms indicating that they are manufactured under complainant's patent. He has the right, and it is his duty, to mark his goods with his own patent mark; but this does not give him the right to put upon the goods, any *indicia* showing that they are under another man's patent or a patent which he does not own and has no right to use. Several reasons occur to me why he should not be allowed to do this. In the first place, the owner of a patent has the right to regulate the quality of goods bearing his patent mark. The value of a patent to its owner may largely depend upon the quality of goods manufactured under it. By manufacturing and selling a poor article purporting to be made under complainant's patent, the value of the patent itself may be seriously impaired and the complainant damaged. In the second place, the public would be imposed upon and led to believe that

they were purchasing a genuine article made by the patentee or under his patent. This reason applies the more forcibly because the law makes it the duty of a patentee or those manufacturing goods under a patent to mark his goods with the word "patented," with the date of the patent; and persons purchasing such goods with the belief that they were made and vended by the patentee, or those acting under his license, might be liable to an action for infringement by the owner of the patent; and, thirdly, such an act is a direct violation of the property interest which the law vests in the owner of a patent. No man has the right to violate this right of property any more than he has to trespass on another's land or other tangible property. Nor can the defendant question the validity of this patent in this collateral way. If the patent is not valid, defendant has no right to impose upon the public by marking his goods with terms indicating that they are protected by a patent.

2. He cannot be allowed to use that to which complainant has at least the exclusive *prima facie* right, and then defend himself by denying the validity of the patent. Again, the effect of defendant's admitted acts is to call in question the complainant's title to this reissued patent.

3. He is in effect guilty of libel upon the complainant's title by asserting that he is the owner of half the patent; and this may work great injury to the complainant. Whether complainant can recover the damages in this action which it may have sustained by these admitted acts of the defendant is not now in question. The only relief at present invoked is the prevention of future damage to complainant, and to this extent, it seems to me, a case is made out for injunction.

An injunction will be issued restraining defendant, his agents, attorneys, servants, and associates, from marking any barbed fence wire or packages of barbed fence wire with any words or letters indicating that said wire is manufactured either in whole or part, under or pursuant to the said Reissued Patent No. 6,902.

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UNITED STATES CIRCUIT COURT, DISTRICT
OF NEW JERSEY. IN EQUITY.

HANFORD, ET AL.

v's.

WESTCOTT, ET AL.

DECIDED 10 NOVEMBER, 1879.

REPORTED 16 OFFICIAL GAZETTE, 1181.

“*Chestnut Grove Whiskey*” Case.

1. The Commissioner of Patents has authority under the statute and rules of the Patent Office to institute an interference between opposing claimants for registration of the same trade-mark for the purpose of determining the ownership of the same.
2. The decisions of the Secretary of the Interior in 13 *Official Gazette*, 963, and of the Commissioner of Patents in *Hoosier Drill Company vs. Ingals*, (14 *Official Gazette*, 785), considered and approved.
3. The decision of the Examiner of Interferences, not appealed from, in such an interference is conclusive upon the parties and their privies, and cannot be questioned in any other tribunal.
4. The successful party in such an interference is entitled to a provisional injunction against the licensees of the unsuccessful party when no doubt exists as to the infringement.

Mr. Geo. W. Dyer, for complainants.

Mr. Wm. B. Guild, for defendants.

NIXON, J..

This is an application for a provisional injunction to restrain the defendants from the use of registered trade-mark numbered 6,378. The record shows that the complainants, trading under the name of A. Hanford & Co., filed an application in the Patent Office on the 12th of June, 1878, for the registration of trade-mark consisting of the letters and words "Hanford's Chesnut Grove," when used in connection with the word "Whiskey," and that the same was registered on the 16th of July, 1878. They state in their application that they had continuously used this trade-mark in their business since the commencement of their partnership on the 1st of July, 1872, and that the said Albert Hanford had used the same for four years immediately preceding that date.

The defendants do not deny the infringement, but justify the use of the trade-mark as licensees of Charles Wharton, who, it is alleged, first adopted it in 1857, and has been in the constant use of the same ever since.

It further appears from certified copies of proceedings in the Patent Office, that after the registration of the said trade-mark for the complainants, to wit, on the 16th day of October, 1878, the said Wharton made application for the registration and record of the same to him, claiming the ownership.

The last clause of the eighty-sixth Rule of Practice of the Patent Office provides as follows:

1. In case of conflicting applications for registration, the Office reserves the right to declare an interference, in order that the parties may have opportunity to prove priority of adoption or right; and the proceedings on such interference will follow as nearly as practicable the practice in interferences upon applications for patents.

In accordance with this provision, the Patent Office declared an interference in this case; notice was given to the parties; a time fixed for filing the preliminary statements, and also for taking tes-

timony on the issue raised. After full hearing of the question, the Examiner of Interferences filed an opinion on the 16th of June, 1879, deciding the right to the use of the said trade-mark to be in the complainants. No appeal was taken from his decision, and, under the rules, the time for appealing has long since expired.

It is insisted in behalf of the complainants that the defendants, claiming under Wharton, are estopped from denying the complainants' title, and that the question of ownership, having been determined by a tribunal authorized by the law to settle it, cannot be opened here between the same parties or their privies. Such contention raises the inquiry whether the legislation of Congress has conferred upon the Commissioner of Patents the authority of determining the ownership of trade-marks upon application made for registration. The Secretary of the Interior claims, and the Commissioner of Patents exercise, such authority. (*Decision of the Secretary of the Interior*, 13 *Official Gazette*, 963; *Hoosier Drill Company v. Ingals*, 14 *Official Gazette*, 785). If rightly claimed and exercised, there has been an adjudication between the parties as to the ownership, which precludes them from raising the question again in another forum.

The Secretary of the Interior, in his decision, quotes section 483 of the Revised Statutes, which authorizes the Commissioner of Patents, subject to the approval of the Secretary, to establish regulations from time to time, not inconsistent with law, for the conduct of proceedings in the Patent Office. He says that, in pursuance of this provision, rules and regulations have been adopted by the Office, with the approval of the Secretary, wherein it is provided that all questions in relation to the priority of claims for trade-marks shall be referred to the Examiner of Interferences, and by him determined; and that the receipt of an application for a trade-mark, its consideration, allowance or rejection, and registration, if allowed, are all proceedings in the Patent Office, and that it is competent for the Commissioner of Patents and the Secretary of the Interior to make such rules and regulations in relation to the granting of certificates therefor and registration thereof as in their judgment shall seem proper.

The Commissioner refers to the clause of the eighty-sixth rule, hereinbefore quoted, which authorizes the declaration of an interference by the Office in order that the parties may have opportunity to prove priority of adoption or right, and thinks that the phrase "or right" in the rule has a wider signification than has heretofore been given to it; that it was meant to empower the officer to inquire into all the matters specified in section 4939 of the Revised Statutes, and into the disputes which may arise concerning them between applicants for registration. He holds that the clause in that section which prohibits the Commissioner of Patents from receiving and recording any proposed trade-mark "which is identical with the trade-mark appropriated to the same class of merchandise, and belonging to a different owner, and already registered or received for registration," constitutes the entire basis for an interference proceeding, and that an inquiry into the title or ownership is necessarily involved in determining the question of right.

2. I see no reason to dissent from the correctness of their reasoning and conclusions; and the more especially when the provisions of sections 4937 and 4938 of the Revised Statutes are considered, which require the Commissioner to ascertain and determine the party entitled to the exclusive use of the trade-mark for the use of which protection is asked.

The right existing in the Patent Office to declare an interference in trade-mark cases, such a declaration affords a tribunal where the parties may, if they please, try the question of title or ownership. It is not compulsory, for sections 4944 and 4945 of the Revised Statutes give cumulative remedies, and open the Courts to all persons who claim to have been wronged by false registrations, imposing penalties for fraudulent representations, verbal or written, and preserving to parties all existing rights and remedies at law or in equity. In the present case the applicant, Wharton, would have been permitted to withdraw his application for registration as soon as the interference was declared, and to go into the Courts for redress. He elected to attempt to prove his right before the Examiner of Interferences.

3. He put in his testimony, and acquiesced in the decision against him without appeal, and it is too late to assert that he is not bound by the result of the contest. A matter is always held to be *res adjudicata* where the question has been determined by a tribunal or competent jurisdiction, and where there is a concurrence or identity of parties, or privies claiming under them, and identity of purpose or object. (*Freeman on Judg.*, section 252; *Aspen v. Nixon*, 4 *How.*, 497).

4. The infringement being admitted, and the title to the trade-mark adjudicated between these parties, there is nothing left for the Court to do, at this stage of the proceedings, except to order a provisional injunction, and it is ordered accordingly.

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CIRCUIT COURT UNITED STATES, DISTRICT
OF COLORADO. IN EQUITY.

THE UNITED STATES*vs.*JOHN ROCHE.

DECIDED DECEMBER, 1879.

REPORTED I MCCRARY, 385,

"Best Brewing Company" Case.

1. TRADE-MARK DECISION OF SUPREME COURT—EFFECT OF.—The decision of the Supreme Court of the United States holding the trade-mark legislation of Congress to be unconstitutional and void, does not affect the validity or impair the force of a decree enjoining the use by defendant of a certain label or trade-mark, it appearing that the injunction suit wherein said decree was rendered was not a statutory but a common law proceeding.
2. COMMON LAW REMEDY FOR VIOLATION OF TRADE-MARK.—The right of the proprietor of a trade-mark to the exclusive use of the same, and

to protect and enforce his exclusive right by proceedings in Chancery, exists by virtue of the common law, and independently of the statute.

3. WHAT AMOUNTS TO INFRINGEMENT OF TRADE-MARK.—The defendant had no right to imitate the trade-mark of the plaintiff in the injunction, by using in his label or trade-mark any of the prominent or distinguishing words of said plaintiff's trade-mark.

MCCRARY, Circuit J.:

By decree of this Court entered at the June Term, 1879, the defendant was, at the suit of the Philip Best Brewing Company and others, perpetually restrained from thereafter using a certain trade-mark or label upon bottles of manufactured beer.

By an order of this Court at Chambers, made on the twenty-ninth day of September last, it was, after proper showing, ordered that the defendant show cause why he should not be attached or otherwise proceeded against for contempt of the decree aforesaid.

In answer to this rule, it is suggested that the Supreme Court of the United States having in the recent cases of *United States v. Steffens*, and *Same v. Johnson*, 100 U. S., 82, held the existing congressional legislation on the subject of trade-marks to be unconstitutional and void, the decree of injunction above mentioned is a nullity and the defendant is not bound to obey it.

1. Upon looking into the record we find that the injunction suit was not a proceeding instituted under the statute, but a bill in Chancery brought to protect and enforce the plaintiff's exclusive right of property in their trade-mark as that right exists at common law. In the opinion of the Supreme Court above referred to it is said: "The right to adopt and use a symbol or device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of the use of that symbol by all other persons, has been long recognized by the common law and Chancery Courts of England and of this country, and by the statutes of some of the States. It is a property right for which damages may be recovered in an action at law, and the violation of which will be enjoined by a Court of Equity with compensation for past infringement. This property, and the exclusive right to

its use, were not created by the Act of Congress and do not now depend upon that Act for their enforcement.

2. The whole system of trade-mark property and the civil remedies for its protection existed long anterior to the Act of Congress and remain in full force since its passage." It follows beyond all doubt that the validity of the decree heretofore rendered against the defendant is in nowise affected by the decision of the Supreme Court holding the trade-mark legislation of Congress to be unconstitutional.

It is, however, further insisted that the label or trade-mark now being employed by defendant is not so nearly like that of the plaintiffs in the injunction as to deceive a person of ordinary caution. This point, even if sound, comes too late. By reference to the decree, which was entered by consent, it will be seen that the defendant was, among other things, enjoined from using any label whatsoever bearing thereon the words "Best Brewing Company." These words are placed conspicuously upon the label which the defendant by his own admission has been, since the injunction, and is now, placing upon bottles of beer manufactured and sold or offered for sale by him. He has therefore violated the plain terms of the injunction.

If, however, the question was still an open one, we should hold, without hesitation, that the defendant is rightfully enjoined from using a label bearing the words "The Best Brewing Co." or "The Best Brewing Co's Export Beer." These are the prominent and distinguishing words upon the label or trade-mark now in use by the defendant as they are likewise upon the trade-mark or label of the plaintiff in the injunction.

3. The defendant has no right to imitate the trade-mark of the plaintiff in the injunction by copying therefrom any of these prominent or distinguishing words. The use by the defendant of a label bearing these words is, in our judgment, well calculated to deceive even the cautious and careful purchaser, by leading him to infer that it is the trade-mark of plaintiff in the injunction.

The showing of cause by the defendant is held to be insufficient, and it is accordingly ordered that an attachment issue against him returnable the first day of the next term of this Court, and that

upon service of the same the defendant enter into bond in the sum of one thousand dollars, with surety to be approved by the clerk, conditioned that he will appear on the first day of the next term of this Court and abide such further order as the Court may then make, and that in the meantime he will obey the decree of injunction aforesaid.

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COURT OF CLAIMS OF THE UNITED STATES.

GEORGE B. WOODMAN

vs.

THE UNITED STATES.

DECIDED DECEMBER, 1879.

REPORTED 15 CT. CLAIM., 541.

“Registration Fee” Case.

ON THE PROOFS.

The claimant applies for a trade-mark and pays the fee of \$25. His trade-mark is duly registered. Subsequently the statute authorizing the registration of trade-marks is declared unconstitutional. He sues to recover back the fee.

- I. The trade-mark statute (Rev. Stat., secs. 4937, 4938,) did not constitute a contract binding the government to protect a party in the exclusive use of his trade-mark.
- II. Where a person paid the prescribed fee for the registration of his trade-mark, he cannot recover it back on the statute relating to trade-marks being pronounced unconstitutional.

THE following are the facts of this case as found by the Court :
On the 10th of May, 1878, the claimant, a citizen of the State

of Pennsylvania, under the statute in such case made and provided, made the following application to the Commissioner of Patents.

“To the Commissioner of Patents,

“Your petitioner respectfully represents that he is engaged in the sale of flour, in the State of Pennsylvania, and that he is entitled to the exclusive use upon flour which he sells of the trade-mark described in the annexed statement or specification and illustrated in the accompanying fac-simile.

“He, therefore, prays that he may be permitted to obtain protection for such lawful trade-mark under the law in such cases made and provided.

“GEORGE BLISS WOODMAN.”

At the same time the claimant caused to be recorded in the Patent Office a statement in conformity with the first of the three requirements contained in section 4937 of the Revised Statutes, and also the written declaration, verified, as required by section 4938 of such statutes; and complied with all the regulations prescribed by the said Commissioner; and paid the fee of \$25 required to be paid in such cases; and the claimant's trade-mark was thereupon registered in the office of said Commissioner on the 21st of May, 1878.

Mr. George A. King, for the claimant.

1. The claimant and the government entered into a contract, by which on the one side was promised protection for the recorded trade-mark, and on the other side was the recording of the trade-mark, the payment of \$25, and a compliance with certain specified rules and regulations. (*Rev. Stat., sec. 4937*).

All of this has been fully performed and executed on the part of the claimant. Nothing whatever has been or can be done on the part of the government to fulfill its part. The claimant now sues to recover the money paid on contract the consideration of which on the other side has wholly failed. (*Dartmouth College v. Woodward*, 4 *Wheat.*, 518; *New Jersey v. Yard*, 95 *U. S.*, 104; *Claf-*

lin v. Godfrey, 21 *Pick.*, 1; 1 *Story Eq. Jur.*, 142, 143; *Hitchcock v. Gittings*, 4 *Price*, 135; 2 *Kent Com.*, 369; *Stent v. Bailis*, 2 *P. Wms.*, 220; *Colyer v. Clay*, 7 *Beav.*, 188; *Allen v. Hammond*, 11 *Pet.*, 63; *Champlin v. Laytin*, 1 *Edw.*, 471; *Bliss v. Negus*, 8 *Mass.*, 46; *Hill v. Rewee*, 11 *Met.*, 271; *Wheeler v. Board*, 12 *John.*, 363; *Brown v. Harris*, 2 *Gray*, 359; *Carter v. Carter*, 14 *Peck.*, 428; *Farrington v. Tennessee*, 95 *U. S.*, 679).

2. The United States are a corporation. (*United States v. Maurice*, 2 *Brock.*, 96; *United States v. Fox*, 94 *U. S.*, 315). Their Constitution is their charter and the law of their being. (*Cooley Const. L.*, 9; *Martin v. Hunter*, 1 *Wheat.*, 326; *Gibbons v. Ogden*, 9 *Wheat.*, 187). The case at bar may very properly be considered as the case of a corporation entering into a contract *ultra vires*. In such a case it is always held that the corporation must account for all benefits that it has received under the *ultra vires* transaction. Especially must it return all moneys which it has actually received. (*Green's Brice's Ultra Vires*, 717-749; *Bank of Australia v. Breillat*, 6 *Mov. P. C. C.*, 152; *Burges & Stock's Case*, 2 *J. & H.*, 441; *Wilson's Case*, *L. R.*, 12 *Eq.*, 521; *Whitney Arms Co. v. Barlow*, 63 *N. Y.*, 62; *Boisgerard v. N. Y. Banking Co.*, 2 *Sandf. Ch.*, 23; *Dickinson v. Hall*, 14 *Peck.*, 217; *Howe v. Richards*, 32 *Mass.*, 64; *Dill v. Wareham*, 7 *Met.*, 431).

The money sought to be recovered in the present action was paid under a mistake. If our two preceding propositions are sound, it is wholly immaterial whether the mistake was one of fact or of law. (*Clafin v. Godfrey*, 21 *Pick.*, 1). We do not believe that the case, rightly considered, turns on the question of mistake. If, however, the case is considered as one of money paid under a mistake of law, it is submitted that it is within the well-settled and recognized exceptions to the rule that money paid in mistake of law cannot be recovered back. "But whether Equity will or will not interfere in the case of a pure mistake of law, and whatever may be the true distinction to be taken between the cases, it is nevertheless clear that any additional circumstances will readily be laid hold of by the Court, as constituting sufficient grounds for interposition.

“Thus, where ignorance of the law exists on one side, and that ignorance is known and taken advantage of by the other party, the former will be relieved. More particularly will this be so if the mistake was encouraged or induced by misrepresentation of the other party.” (*Bisp. Prin. of Eq.*, sec. 188). And the rule is the same at law, in the action for money had and received—an action of which this Court has undoubted jurisdiction. (*United States v. State Bank*, 96 U. S., 30), and which is called by Blackstone, (3 *Com.*, 162), “a very extensive and beneficial remedy,” and by Lord Mansfield, (*Moses v. Macferlan*, 2 *Burr.*, 1002), a “kind of equitable action,” (2 *Chit. Con.*, 898–950; *Br. L. M.*, 79; 1 *Story Eq. Juris.*, 110–139; *Newdigate v. Davy*, 1 *Ld. Raym.*, 742; *Bisp. Prin. of Eq.*, 184–189; 2 *Evans’ Pothier on Oblig.*, 308; *Bize v. Dickason*, 1 *T. R.*, 285; *Reynell v. Sprye*, 1 *D. M. & G.*, 710; *Ex parte James in re Condon*, *L. R.*, 9 *Ch. App.*, 609; *Fane v. Fane*, *L. R.*, 20 *Eq. Ca.*, 698; *Bristowe v. Whitmore*, 9 *H. L. C.*, 391; *Hunt v. Rousmanier*, 8 *Wheat.*, 174; *Veasie v. Williams*, 8 *How.*, 134; *Wheeler v. Smith*, 9 *How.*, 55; *Bayne v. United States*, 93 U. S., 642; *United States v. State Bank*, *Ib.*, 30; *Snell v. Insurance Co.*, *Ib.*, 85; *Brown’s Case*, 6 *C. Cls. R.*, 171; *McElrath’s Case*, 12 *Ib.*, 201; *McKee’s Case*, *Ib.*, 504; *Ellsworth’s Case*, 14 *Ib.*, 382; *Jordan v. Stevens*, 51 *Me.*, 78; *Northrop v. Graves*, 19 *Conn.*, 548; *Green v. M. & E. R. R. Co.*, 1 *Beas. Ch.*, 165; *Snyder v. May*, 7 *Harris*, 238; *Brown v. Rice*, 26 *Gratt.*, 470; *Lowndes v. Chisholm*, 2 *McCord Ch.*, 455; *Lawrence v. Beaubien*, 2 *Bailey*, 623; *Hopkins v. Mazyck*, 1 *Hill Ch.*, 242; *Culbreath v. Culbreath*, 7 *Ga.*, 64; *Underwood v. Brockman*, 4 *Dana*, 309; 3 *Pars. Cont.*, 39; *Steamship v. Joliffe*, 2 *Wall.*, 457; *Bisp. Prin. Eq.*, 212).

Mr. Assistant Attorney-General Simons, for the defendants.

First. The fee was paid voluntary, with full knowledge of all the circumstances. That there can be no recovery in such case is fully established both at law and in equity. (2 *Sm. L. C.*, *Hare & Wallace*, 453; 1 *Pars. Cont.*, 5th ed., 466; *Elliott v. Swartwout*, 10 *Pet.*, 153; *Hunt v. Rousmanire’s Adm’rs*, 1 *Pet.*, 1; *Sohle-*

singer's Case, 1 C. Cls. R., 16; *Folsom's Case*, 4 *Ib.*, 366; *McClelland's Case*, 10 *Ib.*, 68).

Second. The consideration has not wholly failed as alleged. The claimant had for a certain time full benefit of the Act, and it is not shown that he has been in any way damnified.

The fee cannot justly be considered in the light of consideration for the protection afforded, but as a reasonable charge for the service required to secure the benefit of the Act, which the claimant has had.

DRAKE, Ch. J., delivered the opinion of the Court.

1. This action is based on the theory that under the statute authorizing the registration of trade-marks, the United States entered into a contract with every person adopting a trade-mark, and procuring its registration in the Patent Office, to protect him in the exclusive use thereof for the period of thirty years; and that the defendants have failed to keep and fulfill, and are disabled to keep and fulfill their contract with the claimant, because the Supreme Court of the United States has decided that the trade-mark statute is void for want of constitutional power in Congress to enact it; and therefore his trade-mark is without the statutory protection for which he had applied, and supposed he had obtained, and therefore he sues to recover back the fee of \$25 which he paid to obtain the registration of his trade-mark.

There is in this no ground for this action.

The \$25 which the claimant paid was a mere fee, which the statute required to be paid as a condition precedent to the registration; and the statute nowhere imposes upon the United States the obligation to repay it to the claimant under any circumstances whatever.

If the trade-mark statute could be considered to amount in any respect to a contract between the United States and any proprietor of a trade-mark, it was only that on paying that fee and otherwise complying with the requirements of the statute, his trade-mark should be registered in the Patent Office. That was done in the claimant's case.

There is nothing in the statute which binds the United States to protect the claimant in the exclusive use of his trade-mark. It simply declares that he shall be entitled to certain legal rights and remedies in connection with its use.

2. It was for him to determine, before paying the fee, whether it was under the statute worth \$25 to him to have his trade-mark registered; and having decided that it was; and paid the money, the transaction was a completed one, with no ground for any resulting liability on either side.

The claimant's petition is dismissed.

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SUPREME COURT, STATE OF OREGON.

M. LICHTENSTEIN, APPELLANT,

*vs.*MELLIS BROS., RESPONDENTS.

DECIDED JANUARY, 1880.

REPORTED 8 OREGON, 464.

"I X L Auction Store" Case.

TRADE-MARK—INFRINGEMENT OF.

L. recorded the following as a trade-mark: "I X L General Merchandise Auction Store," and used the same as a sign over his place of business. M. afterwards used as a sign over his store: "Great I X L Auction Co." **Held:**

That the Court will not suppress the use of the latter as an infringement of L's trade-mark.

APPEAL from Multnomah County.

This is an action for damages for violation of plaintiff's rights to a trade-mark, commenced in the Circuit Court decided against appellant on demurrer to the amended complaint. The complaint shows, by proper allegations, that the plaintiffs have the exclusive

right to use as a trade-mark the name "I X L General Merchandise Auction Store," and that the respondents, knowing the fact, fraudulently, and for the purpose of deceiving the public, use the name "Great I X L Auction Company." The Court below sustained the demurrer to the complaint, upon the ground that the facts stated did not show an infringement of the plaintiff's trade-mark.

O. P. Mason and E. T. Howes, for appellant.

Johnson, McCown and Macurm, for the respondents.

BY THE COURT, BOISE, J.:

It is conceded that the first ground of demurrer, to wit, that the Court has not jurisdiction of the case, is not tenable; and the appellants now rely on the second ground of demurrer, to wit, that the complaint does not state facts sufficient to constitute a cause of action. In determining this cause of demurrer, we will first consider the matter as to whether or not the letters and words "I X L General Merchandise Auction Store," which constitute the trade-mark of the plaintiff, are so nearly identical with or similar to the words and letters used by defendants, to wit, "Great I X L Auction Co." as to be likely to mislead the public, and cause the one to be taken for the other, and thereby draw the customers of the appellant to the store of the respondents, and thereby injure the business of the appellant. We do not think the letters and words used by the parties are so nearly identical in appearance or meaning as to mislead the public. The words used by the appellant, "General Merchandise Auction Store," suggest that the store contains a general assortment of merchandise, and that goods are there sold at auction. The words "Great Auction Co." would suggest that the Co. sold goods and other property, such as lands and such other things as are embraced under the head of general merchandise. All the words are different in these respective signs except the words *auction*, and this is a word that is generally used over all places where auctions are conducted, and can not be appropriated by any one as a trade-mark without being used with other words,

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It is claimed that the letters "I X L" could not be used by the respondent after being appropriated by the appellant. These letters have been used by many manufacturers to denote their wares, as on cutlery and on bitters, and were not the invention of the plaintiffs, but taken by them from former proprietors and inventors thereof, and do not by themselves make a trade-mark any more than the word *excelsior*, which is often used with other words to make a trade-mark or sign. And in this case, the appellants have recorded all the words above with these letters as their trade-mark, and cannot now claim that these letters alone constitute it. We think the signs of the parties are not sufficiently similar to warrant the Court in interfering to restrain the respondents, or to entitle the appellant to damage.

The judgment of the Circuit Court will be affirmed, with costs.

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SUPREME COURT, STATE OF NEW YORK.
SPECIAL TERM. IN EQUITY.

THE ROYAL BAKING POWDER CO.

vs.

GEORGE SHERRILL, ET AL.

DECIDED JANUARY, 1880.

REPORTED 59 HOW. PR., 17.

“Royal Flavoring Extract” Case.

TRADE-MARK—WHEN A WORD BECOMES PROPERTY AND
ITS USE AS A TRADE-MARK WILL BE PROTECTED.

Where the case clearly shows that the plaintiffs and those through whom they claim were the first to use the word “Royal” as a portion of their trade-mark in connection with flavoring extracts, and have continued its use for a number of years, **HELD:**

That such appropriation of this word, although it is a common one, to distinguish an article produced by them, and although it is only applied to one grade of the article they manufacture, but by which distinctive appellation it has come to be known, dealt in, and used, gives to the

plaintiffs the right to its exclusive use in respect to such production, and such right will be protected.

James W. Gerard, for plaintiff.

C. M. Marsh, for defendant.

VAN VORST, J.:

The case clearly shows that the plaintiffs and those through whom they claim were the first to use the word "royal" as a portion of their trade-mark in connection with flavoring extracts; and that its use has been continued by them ever since the year 1868.

Such appropriation of this word, although it is a common one, to distinguish an article produced by them, and although it is only applied to one grade of the article they manufacture, but by which distinctive appellation it has come to be known, dealt in, and used, gives to the plaintiff the right to its exclusive use in respect to such production.

If the defendant produces a kindred article he should designate it by some other distinctive word or character, and not appropriate to himself a term by which the plaintiff's article is peculiarly known and distinguished.

Natural justice suggests such course. The defendants' article is put up in packages quite similar to those of the plaintiff, and it can be readily understood that the defendants' use of the word "royal," although followed, as it is, by the term "standard," is calculated to mislead purchasers who call for the "royal" extract.

The word "royal" in regard to an article produced by one manufacturer, when a similar article is also produced by others, may get a reputation, and go into use in connection with that word. In such case the word itself becomes property, to the extent above indicated, to the one who first distinctly appropriates it to his use. Such seems to be the case with the plaintiff's article in connection with the word "royal." Plaintiffs ought not to lose the advantage of their appropriation of this word through the action of others whether designed or unintentional.

The fact that the defendants had used the word "royal" in connection with a grade of mustard made by them, gives no right to

its use to designate a flavoring extract after the plaintiff had first distinctly adopted the use of the word for such other production.

Prior in time, prior in right. There should be judgment in favor of plaintiff, restraining the use by the defendants of the word "royal." Singly or as qualifying any other words to designate flavoring extracts.

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CIRCUIT COURT UNITED STATES, DISTRICT
OF MARYLAND. IN EQUITY.

SAWYER

vs.

HORN.

DECIDED 17 JANUARY, 1880.

REPORTED 1 FEDERAL REPORTER, 24.

"Sawyer's Crystal Blue."

TRADE-MARK—FRAUD—INJUNCTION.

A Court of Equity will restrain the fraudulent imitation of a package and label, although they do not technically constitute a trade-mark, where the public are thereby misled into purchasing the goods of the imitator as those of the original manufacturer.

MORRIS, J.:

The bill alleges that the complainant, Henry Sawyer, of the City of Boston, in the State of Massachusetts, has been for about 20 years engaged in the manufacture of bluing; that his bluing has an extended and desirable reputation in the markets of the United States, and especially in Baltimore, where it has been and

now is regarded as an article of great excellence, and has been sold in Baltimore and elsewhere in large quantities.

That in order to identify the bluing made by him and distinguish it from all others, complainant devised and adopted, as a trade-mark, certain marks, symbols and devices, and a form of package, none of which had been before at any time applied or used in connection with bluing, and which have continually, ever since, been used by him to identify his bluing.

That the marks so adopted were:

1. A red disk, applied on the top of the box, which had been first used by him in 1863, and had been registered by him, according to the statutes of the United States, as a trade-mark.

2. Certain pictorial representatives of his boxes, which he used as part of the labels, applied to the outsides of the packing boxes, in which the small boxes containing the blue were packed for market.

3. An allocation or combination, consisting of words printed in bronze letters on blue paper, constituting the label surrounding the small boxes containing the blue.

And also a new and original and peculiar form of package or box to contain the blue, consisting of a cylinder, having a top of metal, perforated with holes, sealed with red sealing wax.

Also a packing box with certain distinctive labels before mentioned, in which the cylindrical boxes were so packed and arranged that upon being opened nothing was exposed to sight but the red tops.

And the bill charges that the respondent Horn is engaged in Baltimore in the business of manufacturing blue, and, knowing the high reputation of complainant's goods as identified by his said marks and labels and peculiar appearance, has for his own profit, and to the injury of the complainant, been selling bluing put up in boxes made in imitation of complainant's, and had attached to the boxes palpable imitations of complainant's trade-marks.

And that said respondent, Horn, had willfully and fraudulently put up his bluing in packages substantially the same in every material respect, and having substantially the same general appear-

ance as those of complainant, and had packed the same in the precise form and manner originated and used by the complainant, and has sold the same as and for the bluing of the complainant.

The bill further alleges that the respondent's imitation of the complainant's peculiar form of package, labels and manner of packing created confusion in the market, and misled and deceived purchasers who were familiar with and desired to obtain complainant's goods, and that respondent's goods were inferior and sold at a less price than complainant's.

The bill prays for an injunction and account.

These are in substance the more important allegations of the bill.

The respondent's answer admits that the complainant is a manufacturer of bluing as alleged, but denies that prior to 1878, the complainant ever claimed any of the alleged symbols, marks, or form or package as his trade-mark, or that he has ever attached to his bluing anything in the nature of a trade-mark, except the fac-simile of his signature, the dates of the patent and reissue obtained by him, and the word "Crystal;" and respondent alleges that the red top of the boxes, the blue color of the label, the lettering, type, phraseology, green box, and other matters claimed by complainant in his bill, are such as belong to commerce and the public in general, and are not susceptible of exclusive appropriation by any one.

Respondent further alleges that complainant had, in the year 1864, obtained a patent for the said box containing his bluing, in which it was described as a package or case, which, when made with distributing holes and filled, is cemented by wax or a wafer, which patent was afterwards held to be void.

That the red top was produced by the application of Venetian red, for the purpose of stopping the perforations, in the top of the package until required to be opened for use, and that the claim of the red top as a trade-mark was an after-thought of the complainant, suggested as a means of continuing his monopoly after his patent was annulled. That it was not a proper subject of registration as a trade-mark, had never been used or applied as described in the certificate of registration, and was but the ordi-

nary use of a cheap and well known red material as a cement to the perforations of the box, and when so applied became part of the box itself, and not in any sense a trade-mark.

Respondent further claims that the pictures used by him on the lids of his larger packing boxes were simply pictures free to be used by any one, and alleges that the form of packages, labels and other marks claimed by complainant are not original or peculiar, but had been long used by many persons in the same trade.

The respondent admits that he does put up and sell a bluing in boxes having a resemblance in form to those sold by the complainant, but denies that he has done so fraudulently, or that he has ever done so in imitation of the complainant's bluing, or ever done anything not warranted by a fair competition in business, and denies that he has ever offered to sell any of his goods as and for the goods of the complainant, or sold any goods bearing any marks belonging exclusively to complainant, or any false representations thereon calculated to create confusion, and cause his goods to be purchased as and for the goods of the complainant.

He admits that he sells his goods cheaper than the complainant, but alleges that he gives as good an article for less money.

The case now comes on for final hearing, and we have been greatly assisted by the careful and thorough manner in which the facts have been presented, and by the able arguments of counsel, and the very numerous exhibits which have been brought to our attention illustrating and explaining the facts in this controversy, and also many of the subjects of controversy passed upon in the cases cited in argument.

It appears that the complainant Sawyer in 1863 began using the present form of box as a convenient method of putting up washing blue in a dry powder, and that he began to distinguish them by using a red colored top in 1866.

He used a box, which is a small cylinder of wood, about an inch in diameter, and about two inches high. The box, when filled with the blue powder, is covered by a tin top, with a flange fitting over the top of this box. The tin cover is perforated with five small holes, so that when needed for use the blue powder can be sifted out as from the ordinary pepper caster or dredging box.

Until needed for use the perforations are closed by something in the nature of sealing wax, by pricking which the perforations can be opened.

This device was supposed by the complainant to be patentable, and he did obtain therefor a patent dated January 5, 1864, re-issued October 1, 1867, but by a decree of the Circuit Court for the Southern District of New York, this patent was held to be void, and that decree, upon appeal to the Supreme Court, has, since the argument of this case, been affirmed.

The bluing manufactured by the complainant and offered in packages of this form, obtained great favor and became well-known, and has been the source of large profits. It became well-known not only in Massachusetts, where complainant's place of manufacturing is, but in Baltimore, where he has sold large quantities since the year 1871.

Upon the cylindrical box of the complainant he has, since 1866, used a label of dark blue paper, printed in silver letters, which completely envelopes the box, and the metal top is covered entirely by a coating of Venetian red and varnish, so that the box, when standing upright, presents nothing but the blue label and the red top.

The quantity of red cement used is in excess of the quantity necessary to be applied, simply to cover the five small perforations in the metal top, and not only completely covers all the top, but extends nearly a quarter of an inch down the sides of the box, enveloping the whole metal covering.

The box and label and top which the respondent uses is similar in size, shape and appearance, so that, except for the words on the label and the color of the printing, which is in gold bronze instead of silver, and a hardly observable difference in the shade of the red color on the top, there is nothing to distinguish them, and unless the two are side by side and attention has been freshly called to these differences, no one can discriminate between them.

They both present the appearance at a little distance of a blue cylinder, with printing in gilt letters, with a red top of sealing-wax.

The respondent states that he was by trade a stone-cutter, and for a while kept a grocery store, and about 1873 began putting up bluing. That from the first he used the cylindrical box and blue label, but not the red top, and that about 1876, learning that Sawyer's patent had been held void, and supposing it was the red top which had been the subject of the patent, he then began to use the red top.

The labels, when compared, show that they are precisely of the same size and color. Both are divided by vertical lines into four sections of precisely the same sizes, but the words printed on them are different.

On Sawyer's label is printed horizontally:

Sawyer's
Chrystal
Blue
and
Safety box:
Patent Jan. 5th, 1864;
Re-issued Oct. 1st, 1867.

Then vertically and enclosed by the vertical lines:

The Standard Blue of America. This form is the best and cheapest method of using Bluing. The quality is unexcelled.

Directions:

Pierce the prints on the top with a pin, and shake a few grains into a cup of soft water; then stir in the rinsing water.

Prepared by H. Sawyer,
Boston, Mass.
H. Sawyer.
(*fac-simile of signature.*)

On Horn's label is printed, with exactly the same divisions by straight lines, and in almost the same type, horizontally:

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Horn's
unexcelled Sifting box
Blue.

Baltimore.

The Standard Blue of the United States.

The quality is unequaled.

Directions:

Pierce the holes of the top with a pin, and sift a few grains in a bowl of water, stir until fully dissolved, then add to the rinsing water.

Prepared by
Jas. G. Horn,
Baltimore, Md.

No one, we think, having the two labels before him, could believe that the similarities were the result of accidental coincidence. And no one having before him the two boxes, with their similar blue labels and red tops, could fail to be convinced, we think, that there was an intentional similarity in their general appearance, well calculated to deceive persons exercising ordinary caution into mistaking one for the other.

The name and place of manufacture on the labels are different, and many of the words, but the color, size, type, and arrangements and divisions are in such exact similitude in all respects as to divert attention from the differences and to produce the impression that they are the same.

The labels, if pasted upon a flat surface, could with less difficulty be distinguished from each other, but when pasted around a small cylinder, in such a way that only about a fourth of the surface can be seen at one time, it becomes a matter of painstaking comparison to detect the differences.

The proof and the exhibits also show that these cylindrical boxes are packed by Sawyer, by putting four dozen of them into a square, green, paper box just deep enough to contain them when standing upright, and when the lid is taken off nothing is seen of the cylindrical boxes, as they pack very close to each other, but the red

tops, and the appearance is that of an almost solid, square mass of red sealing-wax.

And the proof and exhibits show that the respondent packs his cylindrical boxes in precisely the same way, presenting precisely the same appearance. These large boxes of Horn's being of the same color, and having on them labels very similar in designs and color to those of the complainant.

We are satisfied, from an inspection of the exhibits, that the general similarity between the goods of the complainant and respondent in all these respects could not have resulted from accident, but must have been the result of intention, and that the general resemblance is so great as to lead to confusion; and that a purchaser who had been in the habit of getting Sawyer's goods would have to exercise unusual and peculiar care not to take the goods of Horn if they were offered to him.

And, as matter of fact, the depositions of a large number of persons who themselves use the blue for washing purposes in Baltimore were produced, who testified that they knew of Sawyer's blue only by the appearance of the box, and, having been in the habit of using Sawyer's blue, and expecting to get it, had taken Horn's blue when offered them by retail dealers, supposing it was what they had been in the habit of using, knowing it only by the red top and blue box.

Being satisfied that these are the facts as proved by the complainant, we are now to consider the law applicable to them, and what is the remedy, if any, to which the complainant is entitled.

As to the simple question of trade-mark, we think the respondent is sustained in the position taken by him. The red top being, as to its use, a covering for the perforations in the metal top, and as to its color and material, one of the most common of all the cements used to close and seal the mouths of jars, bottles, cans and similar packages, and there being impressed on it no mark or design, it cannot, we think, be said to be a trade-mark, and cannot be exclusively appropriated by the complainant; nor can the form of his box, it having been decided not to be a patentable contrivance, be monopolized by him; nor can the color of the label, nor the allocation of the words thereon, nor the type, be

exclusively appropriated. The word "crystal," as applied to bluing, may be his trade-mark if he first so applied it, and the facsimile of his autograph signature, but these are all ; so that it does not appear, as to anything which the complainant can call technically a trade-mark, that the respondent has been guilty of piracy or imitation.

But we do find that the respondent has been guilty of improper and inequitable conduct, to the injury of the complainant, in having designedly so put up, labeled and packed his goods that purchasers, for whose use they are intended, are misled and deceived, and do get Horn's blue, when they desire and suppose they are getting Sawyer's. And that Sawyer, the complainant, having, after many years of manufacture, established a market and demand for his goods, as known by their peculiar and distinctive appearance, which he was the first to adopt, is now deprived of profits which he would otherwise obtain, by the fact that, after he had so established a reputation and demand for his goods, the defendant, with the intention of getting the benefit of that reputation and demand, has put his goods on the market prepared with such close imitation of the complainant's that they are mistaken for his.

The respondent, while he denied (and there is no evidence whatever to the contrary) that he ever represented or authorized any one to represent that his goods were Sawyer's, does, in his testimony, admit that he put up his goods with the appearance they now have because it was "fashionable," and because he found that a blue box with a red top made them more salable ; and as he sells his goods to the grocers at 50 cents for four dozen, while Sawyer has been accustomed to sell his for 85 cents, it is easy to see that the grocers prefer to give their customers Horn's goods, if they will take them, as both retail at about the same price.

It has been said that the fundamental rule applicable to such cases is that one man has no right to put off his goods for sale as the goods of a rival dealer, and that, "he cannot therefore, be allowed to use names, marks, letters or other *indicia* by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person." *Perry v. Truefitt*,

6 *Beav.*, 66-73. And this principle has been recognized as applicable in cases which were not strictly cases of technical trade-marks by many well considered decisions.

In *Williams v. Johnson*, 2 *Bosworth*, 1, decided in 1857 by Chief Justice Duer and Associate Judges Hoffman and Woodruff upon appeal to the general term of the Supreme Court of New York, without deciding whether or not the complainant was entitled to the use of the words "Genuine Yankee Soap," which he claimed as his trade-mark, the Court held that the imitations of the size, shape, style, labels and substantial appearance of the complainant's goods by the defendant was a fraud, and that he was entitled to protection, and decreed that the defendant should be enjoined from using the labels, devices and hand-bills which he had been using, and from using any other similar ones, calculated to deceive the public or create the belief that the soap sold by the defendant was the soap made and sold by the complainant.

Croft v. Day, decided in 1843, (7 *Beav.*, 84), was not a case of trade-mark strictly, but of the use by two persons, one named Day and the other named Martin, composing a new firm of Day & Martin, of boxes and labels for putting up blacking similar to those which had been for many years used by an old firm of Day & Martin. In giving the reasons for his decision, Lord Langdale, the Master of the Rolls, said: "The accusation which is made against the defendant is this: that he is selling goods under forms and symbols of such a nature and character as will induce the public to believe that he is selling the goods which are manufactured at the manufactory which belonged to the testator in this cause. I stated on a former occasion that in my opinion the right which any person may have to the protection of this Court does not depend upon any exclusive right which he may be supposed to have to a particular name or to a particular form of words. His right is to be protected against fraud. It is truly said that if any takes upon himself to study these two labels he will find several marks of distinction. On the other hand, the colors are of the same nature, the labels exactly the same size, the letters are arranged precisely in the same mode, and the very same name appears on the face of the jars. It appears to me that there is

quite sufficient to mislead the ordinary run of persons, and that the object of the defendant is to persuade the public that this new establishment is in some way or other connected with the old firm, and at the same time to get purchasers to go to 90½ Holburn Hill, and not to 97 High Holburn. I think what has been done is quite calculated to effect that purpose, and the defendant must be restrained."

"My decision does not depend on any peculiar or exclusive right the plaintiffs have to use the names Day & Martin, but upon the fact of the defendant using those names in connection with certain circumstances, and in a manner calculated to mislead the public, and enable the defendant to obtain, at the expense of Day's estate, a benefit for himself to which he is not in fair and honest dealing entitled."

In the case of *Holloway v. Holloway*, (1850), 13 *Beav.*, 209, the plaintiff having established a reputation for preparations known as Holloway's pills and ointment, his brother Henry began to sell H. Holloway's pills and ointment, put up in similar boxes, and with labels and wrappers similar to plaintiff's. The master of the rolls said that, although the defendant had a right to constitute himself a vendor of Holloway's pills and ointment, he had no right to do so in such a way as to deceive the public, and make them believe he was selling the plaintiff's medicines, and that he could not be allowed to perpetrate such a fraud.

In the leading case of the *Leather Cloth Co. v. American Co.*, 11 *Jur.*, (N. S.), 513, upon appeal to the House of Lords, the case was finally disposed of upon the ground that the alleged trademark was simply an advertisement of the quality of the goods, and that it was in both cases printed in very large type, in a circle more than six inches in diameter, easily read and hardly to be mistaken one for the other; and Lord Cranworth, in dismissing the case, says: "I mention this because, if, instead of occupying this large space, the whole had been engraved on a stamp of the size of a shilling, so as not to be capable of being read without close examination, the case would have been different."

In the case of *Dixon Crucible Co. v. Guggenheim*, decided by Judge Paxon in 1870, (2 *Brewster*, 321), although there was no

technical trade-mark, to the exclusive right of which the plaintiffs were entitled, the fact that the defendant's packages of stove polish were in size, shape and labels obviously a fraudulent imitation of the complainant's, induced the Court to grant relief; although it was shown that the wholesale dealers generally understood the difference, and only the consumers were likely to be deceived.

And in that case, although reference is made to a Pennsylvania statute intending to restrain the counterfeiting of private stamps and labels, the reasons given by the learned Judge for his decision are based entirely upon general principles adduced from authorities cited by him.

The case of *Enoch Morgan's Sons' Co. v. Schwakhofer*, in the Supreme Court of the City of New York, was decided upon the same principle. The plaintiffs adopted the name of "Sapolio" as a trade-mark for their goods, and it became known by that name, and by the peculiar and distinctive styles of packages, labels and wrappers in which it was put up. The defendant began manufacturing the same kind of goods and adopted the name "Saphia" as his trade-mark, and adopted the same style of package, with labels and wrappers which, though a careful inspection disclosed that they were different in almost every particular, and had the defendant's own name on them, yet the Court, finding that the defendant's goods were in appearance so close an imitation of the plaintiffs', that consumers of ordinary caution did receive one for the other, and finding that the imitation was designed to mislead purchasers, enjoined the defendant.

The case of *Stonebraker v. Stonebraker*, 33 Md., 252, is also a well considered case in which an injunction was affirmed by the Court of Appeals of Maryland, preventing the use of labels upon medicinal preparations similar to those used by the complainant.

The case of *McLean v. Fleming*, (96 U. S., 245, *October Term*, 1877), is a late and authoritative decision by the United States Supreme Court of questions similar to those arising in the present case, and the principles announced in that decision are, it seems to us, conclusive on the point that the right to a technical trade-mark, in the strict sense of the word, is not necessary to entitle the complainant to relief. For, although the complainant

had, in that case, registered their label as a trade-mark, under the Act of Congress, (which has been declared unconstitutional since the case now under consideration was submitted for decision), it appears that their so-called trade-mark was in fact, more strictly speaking, only a label.

In *McLean v. Fleming* the complainants for many years had been selling preparations labelled "Dr. C. McLane's Liver Pills," and had put up the pills in wooden boxes of uniform size, shape and appearance, with the name of the original inventor stamped in red wax upon the cover of each box, around which they placed a label or wrapper printed in a distinctive style. About 1855, they adopted a black label with white lettering. The defendant, whose name was J. H. McLean, and who had also for many years been making and vending the same kind of pills in boxes similar to complainants', also adopted a black label with white lettering, very similar to complainants', on which he put the words "Dr. J. H. McLean's Universal Pills or Vegetable Liver Pills." It did not appear that the defendant entered upon the business, expecting any advantage from the similarity of names, as the manufacture was begun by both in places far apart, one in Virginia, the other in Kentucky, upwards of twenty years before the filing of the bill.

The Supreme Court, by Mr. Justice Clifford, delivering its unanimous decision, said: "Positive proof of fraudulent intent is not required when proof of infringement is clear, as the liability of the infringer arises from the fact that he is enabled, through unwarranted use of the trade-mark, to sell a simulated article as and for the one which is genuine. Nor is it necessary, in order to give a right to an injunction, that a specific trade-mark should be infringed, but it is sufficient that the Court is satisfied that there was an intent on the part of the respondent to palm off his goods as the goods of the complainant, and that he persists in so doing after being requested to desist. Difficulty frequently arises in determining the question of infringement, but it is clear that exact similarity is not required, as that requirement would always enable the wrong-doer to evade responsibility for his wrongful acts. Colorable imitations, which require careful inspection to

distinguish the spurious trade-mark from the genuine, is sufficient to maintain the issue; but Courts of Equity will not interfere when ordinary attention by the purchaser would enable him at once to discriminate the one from the other. Where the similarity is sufficient to convey a false impression to the public mind, and is of a character to mislead and deceive the ordinary purchaser, in the exercise of ordinary care and caution in such matters, it is sufficient to give the injured party a right of redress if he has been guilty of no laches. Argument to show that the name of the pills, as given in the trade-mark of the respondent, was of a character to mislead and deceive, is scarcely necessary, as they are *idem sonans* in the usual pronunciation; nor can it be doubted that the form of the box containing the pills, and the general appearance of the wrapper which surround it, were calculated to have the same effect. Mention may also be made of the fact that the color of the label and the wax impression on the top of the box are well suited to divert the attention of the unsuspecting buyer from any critical examination of the prepared article. Chancery protects trade-marks upon the ground that a party shall not be permitted to sell his own goods as the goods of another, and, therefore, he will not be allowed to use the names, marks, letters or other *indicia* of another, by which he may palm off his own goods to purchasers as the manufacture of another. Difference between the exhibits undoubtedly exists, still it is manifest that the general appearance of the package, in the respects mentioned, and others which might be suggested, is well calculated to mislead and deceive the unwary, and all others who purchase the article without opening the box and examining the label."

The decree of the Circuit Court was affirmed, enjoining the respondent from using his own name upon any label or wrapper for boxes or packages or pills resembling or in imitation of the labels or wrappers or trade-mark of the complainant, whether in style of engraving, printing or lettering, but the decree for account was reversed upon the ground of inexcusable laches and delay in filing the bill.

We have come to the conclusion in the case before us that the respondent should be enjoined from putting up his goods in the

manner in which he has been doing, as shown by the exhibits, or in any other manner so simulating the form, color, labels and appearance given by the complainant to his goods as to mislead purchasers into mistaking one for the other.

What we decide is that whether the complainant has a trademark or not, as he was the first to put up bluing for sale in the peculiarly shaped and labelled boxes adopted by him, and as his goods have become known to purchasers, and are bought as the goods of the complainant by reason of their peculiar shape, color and label, no person has the right to use the complainant's form of packages, color or label, or any imitation thereof, in such manner as to mislead purchasers into buying his goods for those of the complainant, whether they be better or worse in quality. And finding, from the exhibits and proof in the cause, that the bluing put up by the respondent is not only well calculated so to mislead purchasers, but has actually done so, to the injury of the complainant, we are of opinion that respondent should be perpetually enjoined, and that he should account to the complainant for the damages sustained by him.

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SUPREME COURT OF NEW YORK.
SPECIAL TERM. IN EQUITY.*

ROYAL BAKING POWDER CO.*vs.*MAROSS JENKINS, ET AL.

DECIDED FEBRUARY, 1880.

“Royal Baking Powder.”

Action by “Royal Baking Powder Company” against defendants to restrain them from the use of the word “Royalty” in connection with the manufacture and sale of baking powder.

The defendants are engaged in the same line of business. Their manufacture is put up in round tin boxes of the same forms, sizes and shapes as those used by plaintiff, having red and yellow labels on each box, containing similar large letters on curved lines on the red label and the words “Royalty Baking Powder” with a different ornament or device in centre from that in the centre of the plaintiffs’ red label, and at the upper part of the yellow label in similar type and placed upon the label in the same form the words “Royalty Baking Powder,” followed by printed directions in English and in German on each side of the centre of the label with the names of the manufacturer at the foot. **HELD:**

* Not reported.

1. That the general appearance of the boxes and labels is so nearly identical as to be well calculated to deceive ordinary observers.
2. That the differences are so slight that they would be apt to escape attention unless a comparison could be made by having both the articles under the immediate inspection of the buyer.
3. That plaintiff is entitled to the restraining interposition of the Court.
4. Motion allowed and injunction continued until the hearing and decision of the action.

THIS action was brought by the "Royal Baking Powder Company" against the firm of Jenkins & Morrill, dealers in flour and groceries in New York City, to restrain that firm from the use of the word "Royalty," in connection with the manufacture and sale of baking powder. The allegations of the Royal Baking Powder Company are that the use of the word "Royalty" in connection with baking powder is an infringement of the word "Royal," the well-known trade-mark of the company in connection with the Royal Baking Powder. The company claim that the simulation is calculated to deceive purchasers and defraud the public; also that the cans and boxes containing the baking powder of the said firm, as well as the labels thereon, are almost an exact imitation as to size, form, color, and printed matter of those in use by said Company, and calculated still further to deceive.

The Royal Baking Powder Company in their action claim an accounting from the said firm for all baking powder sold by them under said simulated trade-mark, and claim to recover all profits of sale as damages. They also ask of the Court a permanent injunction against any further use by the defendants or their agents or employees of the trade-mark "Royal" or any imitation or simulation thereof, such as "Royalty" or the like.

A preliminary injunction was issued, a motion made to vacate the same is denied, and the injunction is sustained.

The opinion of the Court is as follows:

DANIELS, J.:

Independently of any statutory law, and under well settled principles of common law, persons engaged in the manufacture of

articles of trade have the right to distinguish them by artificial devices from all other similar articles manufactured and sold. And when that has been done and a business created for such articles as so distinguished, no other person or persons are at liberty to either adopt that device or one so closely resembling it as to deceive persons dealing in the same class of articles, and thereby induce the conviction that in purchasing the simulated articles, they are in fact purchasing those of the first manufacturer and dealer; in other words, one person has no right by simulating the trade devices of another to take away his customers, or undermine his business; while the law justifies and encourages manly competition, it will not tolerate, but, on the other hand, restrain and prevent the use of artifices by which dealers may be deprived of well earned advantages lawfully secured by fair dealing and honest trading. These principles appear to be now settled, both in England and the United States, and they are well sustained by authority. (*Congress Spring Co. v. High Rock Spring Co.*, 45 *N. Y.*, 291; *Colman v. Crump*, 70 *Id.*, 573; *Popham v. Cole*, 66 *Id.*, 69; *Devlin v. Devlin*, 69 *Id.*, 212). It is not necessary that the act complained of should have been prompted by an evil intent or improper motive, but it is sufficient to justify an action that the resemblance in the devices is such as to produce the belief in the minds of the buyers, that in procuring the one class of goods they are really obtaining the others, and in that way producing injury to the trade and business of the party entitled by the priority of his right to the protection afforded by the law. (*Coleman v. Crump*, *supra*; *Royal Baking Powder Co. v. Sherrill*, *MSS., Op. Van Vorst, J.*) The plaintiff has been extensively engaged in the manufacture and sale of baking powder; the article manufactured is put up in round tin boxes with red and yellow labels upon them; upon the red label are the words in large type, "Royal Baking Powder," the first word being in a curve at the upper part of the box, and the other words similarly placed at the lower part of the box. An ornament or device is also placed in the centre between those words. The yellow label covers the residue of the box, containing at the upper part in large type the words "Royal Baking Powder," followed by directions for use, printed on each

side the centre of the label in English and German, followed by the name of the manufacturer. The top of the box contains the words impressed in the tin, "Full weight, 1 lb., Royal Baking Powder, absolutely pure." These labels, colors, wordings and devices combined together constitute sufficient to create a trade-mark or trading device, distinguishing the plaintiff's manufactures from those of others engaged in the same line of business. It is very obviously more than the use of words which cannot be exclusively appropriated to the business of any person or firm, for it is a combination or arrangement of words and other things novel in itself, which others would have no occasion to resort to or use in the ordinary course of their own business affairs, and for that reason the use and enjoyment of that combination would impose no restraint on the proper rights and privileges of other dealers. It constitutes a device invented, used, and appropriated by the plaintiff, which the law will secure the advantage of to the plaintiff, against all persons afterwards colorably using it to advance the success and prosperity of their own manufacture and trade carried on by the sale of a similar article.

The defendants are engaged in the same line of business, manufacturing and selling baking powder. Their manufacture is put up in round tin boxes of the same forms, sizes, and shapes as those used by the plaintiff, having red and yellow labels on each box, containing in similar large letters on curved lines on the red label the words "Royalty Baking Powder" with a different ornament or device in centre from that in the centre of the plaintiff's red label, and at the upper part of the yellow label, in similar type, and placed upon the label in the same form, the words "Royalty Baking Powder," followed by printed directions in English and German on each side the centre of the label, with the names of the manufacturers at the foot. There are other slight but unimportant differences in the label not requiring attention, and the lettering in the cover to the boxes is wholly omitted by the defendants.

1. But the general appearance of the boxes and labels is so nearly identical as to be well calculated to deceive ordinary observers. And from the degree of attention which purchasers would

usually bestow on their purchases, the defendants' manufacture would pass very well in trade for that of the plaintiff.

2. The differences are so slight that they would be very apt to escape attention unless a comparison could be made by having both the articles under the immediate inspection of the buyer.

3. And that, under the authorities, is sufficient to entitle the plaintiff to the restraining interposition of this Court; without it the business of the plaintiff would be exposed to an unfair advantage in favor of the defendants, and its customers and trade diverted to them under the belief, deceptively produced, that they were still dealing in the plaintiff's manufacture.

4. The motion made must be allowed to prevail and the injunction continued until the hearing and decision of the action.

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SUPERIOR COURT OF THE CITY OF NEW
YORK. IN EQUITY.

NATHAN VAN BEIL, APPELLANT,*vs.*

HENRY W. PRESCOTT, ET AL., RESPONDENTS.

DECIDED 2 FEBRUARY, 1880.

REPORTED 46 N. Y., 542.

“*Rye and Rock*” Case.

Trade-mark words “Rye and Rock” are descriptive and cannot be appropriated as a trade-mark.

APPEAL by the plaintiff from a judgment dismissing the complaint.

A. H. H. Dawson, for appellant.

John A. Foster, for respondent.

CURTIS, Ch. J.:

This was an action brought by the plaintiff to restrain the defendants from the use of the name “Rye and Rock,” as applied to a mixture of rock candy dissolved in rye whiskey.

Plaintiff, in his complaint, claims that he adopted, in 1878, the words "Rye and Rock" as his trade-mark.

The Court, at General Term, said: "We concur in the views of the learned Judge at the Special Term that the words 'Rye and Rock' form a description of the article of which the liquid to which plaintiff applied the words is compounded; and, therefore, it is not a trade-mark. A trade-mark is an arbitrary sign or name. Any person who has a right to make the liquid has a right to give a description of it.

"We are also of the opinion that the plaintiff was not the first to adopt the words 'Rye and Rock,' as indicating the compound in question."

SPEIR, J., concurred.

Judgment appealed from affirmed, with costs.

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IN THE ST. LOUIS COURT OF APPEALS.
IN EQUITY.

CHARLES CONRAD, RESPONDENT,*vs.*JOSEPH UHRIG BREWING COMPANY, APPELLANTS.

DECIDED 3 FEBRUARY, 1880.

REPORTED 8 MO. APP., 277.

“Budweiser Beer” Case.

1. The rights of a manufacturer to his particular trade-mark is one which the law fully recognizes.
2. If the marks are so different that the ordinary buyer cannot be deceived no wrong is done to the public.
3. It is not important to determine whether the device simulated is technically to be called a trade-mark or a label * * * The entire device simulated was that which had been adopted by a merchant to designate goods manufactured for him, and under his direction, and sold by him * * * he had introduced his goods extensively under the designation he had adopted, and was entitled to its exclusive use as a trade-mark.
4. The injury done was not in calling the beer sold by defendant Budweiser beer, but in affixing to the bottles a mark calculated to deceive the

ordinary purchaser into the notion that the bottled beer of Uhrig was the article so carefully prepared by Conrad, by whatever name it might be called.

5. Where a label adopted by a merchant to designate goods purchased by him, and for which he had built up a large trade, has been simulated by another merchant, placed upon inferior goods, and put upon the market, an action in the nature of an action for deceit will lie, at the suit of the former.
6. Specific damages need not be shown in such a case, but the jury may assess such damages as they may on the whole evidence, be satisfied has been sustained.
7. That the label bears a name the use of which could not in equity be protected as a trade-mark, will not prevent a recovery, where the label is imitated in size, shape, color, device and general appearance.
8. Where the words in a label adopted as a trade-mark are substantially true, and contain nothing calculated to deceive the public; although not literally true, HELD: to be a distinction without a difference.

APPEAL from the St. Louis Circuit Court.

Everett W. Pattison and *Rudolph Schulenburg*, for the appellant :

The combination used is not valid as a trade-mark ; and an action at law will not lie for the infringement of a label. *Falkenburg v. Lucy*, 35 Cal., 52 ; *Browne on T.-M.*, sec. 137.

The plaintiff's label or trade-mark contains a representation calculated to deceive the public, and is not entitled to protection: *Fetridge v. Wells*, 4 Abb. Pr., 144 ; *Pidding v. How*, 8 Sim., 479 ; *Perry v. Truefitt*, 6 Beav., 66 ; *Partridge v. Mench*, How. App. Cas., 547 ; *Phalon v. Wright*, 5 Pa., 464 ; *Leather Co. v. American Co.*, 1 Hen. & M., 271 ; *Morgan v. McAdams*, 3 C. L. J. (N. S.), Ch., 228 ; *McAndrew v. Bassett*, 10 Jur., (N. S.), 550 ; *Hobbs v. Francais*, 19 How. Pr., 567 ; *Palmer v. Harris*, 60 Pa. St., 156 ; *Hagerty v. Shine*, 7 Cent. L. J., 291 ; *Stockdale v. Orwelyn*, 7 Dow. & R., 625 ; *Ford v. Foster*, 7 Ch. App. Cas., 626.

There was no infringement ; the defendant had the same right as the plaintiff to manufacture the beer and use the name. *Gillet v. Esterbrook*, 47 Barb., 465 ; *Casswell v. Davis*, 58 N. Y., 223 ;

Thompzon v. Winchester, 19 *Pick.*, 216; *Davis v. Kendall*, 2 *R. I.*, 566; *Lazenby v. White*, 41 *L. J. (N. S.)*, Ch., 354; *Canham v. Jones*, 2 *Ves. & Bea.*, 218; *Candee v. Deere*, 54 *Ill.*, 439, 461. Fraud of the very essence of an action at law for violation of a trade-mark: *Browne on Trade-Marks*, sec. 458; *Blanchard v. Hill*, 2 *Atk.*, 484; *Crawshay v. Thompson*, 4 *Man. & G.*, 357; *Rogers v. Norvill*, 5 *C. B.*, 109; *Edelstein v. Edelstein*, 1 *De G., J. & S.*, 185, 199. Damages: *Squier v. Gould*, 14 *Wend.*, 159; *Strong v. Whitehead*, 12 *Wend.*, 64; *Johnson v. Robertson*, 8 *Port.*, 486; *Shipman v. Burrows*, 1 *Hall*, 399; *Croft v. Boite*, 1 *Saund.*, 241, 243, note 5.

R. E. Rombauer and Finkelberg & Rassieur, for the respondent.

There was here such an appropriation by the defendant of the mark, symbol, or device of the plaintiff as will enable the latter to maintain an action against the former for violation of a trade-mark. *Croft v. Day*, 2 *Beav.*, 84; *Pophan v. Wilcox*, 14 *Abb. Pr. (N. S.)* 206; *Sohe v. Griesendorf*, 1 *Wils. (Ind.)*, 60; *Filley v. Fasset*, 44 *Mo.*, 168-178; *Brown v. Mercer*, 37 *N. Y. Superior Ct.*, 265; *Browne on T.-M.*, secs. 385-386. While geographical and generic terms in themselves cannot be appropriated as a trade-mark, yet they will be entitled to protection when used in connection with other symbols and devices, as a trade-mark, against one who uses the same terms in connection with the same devices and similar symbols and with intention to deceive. *Briminger v. Waattles*, 28 *How. Pr.*, 206; *Newman v. Alvord*, 49 *Barb.*, 588; *Lea v. Wolf*, *N. Y. Superior Ct.*, 626; *Lead Co. v. Massury*, 25 *Barb.*, 416; *Coffin v. Brumton*, 4 *McLean*, 516; *Knott v. Morgan*, 2 *Keen*, 213; *McAndrews v. Bassett*, 10 *Jur. (N. S.)*, 550. There was here no such intentional or material misrepresentation by the plaintiff as will deprive him of protection. *Smith v. Woodruff*, 48 *Barb.*, 438; *Curtis v. Byran*, 36 *How. Pr.*, 33; *Fettridge v. Merchant*, 4 *Abb. Pr.*, 156; *Browne on T.-M.*, secs. 492, 493; *Stewart v. Smithson*, 1 *Hill*, 49.

Damages: *Graham v. Plate*, 40 *Cal.*, 593; *Peltz v. Eichele*, 62 *Mo.*, 171; *Marsh v. Billings*, 7 *Cush.*, 322; *Taylor v. Carpenter*, 2 *Woodb. & M.*, 1; *Browne on T.-M.*, sec. 503.

BAKEWELL, J., delivered the opinion of the Court :

This is an action in the nature of an action of deceit for damages for using what the plaintiff in his petition claimed as his trade-mark. The answer was a general denial. There was a verdict and judgment for the plaintiff for \$4,175.

It appears that the plaintiff had been for many years engaged in the wine and liquor business in St. Louis on a large scale, under the trade-name of C. Conrad & Co. For nearly two years before the institution of this suit he had been putting up an excellent quality of beer, which he had, at great expense, introduced to the trade ; and which was very favorably received in other cities, particularly in California and Texas. Budweis is a small town in Bohemia, where very good beer is made, and as plaintiff, who is not a brewer, seems to have believed by some peculiar process.

It appears, however, that the Budweiser process of making beer is not peculiar to Budweis. The beer which the plaintiffs put up was manufactured for him by Anheuser & Co., a large brewing house in St. Louis. The directions of Conrad were that it should be brewed of imported hops and barley. It was brewed altogether from the best imported hops, which were imported and furnished for that purpose to Anheuser & Co., by Conrad himself. These imported hops are superior to any American hops. The barley was not imported ; but it was the best, carefully selected American barley, and as good as any foreign barley. In brewing, the mash is prepared by infusion, or by decoction, or by a process in which the two modes are combined.

In Budweis, the mash is prepared by infusion ; and this beer is so prepared. It costs to prepare it about two dollars a barrel more than the ordinary beer manufactured by Anheuser & Co., and is a better beer ; and is described by the experts examined, as being an 'uncommonly good beer—a hop beer, of good color, bright and inviting in appearance. Conrad testifies that he has a peculiar process of bottling his beer, which is his secret and which improves the beer. The defendant claims, and Uhrig swears, that the Conrad method of bottling is the same used by the defendant, and is a known European process. For the purpose of protecting his interests, Conrad employed a lithographer to get

up a peculiar label. This label is somewhat in the shape of a neck-tie. In the centre are three "C's;" on each flap is a peculiarly shaped crown, wreathed with barley and hop-leaves.

The words on the label are: "We guarantee that this beer is brewed especially for our own trade, according to the Budweiser process, of the best Saazer hops and Bohemian barley, and warranted to keep in any climate. Take notice that all our corks are burned with our trade-mark. The world renowned Budweiser lager beer. Trade-mark, Australia, Europe, Asia, Africa, America." Conrad considered that he had bought this design. The engraver says that he did not understand that Conrad bought the design; that the stone still belonged to the engraver. Defendant manufactured an inferior and cheaper beer. After plaintiffs' beer had acquired a reputation, the president of defendant procured from the same engraver a label of the same size, shape and color, and having the same general appearance, and the same peculiar devices of a crown and wreaths.

Examination would show that the two labels were not the same; but the retail purchaser would readily take one for the other. On defendant's label were three "B's" and the following words: "Caution! See that our corks are burned with our trade-mark. Beware of imitation. The world renowned Budweiser lager beer. Trade-mark." There was testimony to the effect that purchasers did actually mistake one label for the other; and it is evident, from inspection, this must have been the case. The Uhrig label was calculated to deceive. Defendant also put up his beer in bottles of the same color and appearance as those used by plaintiff. There is testimony to the effect that when the president of defendant ordered the labels, he directed that they should be made with a difference so as to avoid either a law suit or a quarrel. There was testimony tending to show that the president of defendant, before ordering these labels, visited the manufactory of plaintiff, whilst plaintiff was absent from the State; and that the travelling agent of defendant told plaintiff's agent that he had telegraphed to defendant's president to put on a similar label, and to make the Uhrig beer look like Conrad's beer. This testimony was admitted against defendant's objection. There was also testimony

that the same travelling agent of defendant told another agent of plaintiff that they intended to put the Budweiser labels on bottles. Plaintiff's beer was so popular that his sales gradually rose from \$24,000 the first year to \$96,000, in the six months immediately preceding the trial. He had spent over \$12,000 in introducing the beer, and several thousand dollars in trying to counteract the injury done to his trade and reputation by the Uhrig beer sold under the simulated label. The Uhrig beer was sold much cheaper, and necessitated, in some cases, a reduction of the price on the plaintiffs' part, its inferior quality also injured the reputation of the C. C. C. beer, as one was taken for the other.

1. The right of a manufacturer to his particular trade-mark is one which the law fully recognizes. The Courts interfere, both to protect the manufacturer in his particular trade, and to guard the public against imposition.

2. If the marks are so different that the ordinary buyer cannot be deceived, no wrong is done to the public; and if the mark complained of is not shown to have been adopted and used by the plaintiff, so that his business is not injured by its use by another, there is no ground of action of deceit.

It is contended that the mark simulated was not a trade-mark, and that the words "Budweiser Lager-Beer" could not be a trade-mark.

3. It is not important to this case to determine whether the device simulated is technically to be called a trade-mark or a label, nor is it important that the words "Budweiser Lager-Beer" by themselves alone, could not be used as a trade-mark. The entire device simulated was that which had been adopted by a merchant to designate goods manufactured for him, and under his direction, and sold by him; the device was adopted by him to distinguish his goods from those of another; he had introduced his goods extensively under the designation which he had thus adopted and was entitled to the exclusive use of the label which he had thus adopted as a trade-mark to distinguish his goods. *Burke v. Cassin*, 45 Cal., 467.

Let it be granted that no one can have an exclusive property in the words "Budweiser Lager-Beer," and that all lager-beer made in any town called Budweis is properly so called.

4. The injury done in this case by defendant to plaintiff was, not in calling the beer sold by defendant Budweiser beer, but in affixing to the bottles of defendant's beer a mark calculated to deceive the ordinary purchaser into the notion that the bottled beer of Uhrig was the article so carefully prepared by Conrad, by whatever name it might be called.

The owner of goods which he exposes to sale in market in his own right, is entitled to the exclusive use of any trade-mark devised and applied by him to distinguish them as being of a particular manufacture or quality, although he is not himself the manufacturer. *Walton v. Crowley*, 3 *Blatch.*, 440.

It is contended that the law can afford no protection to plaintiff, because his so-called trade-mark or label was in itself a misrepresentation. This beer it is said, was not Budweiser beer. That it was not Budweiser beer, in the sense that it was not made in Budweis is true. Neither was it imported beer. But it does not appear that it was held out to the public, either as actually made in Budweis or as a foreign article. The statement on the label explains that it was not made at Budweis, but by the Budweiser process.

Whether there was anything peculiar to Budweis about this process or not, it seems that this beer was really made as beer made in Budweiser—of the best barley and hops, and with the same preparation of mash. The label states that it was made of the best Saazer hops and imported barley.

8. If this was not literally true, the testimony is that it was a distinction without a difference. Imported hops exclusively were used. There were frequently other hops, but they were always of the same excellent quality as Saazer hops, and of the same peculiar properties, and were always imported hops. The barley was not imported; but a select quality of American barley, equal to imported barley was always used. There was no testimony tending to show any imposition upon the public by plaintiff. The testimony is that the public was furnished by him with an excellent

quality of beer, made of imported hops and of barley equal to any to be found in Europe or America. This beer was made specially for plaintiff, according to his directions.

To simulate the label under which he was selling his beer, and, under the simulated label, to put off an inferior quality of beer upon the public as the same which had acquired a reputation under the Conrad label, was a fraud at once upon the public and on Conrad, for which he had an action. The imitation of the label was a false representation that the goods to which it was attached, were manufactured or sold by the person whose label was imitated, and there was evidence that persons were deceived thereby, and that the public was thus defrauded. The variety of cases in regard to trade-marks, as is remarked by Judge Robinson in *Corwin v. Daley*, 2 Bosw., 224, grows out of the various ingenious means used by traders to defraud each other, and to represent, without appearing to do so, that the articles dealt in by one are those of another.

It was not a question in this case whether the words "World-renowned Budweiser Lager-Beer" used by themselves, without the other devices shown in this case can be a trade-mark, and whether a Court of Equity would, on the testimony in this case, enjoin their use. Others might, perhaps, employ these words with truth and honestly. But no one could honestly adopt, for beer in bottles like the bottles used by the plaintiff, the label which defendant is shown to have used, if it so closely simulated the label of plaintiff as to be readily taken for it, when placed upon a bottle like the bottles which plaintiff used. The resemblance between the labels was not accidental, it was manifestly for a purpose. There was deceit and consequent damage; and there was evidence to support the verdict. *Brown v. Mercer*, 37 N. Y. Superior Ct., 265; *Boardman v. Britannia Co.*, 35 Conn., 402.

It is not necessary to set out the instruction given or refused. The case was put to the jury on a theory as favorable to the defendant as he could ask. If the views of the law of the case which we have expressed are correct, the instructions refused were properly refused.

Some objections were saved to the admission and exclusion of evidence, but in this we see no material error to warrant a reversal of the judgment.

As to the damages, the facts present a case of fraud on the plaintiff and violation of his rights, for which the action lies without proof of specific damages; and the jury having found for plaintiff, he is entitled to such damages, as the jury, on the whole evidence, should be satisfied he had sustained.

And the plaintiff was not confined to the loss of actual sales, he could be specifically shown to have lost, but the jury might make such inferences as to the loss and injury sustained by plaintiff as they might think warranted by the evidence in the case. *Marsh v. Billings*, 7 *Cush.*, 322.

We do not think the damages were excessive.

The judgment is affirmed.

Judge LEWIS is absent; Judge HAYDEN concurs.

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IN THE COURT OF COMMON PLEAS, NEW
YORK CITY. SPECIAL TERM. IN EQUITY.

HEGEMAN & CO.

vs.

JOHNSTON N. HEGEMAN, ET AL.

JOHNSTON N. HEGEMAN

vs.

HENRY I. CUTTER, ET AL.

DECIDED 14 FEBRUARY, 1880.

REPORTED 8 DALY, 1.

Rights of "Successors" to a Firm.

1. A person may acquire the right known as the good-will in a business, from its being established in a particular place, from which he has derived, or may derive, profit, and when there is attached to the business a name indicating to the public where or in what manner it is carried on, it is a right which will be protected by a Court of Equity, even when he removes the business to another place.

2. The proprietary right which a man has acquired in a trade-mark, or in the use of his name, or in any name general or otherwise which designates a particular business established and carried on by him, involving what is known as the "good-will" of the business, is in the nature of property, and transmissible by assignment or bequest, and will pass with the sale of the business to which the name or trade-mark is attached, or under a general assignment for the benefit of creditors, which, by its terms, transfers all the insolvent's property for the payment of his debts, although it may not be specified in the schedule annexed to the assignment, or in the one which, under the General Assignment Act of this State, is subsequently made out and filed.
3. In 1827, one William L. Rushton established in the City of New York, a business in the sale, by wholesale or retail, of drugs and medicines, with which was connected the putting up of medical prescriptions, and of special preparations known by names of his own creation or adoption. In 1832, he associated with him one Aspinwall, and in 1843, William Hegeman, who had originally been in Rushton's employment, became a partner in the place of Aspinwall, and continued thereafter to be a partner during several changes of proprietorship and of the firm-name, until he became the principal proprietor, when the firm-name was changed to that of Hegeman & Co. The firm then had a central or principal place of business at No. 203 Broadway, and branches in other parts of the city. William Hegeman afterwards associated with him his son J. N. Hegeman, and the business as conducted by them under the firm-name of Hegeman & Co. had a high reputation, which was largely due to the experience, knowledge and business-like qualities of William Hegeman. The special preparations compounded and sold by the firm were made up by assistants employed in the pharmaceutical department from formulas or recipes which William Hegeman gave them, and which were copied out from a book which he kept in his possession. These special preparations were distinguished by special names with which that of Hegeman was incorporated, such as "Hegeman's Compound Fluid Extract of Buchu," and the label attached to them had on it a symbol or emblematic trade-mark, which represented the figure of an eagle, with extended wings, perched upon a mortar and pestle, with a scroll from the eagle's mouth, containing the words "established 1821," which was accompanied by a statement on the label that the article was prepared only by Hegeman & Co. After the death of William Hegeman, the surviving partner made a general assignment for the benefit of creditors, conveying to the assignee the entire co-partnership property and effects in general and comprehensive terms, such as "all *choses in action*," and "all property and effects, of every nature and description, of whatever name or nature," and the assignee thereunder sold to a purchaser

who paid a substantial consideration therefor, the trade-mark and good-will, and as connected with it the business name; and "all preparations, recipes, formulas, prescriptions, and recipe books, labels, plates, proprietary rights, and proprietary articles." After this sale the surviving partner, J. N. Hegeman, associated with himself one J. W. F., and under the name of Hegeman & Co., opened a store at 756 Broadway, and sold the special preparations of the old firm of Hegeman & Co., under the same names and labels that it had done. **HELD:**

That the good-will of the business, and the right to claim to be the successor of the firm of Hegeman & Co. passed to the purchaser from the assignee, and that J. N. Hegeman, as surviving partner of that firm, had no right growing out of his former connection with the partnership to assume or hold out to the public, and to the detriment of those who acquired by purchase all that remained of the former firm, that he was carrying on the said firm and business, or to vend the special preparations of that firm so labelled and marked as to indicate to purchasers that they were put up and prepared by that firm, and that he had no right to the business name, the trade-mark, or to anything incident or belonging to the firm, except the use of his own name, of which he could not be divested, and the right to attach his own name to the articles he manufactured and owned, but not in such a way as to pass them off as the articles manufactured or prepared by the firm of Hegeman & Co., or by those who had succeeded to that firm, and also the right to enjoy whatever benefit or advantage he might derive by representing that the business carried on at 756 Broadway, was carried on by a firm, one of whose partners was formerly a member of the firm of Hegeman & Co.

4. The purchaser from the assignee of Hegeman & Co. of the trade-mark, good-will, &c., sold all the rights acquired by such purchase to a corporation (which had been formed under the General Act of 1848, for the formation of corporations for manufacturing, &c., purposes,) whose corporate name was "Hegeman & Co.," and this corporation advertised its business under the style of "Hegeman & Co., Chemists and Druggists, 203 Broadway only, New York," and issued a circular stating that the concern of Hegeman & Co., had resumed business, and generally conducted the business—in their dealings with the general public—as if it were not a corporation, but a continuation of the old firm. **HELD:**

That the purchase from the assignee, in view of the Statutes of this State (L. 1833, c. 281), against doing business in fictitious names, did not confer on the purchaser the right to do business under the name of Hegeman & Co., but only as the successor of that firm, and that the manner in which the corporation was doing business was an attempt to

evade the statute, and a fraud on the public, and that as long as it continued to do so, a Court of Equity would not enforce against infringers thereof its rights to the good-will and trade-mark of the old firm of Hegeman & Co.

THE facts are stated in the opinion.

Horatio F. Averill, for Hegeman & Co.

William H. Ingersoll, for Johnston N. Hegeman and others.

CHARLES P. DALY, *Chief Justice*:

These cases, which are cross-actions relating to the same thing or right, involve an examination of several questions as to the right of property in a name, in a trade-mark, in a name and trade-mark so united, that they, together from the trade-mark, and in the good-will of an established business, indicated by a general name, or the name of the proprietor, or of a former proprietor or founder.

It will be necessary, first, to state the law, so far as it has been settled in respect to property in a name, in a trade-mark, and in the good-will of an established business, and what is incident to it, before applying the law to the facts in this case.

When, however, the whole pecuniary value of a name in its connection with an article of merchandise, or a manufacture, or a business, is derived solely from the personal qualities of the one to whom the name belongs, such as his skill, special knowledge and experience, or from the fact that the article is produced under his personal supervision, which imparts to it a special value, then the right to the name is not transmissible.

A trade-mark may consist in a name, or in a symbol or device used to indicate the nature, quality or identity of an article of commerce, whether it consists of an article that any one is at liberty to fabricate, compound or vend, or which originated with, or the exclusive right to manufacture or vend, which is under the protection of a patent, or otherwise in the person or proprietor by whom the trade-mark was devised. It may exist where the name of the article and of the proprietor are so blended together that

the right to the use of the name is indispensable to the use of the trade-mark, or may consist of the name alone of the manufacturer or proprietor, or may exist where the article fabricated is so made or shaped that the peculiar form of it is designed to, and does, serve as a trade-mark; as in the case of a sewing-machine, the iron framework of which was so constructed as to represent and form the two initial letters of the proprietor's name.

1. A person may acquire the right known as the good-will in a business from its being established in a particular place, from which he has derived, or may derive, profit, and where there is attached to the business a name indicating to the public, where, or in what manner, it is carried on; and this is a right which will be protected in a Court of Equity, even where he removes the business to another place. (*The G. & H. Mnfg. Co. v. Hall*, 61 *N. Y.*, 232; *Harper v. Pearson*, 3 *Law Times*, [*N. S.*], 547; *Howard v. Henriques*, 3 *Sandf.*, 725; *Christy v. Murphy*, 12 *How. Pr.*, 77). The proprietary interest which a person has in his name, so far as any pecuniary value arises from the use of it, which a Court of Equity would protect, or which may be transmissible by assignment, is necessarily connected with some business, trade-mark, or other interest, through which a pecuniary value has become attached to it.

2. The proprietary right which a man has acquired in a trade-mark, or in the use of his name, or in any name, general or otherwise, which designates a particular business established and carried on by him, involving what has been previously described as the good-will of the business, is, being in the nature of property, transmissible by assignment or bequest. (*The G. & H. Mnfg. Co. v. Hall*, 61 *N. Y.*, 227, 230, 231; *The Leather Cloth Co. v. American Leather C. Co.*, 4 *De Gey, J. & S.*, 142; *Id.*, *H. of L. Rep.*, 522; 11 *Jurist*, [*N. S.*], 513; *Sargent v. Romen*, *Annales de la Prop.*, t. 13, p. 21; *Congress, &c. Co. v. High Rock, &c.*, 57 *Barb.*, 526; *Id.*, 45 *N. Y.*, 291; *Dixon Crucible Co. v. Guggenheim*, 3 *Am. Law Times R. [St.]*, 288; *Lockwood v. Bostwick*, 2 *Daly*, 521; *Hitchcock v. Cohen*, 6 *Ad. & Ell.*, 438, 449; *Howe v. Searing*, 6 *Bosw.*, 354; *Clinton v. Douglas*, 1 *H. R. V., Johnson*, 176; *Ainsworth v. Walmesley*, 44 *L. J. R.*, 242; *Durreya*

v. Plato, 29 *Cal.*, 292; *Hall v. Barrows*, 10 *Jur.*, [*N. S.*], 55; 4 *De Gey, J. & S.*, 156, 157, 158; *Croft v. Day*, 7 *Beav.*, 84; *Bradbury v. Dickens*, 27 *Id.*, 53; *McLean v. Fleming*, 6 *Otto*, 249, 250; *Browne on Trade-Marks*, secs. 359, 360), and will pass with the sale of the business to which the name or trade-mark is attached; or under a general assignment for the benefit of the creditors, which by its terms, transfers all the insolvent's property for the payment of his debts, although it may not be specified in the schedule annexed to the assignment, or which, under our statute, is subsequently made out and filed. (*Hall v. Barrows*, *supra*, *Burns v. Bedford*, 33 *Law J.*, [*N. S.*], 465; *Edilsten v. Vick*, 11 *Hare*, 78; *Hudson v. Osborne*, 39 *L. J. Ch.*, [*N. S.*], 79; *Couch v. Delaplaine*, 2 *N. Y.*, 397; *Couch v. Lott*, 17 *Id.*, 478; *Cram v. Union Bank*, 1 *Abb. Ch. of App. Dec.*, 361; *Miller v. Halsey*, 4 *Abb. Pr.*, [*N. S.*], 33). When, however, the whole pecuniary value of the name, in its connection with an article of merchandise, or a manufacture, or a business, is derived solely from the personal qualities of the one to whom the name belongs, such as his skill, special knowledge and experience, or from the fact that the article is produced under his personal supervision, which imparts to it an especial value; then the right to the name is not transmissible. It is then purely personal; and this is equally so with a trade-mark used and recognized, as denoting that the article or product is made by a particular person, whose skill, experience, or other personal quality, or whose personal experience in the fabricating, preparation or production of it, gives to it a peculiar value, which is distinguishable from a trade-mark used as a brand of quality, or of texture, fineness, or other characteristics; or to indicate that it is made in a particular establishment or manufactory, or where a name simply denotes an established business, with whatever advantages may accrue from its long establishment, the fact that it is generally or widely known, and the confidence it inspires from its duration. (*Hall v. Barrows*, *supra*; *Bury v. Bedford*, *supra*; *Carmichael v. Lattimer*, 11 *R. I.*, 395).

The defendant, while conceding that a party can dispose of the right to use his name in a certain business, insists that it will not

pass under a general assignment for the benefit of creditors, but only by a clearly expressed intention on his part to do so, in the form of a positive agreement; and in support of this refers to many cases, three only of which I deem it necessary to notice and distinguish, as the residue have no bearing whatever upon the point raised.

In *Bradley v. Norton*, (33 Conn., 157), where the adopter of the trade-mark, which contained his own name as part of the title of a new compound prepared and sold by him as a fertilizer, made an assignment for the benefit of his creditors, but the trade-mark was not inventoried by the trustee or by the appraiser, and was never claimed by the trustee or by the creditors, nor in any manner disposed of under the assignment; and where the adopter, upon getting again into business, prepared and sold the same compound by the same name, it was held by McCurdy, J., as against an infringer of the trade-mark; that the assignment had been "incomplete and inoperative in respect to this right," and that the defendant could not set up the effect of the assignment to screen himself from his illegal proceeding. This case is distinguishable from the one now before me, in the fact that the business name, good-will and trade-mark were, in the present case, claimed and sold by the assignee for a considerable sum of money, which went to the creditors under the assignment; and it is by virtue of that sale that the legal right to it is claimed in this action. The decision of the Court upon this point in *Bradley v. Norton*, was correct; but not for the reason assigned by Judge McCurdy, that the assignment did not operate to transfer it. The facts stated show that the right to it, under the assignment, was abandoned. A trade-mark, whether it consists of a symbol or a descriptive name, may be abandoned; and if it is, it may then be appropriated by any one, who, by doing so, adopts it as his own; or after it is abandoned it may be resumed by the original proprietor and re-adopted by him, if, in the meantime, it has not been taken possession of by another, or by the community in general, or become, as a name or device, by general user, a mere designation of the kind of article or product, when its quality as an exclusive trade-mark is gone; the criterion or test being, was

there an *intention* to abandon, which will depend upon the special circumstances of the particular case. (*Denton Vulcanite Co. v. Weatherbee*, 3 Fish, 87; *Lemoine v. Ganton*, 2 E. D. Smith, 243; *Browne on Trade-Marks*, secs. 677, 680, 681, 691). In *this* case of *Bradley v. Norton*, the intention to abandon was manifest. Neither the trustee, the creditors, nor any one under the assignment having assumed any right to the use or disposition of it, it was abandoned, and the insolvent, upon again going into that business, had the right to re-adopt it as he did.

In *Helmbold v. Helmbold*, (53 How. Pr., 457), Westbrook, J., after stating that a party could, by a voluntary sale or assignment, transfer the right to use his knowledge and name, remarked that he did not "see how the right to use his own knowledge or name could be taken from him by any judicial proceeding whatever; that if they can be, the merchant who has become unfortunate, but who has still a knowledge and a name with which to begin business anew, must, if he has been adjudged a bankrupt, be content to leave with his assets, his brains and his character." In these remarks, the Judge recognizes that, by a voluntary assignment for the benefit of creditors, the right to use a man's name could be assigned; and beyond this, he merely distinguishes what I have already pointed out, that when a man's personal qualities are what constitutes the value in the use of his name, they are not, in their nature, assignable.

Moir v. Brown, (14 Barb., 39), merely decides that nothing is transferable by assignment for the benefit of creditors, where the general words of the instrument refer to the schedule annexed as showing what is assigned, and the schedule was not annexed at the time of the delivery of the instrument. In *Corwin v. Daly*, (7 Bosw., 222), it was simply decided that a man could acquire no right to appropriate exclusively to himself such general words as "Club House Gin," as a trade-mark, and consequently could not, by assignment, transfer to another what he did not possess himself, and the remaining cases referred to are equally inapplicable.

The cases I have cited establish, in my judgment, that a trade-mark and the name by which a business has become known, involv-

ing what is understood by the good-will, will pass under a voluntary assignment, transferring the insolvent's property of every nature and kind for the payment of his debts, unless the value of the name has arisen from, and depends solely upon, the personal qualities or personal supervision of the one to whom it belongs. In none of the cases cited by the counsel of J. Nevlin Hegeman has it been decided that it will not; nor do they, in my opinion, afford any countenance for so holding. The whole point is pithily put in one of the cases I have cited (*Hudson v. Osborne*, 39 *L. J. Ch.*, 79; 21 *L. J.*, [*N. S.*], 386), in the statement that, in substance, there is no distinction between the sale by a man of his business, good-will and trade-mark, and the sale of them by an assignee in bankruptcy of all the bankrupt's assets of every kind, and the insolvent has no right afterward to use the trade-marks which were the marks of that business, or to use the name or title of the firm as representing himself as continuing the business, all the rights of which passed to his assignee, and to the purchaser, under the assignment. He has no right to represent himself as continuing the identical business that was sold by his assignee to another, which does not, however, debar him from going into the same business again, and indicating the fact of his having been in the former one; or from alleging anything respecting the new business, unless it be done with a design to impair the right of the purchaser of the former business, or to mislead the public, as has been held in *Crutwell v. Lye*, (17 *Ves.*, 346), and *Clinton v. Douglass*, (1 *H. R. V. Johns. R.*, 176).

It has been decided in several cases, that where a man has introduced a new medical preparation and given it a title, a component part of which is his own name, as indicative of the true origin and ownership of the article, and not used simply to designate the article itself, and assigns to another all his interest in it, with the sole right thereafter to manufacture and vend it, the transfer carries with it the right to use the name by which it has become known. But where the name is not used as solely indicative of origin and ownership, but of the ingredients, characteristics, composition or qualities of the preparation, as "Ferro-Phosphated Elixir of Calisaya Bark," (*Caswell v. Davis*, 58 *N.*

Y., 223); or "Cherry Pectoral," (*Ayer v. Rushton*, 7 *Daly*, 9); or where the term employed is one that has acquired a generic meaning, as descriptive of a general kind, quality, or class of medicines; as where the name employed is "James' Powders," "Turlington's Balsam," or "Thompsonian Medicines," a party has no exclusive right or privilege to compound and vend such medicine, although he may have been the first to devise the compound, or although his own name forms a part of the title he has given to it. *Thompson v. Winchester*, 19 *Pick.*, 214; *Caswell v. Davis*, 58 *N. Y.*, 223; *Ayer v. Rushton*, 7 *Daly*, 9; *Amoskeag Manufacturing Co. v. Spear*, 2 *Sandf. S. C.*, 610; *Fetridge v. Wells*, (4 *Abb. Pr.*, 146). But, although no exclusive right to use a name of this description can be acquired, and any one is at liberty to use it, another is not allowed so to use it as to injure the proprietor and deceive the public by so printing the name and so arranging the form, color, appearance and inscription, upon the package or label, as to convey the impression that his commodity was made or put up by the other proprietor, which is a fraud and an imposition, and he would be enjoined by a Court of Equity from doing it. (*McHarg v. Eastman*, 35 *How. Pr.*, 205; *Lockwood v. Bostwick*, 2 *Daly*, 521; *Enoch Morgan's Sons' Co. v. Schwakhofer*, 55 *How. Pr.*, 37). It has also been held, in several cases, that where a trade-mark or a name, or a trade-mark and name united, has been used and recognized, as denoting that the article is made at a particular establishment, the name used being that of the proprietor of the establishment, as "Stilman's Mill," (*Carmichael v. Latimer*, 11 *R. I.*, 409), that those who succeed to the establishment, such as his heirs, next of kin, or his successors in interest, may, in carrying on the establishment thereafter, there being no statutory enactment to the contrary, continue to use the same name and trade-mark, without any reference to their derivative title, for nobody is thereby deceived, as they get the same article and from the same place as they got it before. (*Whitehouse v. Browne*, 44 *Md.*, 303; *Fulton v. Sellers*, 4 *Brews.*, 22; *The Leather Cloth Co. v. The American Leather Co.*, 11 *H. of L.*, 542; *Carmichael v. Latimer*, 11 *R. I.*, 409; *Filkins v. Blackman*, 13 *Blatch.*, 444). But it has been held, that if the assignee, who

has acquired the right to manufacture an article which was manufactured at a particular place, manufactures it at another place, but continues to use the former trade-mark, which states where the article was manufactured, and that it had certain qualities, some of which the assignee omitted in his manufacture of it, that no right existed in such a case to use the former trade-mark, for the reason that what was upon it was then untrue. (*Leather Cloth Co. v. The Am. Leather Co.*, *supra*).

It is, in certain cases, difficult to determine whether the whole or principal value of a trade-mark arose from, and depended upon, the personal qualities or personal supervision of the one who adopted it. It has been recognized in some of the cases that banking houses like Baring Brothers of London, that have a name, that has become valuable, do, and may rightfully continue the house under the original name, although no person of that name remains in the firm. (*The G. & H. Manuf. Co. v. Hall*, 61 N. Y., 232). The value of the name in such a case naturally grows out of the long duration of such a house, and the confidence that is felt in the integrity of its management. The integrity or ability, however, of those who have founded such a house, does not appear to have been regarded as the sole source of the value of its name, inasmuch as the right of those who have succeeded to the interest in it to continue it under the same name has been recognized; and this would apply, not merely to banking houses, but to any mercantile business; and also, under certain circumstances, to manufactories, especially to those where the article is manufactured by machinery, as is now extensively the case, the mode of manufacture being a mere matter of detail, which may be conducted as well by those who succeed to the interest as by those who first established the manufactory.

3. In the present case, the business carried on by Hegeman & Co. involved both trading and manufacturing. They were the successors of a business originally established in this city in 1827 by William L. Rushton, who associated with him, in 1832, James S. Aspinwall, for the sale by wholesale and retail of drugs and medicines, with which was connected the putting up of medical prescriptions, and of special preparations known by names of their

own creation or adoption. Rushton and his successors were pharmacéutists as well as druggists, by which I understand those who prepare or compound medicines and also deal in drugs. William Hegeman was originally in Rushton's employment. In 1843 he became the partner in place of Aspinwall, and continued thereafter during several changes of proprietorship and of the name of the firm, until he became the principal proprietor in the last firm and name which it assumed, and which he gave to it, of Hegeman & Co., having then a central or principal place of business at 203 Broadway, with branches in other parts of the city. I have not the evidence now before me, but my recollection of it is, that the business, as conducted by him and his son, J. Nevlin Hegeman, who constituted the company, had a high reputation, was largely due to his experience, knowledge and business qualities, and that it stood as high as any house in the same business in this city. It appears that the special preparations before referred to were made up from formulas or recipes, and were distinguished by special names, with which that of Hegeman was incorporated,—such as “Hegeman's Compound Fluid Extract of Buchu,”—and by a symbol or emblematic trade-mark which represented the figure of an eagle, with extended wings, perched upon a mortar and pestle, with a scroll from the eagle's mouth containing the words, “Established 1827,” which was accompanied by a statement on the label that the article was prepared, or prepared only, by Hegeman & Co. A business like this, which had been long established for the putting up of medical prescriptions, the making and vending of special preparations from formulas and recipes, and the buying and selling of drugs, and of such other articles as are connected with such a business, the proprietors of which had been several times changed, as well as the name or title of the firm, could be continued, as it had been before, by successors acquainted with such a business, who would attend to its details; and I would not be warranted in holding that the value of the business, name or good-will depended solely upon the personal qualities of the elder Hegeman, and would cease altogether upon his death. The personal qualities of those who establish a business, or who, for some years, have

carried on one that was previously established, may or may not have an effect upon the value of the good-will and business name. Persons go to a particular place of business for various reasons; some because they do, or think they do, get what they want better and cheaper than elsewhere, or because the house has a special commodity, procurable there only, or a greater variety of some particular article; some, simply because they have been in the habit of going there; others, because they are known to the attendants, and being recognized as customers will, or expect to be, better served; others, because they are directed or recommended to go by those who are in the habit of dealing there, or because the locality is convenient, or for other reasons. Many purchase for years at large houses in this city, like A. T. Stewart & Co., or R. H. Macy & Co., who never see the proprietors and are never seen by them. The existence of the same business in the same place for many years may constitute the chief value of the good-will, independent of who are the proprietors, and continue under many changes of proprietors. A business once thoroughly established, and having a large custom, may go on thereafter mechanically, so to speak, by a careful supervision and attention to its details, and be conducted by those who succeed to it, as satisfactorily and as successfully as by those who founded it.

The long duration of a business, like the one in the present case, which, at the death of the elder Hegeman, had been in existence in this city for nearly half a century, had necessarily an effect upon the value of the good-will, as in the progress of years such a business would become more widely known, the business name and address being put upon every bottle and package; and where advertisements would be largely resorted to, and continued for years to call attention to what was an important part of it—the sale of special medical remedies, or as they are more generally called, patent medicines, from the assumption that the mode of their preparation is known only to the proprietor. Hegeman succeeded to predecessors who may have had much to do with establishing the reputation which the house had acquired, and in like manner others succeeding to him may maintain what he continued or augmented; for Marcher, one of the successors under

the sale by the assignee, had been for twenty years in Hegeman's employment, as Hegeman, before he became a proprietor, had been sixteen years in the employment of William L. Rushton, and Rushton & Aspinwall. Hegeman's skill and experience as a pharmacist was no doubt important in the business; but in respect to the business generally, it is to be noted that while he and his own son were proprietors the financial condition of it became impaired. The branches were lopped off, and my recollection of the evidence is, that at the time of his death the main business was seriously embarrassed financially; but whether this was so or not, the house became insolvent two years afterwards. After William Hegeman's death the sole value of the good-will certainly did not depend upon the personal qualities or supervision of his son and successor, who, when in partnership with his father, had no diploma from the College of Pharmacy; nor skill nor experience in compounding medical preparations, but attended to other branches of the business. In the pharmaceutical department several persons were employed, who made up the special preparations from the formulas or recipes which the elder Hegeman gave them, copied out of a book which he kept in his possession. Upon his death, the son, as the surviving partner, carried on the business in his own interest and that of those to whom the interest which his father possessed had passed by his will, and the business having been either embarrassed at the time of the elder Hegeman's death, or becoming so under the management of the son, the firm became insolvent, and the son, J. Nevin Hegeman, as the surviving partner made a general assignment for the benefit of creditors, conveying to the assignee the entire co-partnership property and effects in the most general and comprehensive terms, such as "*all choses in action*," and "*all property and effects, of every nature and description, of whatever name and nature.*" And the assignee, on the 11th March, 1878, under this assignment, after having sold out a certain portion of the stock, sold to Mrs. Gertrude A. Cutter the residue, with the trade-mark, the good-will, and, as connected with it, the business name; and "*all preparations, recipes, formulas, prescriptions and recipe books, labels, plates, proprietary rights, and proprietary articles.*"

This sale was made for the sum of \$8,000—\$2,000 being the estimated value of the stock, which may or may not have been of greater value, the evidence upon that point being conflicting, and \$6,000 for the good-will, business name, trade-mark, recipes, &c., whatever may have been the actual value of the stock, it is very clear that in this sum of \$8,000 considerable value was attached, both by the assignee and the purchaser, to the value of the business name, good-will, locality, trade-mark, &c., and this \$8,000 went to the payment of the creditors of the insolvent firm.

On the same day that this sale was made to Mrs. Cutter, G. B. Marcher, who, as I have said, for twenty years had been employed by the firm of Hegeman & Co., and who, during ten years of that time, had, under William Hegeman, the supervision of the compounding and putting up of the special preparations, or what are called in the papers the proprietary articles, entered into an agreement with the widow of William Hegeman, and three of his children, to whom he had left by his will all the residue of his property, by which agreement with Marcher, whatever rights they had to manufacture and vend Hegeman's preparations or proprietary articles, or to his trade-marks, or labels, or right to use the name of Hegeman, or of Hegeman & Co., was transferred to Marcher, upon the consideration that he would make and vend them as licensee, under the name of Hegeman, or Hegeman & Co., and pay a royalty of one-fourth of the net profits arising from their sale to the widow, Mrs. E. G. Hegeman; and on the same day Marcher, together with William A. O. Hegeman, one of the sons of the elder Hegeman, and H. T. Cutter, the husband of Mrs. Cutter, formed a corporation under the Act of 1848, authorizing the formation of corporations for manufacturing, mining and chemical purposes, declaring in the certificate filed by them that the name of the corporation was Hegeman & Co.; that it was formed to compound, manufacture and sell drugs, and to carry on a general drug business and everything incident thereto, and also to prepare and keep for sale the preparations and proprietary articles lately dealt in by the firm of Hegeman & Co., and known as Hegeman's or Hegeman & Co's preparations; and on the 15th day of March,

1878, Mrs. Cutter assigned to the corporation all the interests that she had acquired by the purchase and assignment from the assignee; and on the 23rd day of October, 1878, Marcher conveyed to the corporation all the interests that he had acquired under the assignment from the widow and three children, subject to the performance of the conditions contained in it.

On the 12th day of March, 1878, the day after the execution of the certificate of incorporation, a circular was sent, under the name of Hegeman & Co., to the customers of the firm, announcing that it gave them (Hegeman & Co.) pleasure to inform the recipients of the circular that the concern of Hegeman & Co. had resumed business on the 11th March, 1878, the residue of the circular being as follows:

“Mr. George B. Marcher, for twenty years in charge of *our* wholesale business and manufacturing department, has become associated with *us*, and under his personal supervision, *we* confidently assure our patrons of every attention as heretofore.

“Thanking our friends for any past favors, and soliciting their patronage for the future, we remain yours very truly, ‘Hegeman & Co.’”

On the 14th of March following, the certificate of incorporation was filed, and the corporation have since, and are now, continuing the business as a corporation, styling themselves upon their labels, cards, advertisements, &c.,—without any reference to their corporate character or derivative title,—“Hegeman & Co., chemists and druggists, 203 Broadway only, New York.”

In October, 1878, J. Nevin Hegeman, in a letter addressed to Marcher, informed him that he did not recognize his right to carry on the firm as he was doing; and in the following January, 1879, he associated himself with J. W. Ferrier, who had been an employee of the old firm of Hegeman & Co., and who was then employed as a clerk by the corporation, and they, J. Nevin Hegeman and Ferrier, under the old title of Hegeman & Co., began business in a store, 756 Broadway, which had formerly been one of the branch stores of the old firm, and which had been sold during the life-time of the elder Hegeman, to a person who carried it on in his own name and with the title of “Successor to Hegeman

& Co.,” and which was subsequently sold, under a sheriff’s sale, and purchased by the judgment creditor, who carried it on for a short time thereafter. In the business thus established by J. Nevin Hegeman and his partner, Ferrier, they claimed to be a continuation of the old firm of Hegeman & Co., and assumed the right to manufacture and vend all the proprietary articles of the old firm, and the right to use the trade-mark, labels, and everything pertaining to it, and are so doing, having upon the proprietary articles a label printed in all respects like that used by the corporation, with the exception that the name of the place of business is 756 Broadway, and that the word “only” is omitted.

In the two actions brought, the relief asked for is substantially of the same character, each asking that the other be enjoined from using the name of Hegeman & Co., or the trade-mark, labels, or other indicia of that firm—which is substantially a statement of all the material facts that I have to pass upon.

3. It is very clear to my mind, as I have already stated, that all the interests, of whatever nature or kind, including the good-will, business name, trade-mark, &c., passed to Mrs. Cutter, the purchaser under the sale by the assignee, and is vested in those to whom she subsequently conveyed all she purchased; and that J. Nevin Hegeman has no right growing out of his former connection with the partnership to assume or hold out to the public, and to the detriment of those who acquired by purchase all that remained of the former firm, that he is carrying on the same firm and business; or to vend the special preparations of that firm, so labeled and marked as to indicate to purchasers that they were put up and prepared by that firm; that he has no right to the business name, the trade-mark, or to anything incident or belonging to the firm, except the use of his own name, of which he cannot be divested, and the right to attach his own name to the articles he manufactures and vends; but not in such a way as to pass them off as the articles manufactured or prepared by the firm of Hegeman & Co., or by those who have succeeded to that firm, and also the right to enjoy whatever benefit or advantage he may derive by representing that the business carried on at 756 Broadway is carried on by a firm, one of the partners of which was

formerly a member of the firm of Hegeman & Co. This, in my judgment, is all the rights he now possesses through his former connection with the insolvent firm, the assets, proprietary rights and interests in which have passed to others.

4. It now remains to determine whether those who purchased all the effects, business rights or advantages and interests of the insolvent firm are entitled to carry on the business in the manner they have done and are now doing, and in respect to that, my judgment is equally clear. All that could be obtained by the purchase from the assignee was the right to succeed to whatever the insolvent firm possessed, which gave the purchaser, or those to whom she subsequently transferred her interest, no right to represent to the public, as they have done and are still doing, that the former business, which was temporarily suspended, has been resumed by the same persons, having associated with them G. B. Marcher. They are not, nor are any of them, the same persons who carried on the previous firm. They have acquired no right, and could acquire none, to the business or anything connected with, or incident to it, from the widow or children who made the assignment to Marcher, for they had nothing to transfer, everything belonging or appertaining to that firm having passed under the assignee's sale to Mrs. Cutter; and whatever interest those who are now conducting the business as a corporation have, in what she transferred to them, or to it, by assignment. She and they, as her successors in interest, had a right to all the advantages of the business name, as much so as to the locality and the good-will, of which the business name is but a part.

There is a certain value in the business name, and they, and they alone, are entitled to the advantages of it, whatever those advantages may be, as they are carrying on the same business in the same place, the business name and the locality, as I have said, enter into, and are parts of, what in such a case constitute the good-will. (*Howard v. Henriques*, 3 Sandf., 725). "This," Lord Eldon said, "is the probability that the old customers will resort to the old place;" (*Crutwell v. Lye*, 17 Ves., 346); and "the name of a firm," in the language of Vice-Chancellor Wood in *Clinton v. Douglass*, (1 H. R. V. Johns., 176), "is a very im-

portant part of the good-will of the business carried on by the firm."

What they have acquired is not the right to represent themselves to the public as the former firm, but as the successors of Hegeman & Co., (*Hall v. Barrows*, 10 *Jurist*, [*N. S.*], 55), which gives them all the advantages of the business name which they could acquire, and is a truthful representation to the public of what they actually are. "If," it was said in the case last cited, which was a bankruptcy case, "the Court direct the sale of the business or the manufacture carried on by the owner of the name, it might give to the purchaser the right to represent himself as the successor in business, and, *in that manner*, to use the name." Those, says Troplong, who succeed to a deceased merchant's business are forbid, by the *Commercial Code*, Art. 21, (*France*), from continuing it in his name, (which Article provides that the names of the copartners constituting the firm can alone be represented in the name of the firm—*Les noms des associés peuvent seuls faire partie de la raison sociale*). Credit, he says, is altogether personal. It is not transmissible. It is won by actions and capacity. It is not right, then, that a successor should avail himself of a fallacious credit, in appropriating a firm's name extinguished by the death of one of those who gave to it its value; and he expresses his astonishment that the right to do so should be recognized in England, as it is a fraud upon a confiding public. *Troplong, Le droit civil, tom. XII, p. 372.*

In *Bautain v. Merklene*, (*Annales de la Prop.*, tom. iii, p. 307), Bautain and wife had sold to Merklene and wife an establishment where they had carried on the business of opticians, and it was stipulated that the purchasers, as successors, might avail themselves of the name of Bautain, if convenient. They used the same, however, on their sign, cards, &c., without any reference to their being successors, and it was held that they were not entitled to do so; that they could use it only by expressing with it that they were successors. These are French authorities, but we are not without authority to the same effect in this country. In *Sherwood v. Andrews*, (5 *Am. L. Rep.*, [*N. S.*], 588), it was held, that every assignee or purchaser who uses the trade-mark of

the original proprietor without indicating that he is the assignee or purchaser, practices an imposition upon the public. "I do not deny," says Chief Justice Wilson in delivering the opinion of the Court, "that the right to use the trade-mark of the original proprietor passes with the good-will, by operation of law, to the executor and to the assignee of a bankrupt, and that it may pass to an assignee by express agreement between the parties; but I insist that in such cases, in order to receive the aid of a Court of Equity, the parties must add to the original trade-mark words indicating the authority for, and the right to its use as executor, assignee or successor of the original proprietor, as the case may be. Assignees of trade-marks have no special privilege of sailing under false colors, and if they will persist in doing so, prudence would dictate that they give Courts of Equity a wide berth."

It is declared by statute to be a misdemeanor in this State for any person to transact business in the name of a partner not interested in his firm; and that, where the designation "and company" or "& Co." is used, that it shall represent an actual partner or partners. (*L.* 1833, *c.* 281, *p.* 404); and by the Act of 1854, (*L.* 1854, *c.* 400, *p.* 1084), the use of a copartnership name, theretofore or thereafter used by firms having business relations with foreign countries, where the business is continued by some of the copartners, or by assignees or appointees, may be continued, provided that, on every change of the persons continuing the use of the name, a certificate shall be filed and notice published in the mode directed by the statute. These statutory enactments prevent, in this State, the continuance, after the death or retirement of partners, of the name of firms as they have been and are probably still continued in England, and were, in this State, before the passage of these statutes.

It is not assumed that any right to continue the name of Hegeman & Co. has been derived under, or by a compliance with, these statutory provisions. The successors in interest, however, have sought to accomplish the same thing, by filing a certificate to incorporate themselves as a manufacturing company, under the the general statute, by the name of Hegeman & Co., devised as a means of enabling them, under the forms of law, to hold them-

selves out to the public as being the firm of Hegeman & Co., instead of being, as they are, the successors of that firm—a device which, however ingenious, will not accomplish the purpose sought to be effected; at least, so far as securing for them the protection of a Court of Equity in the use of the name in that way. It is an attempt to do, by means of a formal incorporation under the general statute, what is forbidden by law and declared to be a misdemeanor—that is, to transact business in the name of a person not interested in the firm. It is, in fact, trying to do by the instrumentality of one statute what they are forbidden to do by another. The fact that W. A. Ogden Hegeman, who is a practicing lawyer, was associated as one of the copartners does not make the case any better, as he never was a member of the firm Hegeman & Co., and the futility of attempts to get the benefit of a business name, by contrivances of this kind, has been declared in adjudged cases, (*Croft v. Day*, 7 Beav., 84; *Bloss v. Bloomer*, 23 Barb., 604; *Brown on Trade-Marks*, secs. 374, 393, 424). I do not mean to say that Marcher, Cutter and W. A. Ogden Hegeman could not have associated themselves together in good faith, in the same kind of business, under the copartnership name of Hegeman & Co., or that J. Nevin Hegeman and Ferrier might not have done the same; which would have been forming a new business with the same name as the former one. But this was what neither undertook to do, or are doing. J. Nevin Hegeman and Ferrier claim to be carrying on the old firm, using its trade-mark, its name, and selling its proprietary articles with substantially the same kind of label, as if it were still in existence, and those who have succeeded to its interests are doing exactly the same, having notified the customers that the firm had resumed business, having associated with it G. B. Marcher, and are assuming to carry it on, so far as respects the public, as if that were the only change that had been made.

My conclusion in this case is, that neither of the parties plaintiff in these cross-actions have, upon the facts before me, established any right to the equitable aid of the Court. That those who have acquired through the sale under the assignee, and by subsequent conveyances, all that remained of the assets, interests,

rights or property of the insolvent firm of Hegeman & Co., have the right to use that business name, and the trade-mark with it, if they so use it as to express the fact that they are successors to, and not the original firm. That if they abandon their present mode of styling themselves Hegeman & Co., and upon their signs, labels, stamps, advertisements, &c., &c., declare themselves to be, what they really are, *successors* to Hegeman & Co., they will be entitled to the equitable aid of the Court to restrain J. Nevin Hegeman and Ferrier from holding out to the public that the business they are carrying on is a continuation of that of the old firm, and of making use of its trade-mark, business name, &c., to the detriment of those who have acquired whatever interest there is in the trade-mark and name. That, so far as I can judge from the specimens exhibited on the trial, the articles, called proprietary articles, have all names indicating the qualities, ingredients, or composition of the articles, such as "Hegeman's Ferrated Elixir Bark, or Elixir of Calisaya Bark with Iron," "Hegeman's Compound Fluid Extract of Buchu," "Hegeman's, formerly Velpeau's celebrated remedy for Diarrhœa," and that no trade-mark exists in these names. (*Caswell v. Davis*, 58 *N. Y.*, 223; *Ayer v. Rushton*, 7 *Daly*, 9). That so far as J. Nevin Hegeman and Ferrier attempt to sell articles by such names, and put them up in such a way, as to deceive purchasers in the belief that they are made and put up by the successors of Hegeman & Co., or by that firm as if it were still in existence, they will be restrained upon the application of those who have succeeded to the interests of that firm, when they are in a position to call upon a Court of Equity to protect them.

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SUPREME JUDICIAL COURT OF MASSACHU-
SETTS. IN EQUITY.

JOHN M. CONNELL, ET AL.

VS.

JOSIAH S. REED, ET AL.

DECIDED 16-17 MARCH, 1880.REPORTED 128 MASS., 477.

“East India Remedy” Case.

If a person can have a trade-mark in the words “East Indian,” in connection with the word “remedy,” upon bottles of medicine, (which is at least doubtful), yet if he has falsely adopted and used these words to denote and to indicate to the public that the medicines were used in the East Indies, and that the formula for them was obtained there, he cannot maintain a bill in equity to restrain an infringement of such trade-mark.

J. L. S. Roberts, for plaintiffs.

C. Robinson, J. & G. A. Blaney, for the defendants, were not called upon.

GRAY, C. J.:

This is a bill in equity to restrain the defendant from infringing upon an exclusive right claimed by the plaintiffs in the words "East Indian," used together with the word "remedy" or "remedies," as a trade-mark upon bottles of medicine.

Although the Master reports that there was no evidence that any other person than the plaintiffs or their agents had ever used these words in connection with the manufacture and sale of medicines, it is at least doubtful whether words in common use as designating a vast region of country and its products, can be appropriated by any one as his exclusive trade-mark, separately from his own or some other name in which he has a peculiar right. *Canal Co. v. Clark*, 13 Wall., 311; *Taylor v. Carpenter*, 3 Story, 458, and 2 Sand. Ch., 603; *Gilman v. Hunnewell*, 22 Mass., 149, 148.

But the conclusive answer to this suit is, that the Master has found, upon evidence which appears to us to be satisfactory, that the plaintiffs have adopted and used these words to denote and to indicate to the public, that the medicines were used in the East Indies, and that the formula for them was obtained there, neither of which is the fact. Under these circumstances; to maintain this bill would be to lend the aid of the Court to a scheme to defraud the public. *Pidding v. How*, 8 Sim., 477; *Perry v. Truefitt*, 6 Beav., 66, 76; *Leather Cloth Co. v. American Leather Cloth Co.*, 4 DeG., J. & S., 137, and 11 H. L. Cas., 523, 552, 542, 548; *Palmer v. Harris*, 60 Penn. St., 156. The decree dismissing the bill must therefore be

Affirmed with costs.

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SUPREME COURT, STATE OF NEW YORK.
SPECIAL TERM. IN EQUITY.

THE ELECTRO-SILICON CO.

*vs.*ASA G. TRASK.

DECIDED APRIL, 1880.

REPORTED 59 HOW. PR., N. Y., 189.

“Electro-Silicon” Case.

TRADE-MARK—INJUNCTION.

The plaintiffs coined the compound word “*Electro-Silicon*,” and applied it to a polishing powder prepared by them from an infusorial deposit. They put up the powder in appropriate packages, and acquired a large sale therefor.

The defendant, with a view to imitate their preparation, prepared a powder to be used for the purpose, and put it up in packages similar to those of the plaintiff, and designated it “Electric-Silicon,” and have offered it for sale. **HELD:**

That they should be restrained.

Chase & Bestow, for plaintiff.

John A. Foster, for defendant.

VAN VORST, J.:

The plaintiffs are the manufacturers of a polishing powder and have introduced it into use under the name of "Electro-Silicon." It is put up in wooden boxes, circular in form, the top and sides of which are covered with yellow colored paper. On the paper covering, near the top, the plaintiffs have caused to be printed the name which they have given to their powder, "Electro-Silicon," below which are words generally descriptive of their preparation, and designating the uses to which it may be applied, to which is added its corporate name as proprietor, and their place of business. On the sides are printed directions for its use, as, also, a more detailed account of the article itself.

This preparation is used for polishing gold and silver plated ware and other substances where luster is required.

Plaintiff and its predecessors through whom it claims title, first introduced this article into use, under the name first applied by them, "Electro-Silicon."

The combination of these words is wholly arbitrary and was coined for the purpose.

While the simple word "Silicon" is measurably descriptive of the article, it is not so technically. "Electro" as a descriptive word, has no relation to the substance. It, perhaps, suggests the rapidity of movement with which the polish is applied. "Silicon" is one of the elements, and enters into many substances. The substance used by the plaintiff is an "infusorial deposit" consisting of silicon and oxygen, and may be technically denominated "silica" "silicic acid." It contains, however, according to an analysis in evidence, nearly one hundred per cent. of silicon.

The plaintiff has made the effort and has produced and introduced into the market at considerable expense a useful article which is familiarly known and much dealt in. It is known to dealers under its name "Electro-Silicon."

Six or seven years ago the defendant, who was then in the shoe business, became interested with one Hyatt in putting up and selling an article of polishing powder called "Hyatt's Polishing Powder." But the business proved unsuccessful, and the defendant having sustained some loss, he gave it up, but kept in his

possession some of the old boxes and labels which he had used in connection with the article.

About two years ago he resumed the business, with his powder boxes and labels, and sent out a canvasser to dispose of it. After making some sales, his canvasser said to him : " I have some calls for Electro-Silicon. I think I must have some of that."

The defendant then procured a substance from which he made a powder similar in appearance to that of the plaintiffs, and putting it in boxes covered with yellow paper, with printing thereon arranged much like that of the plaintiff's boxes, introduced it for sale under the name of "Electric-Silicon" printed upon the cover of the box, in a circular form, similar to that of plaintiff's arrangement. The general appearance of the boxes is much the same, and the one, to an unwary purchaser, might readily be mistaken for the other.

The witness Waterhouse, who upon the trial, says, in substance, that he called at the place where the defendant manufactured his article and saw him personally, and asked for "Electro-Silicon," and was handed, or referred to the "Electric," and in the course of conversation which followed, in regard to the difference between the two preparations, the defendant, by way of assigning reasons for putting up "Electric-Silicon," said "he had an article called 'Hyatt's Polishing Powder,' and his customers complained that it did not sell very well ; it was not met favorably by the public, and some one had suggested the idea, if he would get up something looking like 'Electro' he could sell it, and he got this up, which he called 'Electric-Silicon,' and that it would sell readily for the 'Electro-Silicon.' " The defendant made a similar statement to the witness Bestow.

Under the evidence, the defendant's article is inferior in quality to the plaintiff's, and contains less than one per cent. of "silicon." Such was the result of the analysis of Mr. Haberstro, an analytical chemist, who stated further that the defendant's preparation consisted principally of sulphate of lime.

From the above statement, it seems reasonable that the defendant's preparation was designed to be an imitation of the plaintiff's,

and to be sold, although an inferior article, for it. Such practices equity cannot sanction.

The form of the boxes, the color of the paper, the arrangement of the printed matter, the name "Electric-Silicon," are all suggestive of a design to fraudulently imitate the plaintiff's trade and business, and to reap gain thereby; and that such was his motive is shown by the defendant's own statements.

The case is clearly within the principles announced by Lawrence, J., in *Enoch Morgan's Sons' Co. v. Schwakhofer*, 5 *Abbott's N. C.*, 265; and *Brown v. Mercer*, 27 *N. Y. Superior Ct. R.*, 265.

There should be a judgment for the plaintiff, enjoining the defendant, with costs.

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CIRCUIT COURT UNITED STATES, EASTERN
DISTRICT OF PENNSYLVANIA. IN EQUITY.

CARROLL

vs.

ERTHEILER.

DECIDED 6 APRIL, 1880.

REPORTED 1 FEDERAL REPORTER, 688.

“Lone Jack” Case.

1. TRADE-MARK—NAME—INFRINGEMENT.—Where the dominating characteristic of a trade-mark is a name by which the manufacturer's goods have become familiarly known to the public, another manufacturer has no right to designate his goods by that name, even though he accompanies it with a different device.
2. DISTINCTION BETWEEN CIGARETTES AND SMOKING TOBACCO.—Although the revenue laws distinguish between cigarettes and smoking tobacco, there is no such substantial difference as will justify a manufacturer of cigarettes in applying to them a name which has become the well recognized designation of another manufacturer's smoking tobacco.
3. Complainant, a manufacturer of smoking tobacco, used a trade-mark consisting of the name “Lone Jack,” with an accompanying device, and his tobacco became known to the public by that name. Respondent

subsequently commenced manufacturing cigarettes, using a trade-mark with the name "Lone Jack," accompanied with a device different from that of complainant. **HELD:**

That complainant was entitled to an injunction.

4. **PRACTICE—EVIDENCE—PREPARATION OF AFFIDAVITS.**—Where affidavits have been prepared and printed without seeing the witnesses, and sent over the country to be signed by those who might be found willing to do so, the statements therein are not regarded with confidence by the Court.

MOTION FOR A PRELIMINARY INJUNCTION.

The bill set forth that complainant had for over 16 years manufactured smoking tobacco, and had adopted, and continuously and exclusively used during that time, a trade-mark, a prominent characteristic trait of which was the arbitrarily selected word-symbol "Lone Jack:" that he affixed this trade-mark, by means of printed labels and wrappers, to his smoking tobacco, which was put up in various styles of packages, including the form commonly known as cigarettes; that although the said word-symbol "Lone Jack" was generally used in connection with certain words, being advertisements of his name and place of business and other matter, and frequently the name of the specific article and the representation of the bust of a man smoking, still complainant's smoking tobacco came to be popularly known among merchants and consumers by the peculiar distinctive designation of "Lone Jack," and was bought and sold under that name; that respondent, intending wrongfully to usurp complainant's reputation, and to deceive the public into supposing that they were buying complainant's tobacco, colorably imitated complainant's trade-mark, and in July, 1879, began to affix to goods of substantially the same descriptive properties as complainant's the word-symbol "Lone Jack," and to sell smoking tobacco wrapped in papers and bearing a label containing, as its most prominent characteristic, *the said word-symbol*, and that the public had been deceived thereby into buying respondent's tobacco, supposing it to have been manufactured by complainant. The bill prayed for an injunction and account.

The answer denied that complainant had any proprietary or exclusive interest in the word-symbol "Lone Jack" by itself, and alleged that complainant's trade-mark only gave him the right to use the words "Lone Jack" in connection with the words "The Celebrated" above the bust of a man smoking a pipe, and with the words on each side of said bust, "Or seek no further, for better can't be found," and below said bust the words, "Smoking tobacco, manufactured by John W. Carroll, Lynchburg, Virginia." It denied that complainant had ever applied said trade-mark to cigarettes, or to any other article than smoking tobacco, or that he had made or sold cigarettes by the name of "Lone Jack." It alleged that what is known by smokers and to the trade as smoking tobacco is a distinct article of merchandise from cigarette tobacco, and cannot be used for the manufacture of cigarettes, and that cigarette tobacco paid a special tax to the United States Government. It further alleged that respondent had, in May, 1879, adopted and was entitled to a trade-mark for cigarettes consisting of the words "Lone Jack" above and the word "Cigarettes" below the figure of the Jack of Spades, and the name "Ertheiler & Co., New York," below, and "The best" below all; and that the sales of cigarettes under this trade-mark were the only sales by defendant complained of by plaintiff. The answer further denied that there was any resemblance between the trade-marks, or any attempt at imitation; or that respondent had any intention to usurp complainant's reputation, or deceive the public; or that the public were deceived. Both parties filed affidavits in support of the facts respectively alleged in the bill and answer.

William Henry Browne and George Harding, for complainant.
Field, Dorsheimer, Bacon & Deyo, for respondent.

BUTLER, J.:

It would be unwise to say more at this time than is necessary to explain the action of the Court in disposing of the interlocutory motion now before it. The plaintiff's exclusive right to the trade-mark, as a designation of his smoking tobacco, is not doubted.

2. The defence rests upon a denial—*first*, that the defendant has used the trade-mark; and *second*, that he has used it as a designation of “Smoking Tobacco.” The second branch may, most conveniently, be noticed first. While the revenue laws, for purposes of taxation, distinguished between smoking tobacco and cigarettes, there is, we believe, no substantial difference. Cigarettes consist of smoking tobacco, similar in all material respects to that used in pipes. The circumstance that a longer “cut” than that commonly used in pipes is most convenient for cigarettes is not important, nor that the tobacco is smoked in paper instead of pipes. It may all be used for either purpose, and is all embraced in the term “smoking tobacco.”

We do not believe the public or the trade draw such a distinction as the defendant sets up. We have not overlooked the statements contained in his affidavits, but the method pursued in obtaining this testimony, generally, does not recommend it to our confidence. The affidavits seem to have been prepared without seeing the witnesses, and sent over the country to be signed by those who might be found willing to sign them. They are, generally, similar in language, and printed. This method of obtaining testimony is not worthy of encouragement. If the public and trade draw such a distinction, and, therefore, do not suppose the defendant’s cigarettes to be made of the plaintiff’s tobacco, (and the defendant so understands), why does he adopt the designation by which this tobacco is familiarly known, and persist in using it?

1. The dominating characteristic of the plaintiff’s trade-mark is the *name* “Lone Jack.” His tobacco has come to be known and described by this name, throughout the country, to such an extent that the accompanying device has ceased to be important, if it ever was so,—doubtless rarely observed, and slightly remembered. At home and abroad, to the trade and the public, it is familiarly known as “Lone Jack,” and is thus designated as the plaintiff’s manufacture by purchasers and sellers.

The defendant’s application of this name to his smoking tobacco is an adoption and use of the essential part of the plaintiff’s trade-mark. Surrounding it with a different device signifies nothing to the public, who attach no importance to the device of the plain-

tiff. The defendant's name upon the cigarettes, if recognized, (and it would not be without close inspection), would not inform the public that the tobacco is not of the plaintiff's manufacture. That the defendant's act is calculated to mislead can hardly be doubted, that it has misled, the plaintiff's affidavits, we think, show; and the inference that the defendant supposed it would mislead, and intended it should, cannot well be avoided. Why otherwise did he adopt this particular name? He knew it to be the recognized designation of the plaintiff's tobacco, which had become popular with consumers and the trade. Did he not expect the public to be influenced thereby and his business increased? An affirmative answer cannot well be avoided. If he did not, however, the injunction will do him no harm, for he has not yet had time to establish a reputation of his own under this name.

Whether the plaintiff commenced putting up his tobacco in the form of cigarettes before the defendant applied the designation "Lone Jack" to his cigarettes need not be considered at this time.

The law involved is, we believe, well settled, and is so fully stated in every aspect suggested by the learned counsel for the defendant, in *McLane v. Fleming*, 6 *Otto*, 245, and *Singer Sewing Machine Co. v. Wilson*, 3 *Law Reports*, (*appeal cases*,) 376, that no more is deemed necessary than a reference to these cases.

3. A preliminary injunction as prayed for will be granted.

An injunction was subsequently issued restraining respondent, until the further order of the Court, from selling cigarettes or smoking tobacco in any form bearing the trade-mark "Lone Jack."

Note.—See *Sawyer v. Horn*, *ante*, 24.

57

SUPREME COURT OF ILLINOIS.

OTTOMAN CAHVEY CO.

vs.

JAMES F. DANE, ET AL.

DECIDED 18 MAY, 1880.

REPORTED 95 ILL., 203.

*“Ottoman Cahvey Company” Case.*CORPORATIONS—PARTNERSHIPS—DOING BUSINESS UNDER
THE NAME OF ANOTHER CORPORATION.

A company claiming to have been incorporated under the laws of another State, commenced doing business in this State under its assumed corporate name. Subsequently, another company became incorporated by the same corporate name as the former, under the laws of this State, and commenced business in the same city in which the former company was already established. The company organized under the laws of this State, sought to restrain the persons composing the other company from continuing to do business under the corporate name, alleging that the defendants' pretended corporation no longer existed, but it was held that was not sufficient ground for the relief sought. If the defendants were no longer incorporated, or if their original organization as a corporation was illegal, they still had a right to prosecute their business as partners, and under any name they might adopt.

APPEAL from the Appellate Court for the First District.

This suit was commenced originally in the Superior Court of Cook County, and tried before the Hon. Samuel M. Moore, Judge, presiding. On appeal to the Appellate Court the decree of the Superior Court was affirmed.

Messrs. McClellan, Tewkesbury & Cummins, for the appellant.
Messrs. Roberts & Hutchinson, for the appellees.

PER CURIAM.—This was a bill in equity, brought by Ottoman Cahvey Company, appellant, against James F. Dane and Scammon P. Richards, to enjoin defendants from using the trade-mark of complainant, of which the words "Ottoman Cahvey" were an essential part, and also to enjoin the defendants from using the corporate name of complainant, "Ottoman Cahvey Company." On the hearing upon bill, answer and proofs, complainant abandoned that portion of its bill which related to the trade-mark, and only attempted to restrain the defendants from using the corporate name. The Superior Court, however, dismissed the bill for the want of equity, and this decree, on appeal, was affirmed in the Appellate Court.

The only question which we are called upon to consider by this appeal is, whether, under the allegations of the bill and the evidence, a Court of Equity should lend its aid to restrain the defendants from the use of a certain name in the transaction of their business.

It appears, from the evidence, that on or about the 29th day of June, 1875, the defendants and Andrew H. Adams organized a corporation, under the laws of the State of Michigan, which was known as the "Ottoman Cahvey Company," the two defendants being the principal stockholders. The business of the corporation was carried on in the City of Chicago, under the name assumed by the defendants, from the time the company was formed in 1875 until the bill in this case was filed. It also appears that on or about the 24th day of September, 1878, Andrew H. Adams and others organized a corporation, under the laws of this State, to be known as the "Ottoman Cahvey Company," which was located in

Chicago, and this bill was filed by the last named corporation to restrain the defendants from doing business under the corporate name of "Ottoman Cahvey Company."

We perceive no ground upon which the bill can be maintained. If the Michigan corporation was dissolved by decree of Court, as claimed by the complainant, or if the Michigan corporation made an assignment, as contended, and no longer acted in the capacity of an incorporated company, still the defendants had the clear right to continue the business in which they were engaged, as partners, and, if they saw proper to conduct their business under the firm-name of the "Ottoman Cahvey Company," no reason is perceived why they could not do so.

The fact that a corporation was organized under the laws of this State, subsequent in date to the time defendants commenced business, which assumed the same name under which defendants were carrying on their business, could confer no right upon complainant to invoke the aid of a Court of Equity to restrain the defendants from the use of the name. So far as the complainant was concerned the defendants had the prior right to the use of the name, as they had conducted their business under the name assumed continuously, from the date of the organization of the Michigan corporation. If the Michigan corporation was not legally organized, or if it was dissolved by decree of Court, the defendants who carried on the business did so as co-partners, and they had the right, as such, to assume any name they saw proper; and they could use the name "Ottoman Cahvey Company" as well without a legal organization, as they could had they been legally organized under the laws of Michigan.

So far as is shown by this record, the defendants had at least as much right to use the name assumed as the complainant. As the complainant has shown no equitable ground for relief, the Superior Court did right in dismissing the bill for the want of equity.

The judgment of the Appellate Court will be affirmed.

Judgment affirmed.

58

IN THE UNITED STATES PATENT OFFICE.

EX PARTE HEYMAN.

DECIDED 31 MAY, 1880.

REPORTED 18 OFFICIAL GAZETTE, 922.

“Invigorator Spring Bed” Case.

1. The law is well settled that words merely descriptively used, are not proper subjects for trade-mark registration. *Canal Co. v. Clark*, 13 Wall., 311.
2. The use of descriptive words objectionable, for two reasons, first, because the public will be apt to understand the words as merely descriptive, and will not therefore associate them with origin or ownership, and second, because others can employ a merely descriptive word upon their wares with equal truth and consequently with equal right.
3. If the descriptive character that might attach to a word is so very remote as to be but secondary, so that the word will be understood by the public not as a descriptive but as a fanciful term, it may then constitute a valid trade-mark.
4. The word “Invigorator” attached to or stamped upon spring bed-bottoms allowed, because merely suggestive.

APPLICATION of George Heyman filed August 11, 1869.

MARBLE, *Commissioner* :

The applicant in this case seeks to register the word “Invigorator” as a trade-mark for spring bed-bottoms. The registry is

denied by the examiner on the ground that "the word in question is, in a certain sense, descriptively used by the applicant; or the objection may be stated in another form, that the word is not distinctly an arbitrary designation, and hence would not serve the purpose of indicating the origin and ownership of the articles to which it is designed to be affixed."

1. It is undoubtedly a well settled rule of law that words that are merely descriptively used are not proper subjects for trade-mark registration. This is thus distinctly stated by the Supreme Court in the case of the *Canal Company v. Clark*, (13 Wall., 311). "Nor can a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, be employed as a trade-mark and the exclusive use of it be entitled to legal protection." (*Amoskeag Manufacturing Company v. Spear*, 2 Sand., 599; *Hathaway & Sons, C. D.*, 1871, 97; *Alden* 15 O. G., 388; *The Safety Powder Company*, 16 O. G., 136).

2. The use of descriptive words as trade-marks appears from the decisions to be objectionable for two reasons; first, because the public will be apt to understand the words as merely descriptive, and will therefore not associate them with the origin or ownership; and second, because others can employ a merely descriptive word upon their wares with equal truth and consequently with an equal right.

A distinction should be made between words which are the legitimate accepted terms in describing "the qualities, ingredients, or characteristics of an article," and words which are but inferentially or remotely descriptive. In the one case the words will be understood by the public as indicating some peculiarity of the article itself, and not as pointing to origin or ownership; in the other they will be regarded rather in the light of words fancifully and arbitrarily used, and will consequently serve the purpose of a trade-mark. This appears to me to be the proper test. If the word employed (as the word "safety" in connection with gun-powder and the words "System-Renovator" in connection with medicines, in the cases cited by the Examiner) are so obviously indicative of some peculiarity or quality of the article that the public will be apt to consider them mere descriptive terms, then it

is clear that they are not proper subjects for trade-mark registration, since they can neither indicate origin nor ownership, nor can they be the exclusive property of any one.

3. If, however, the descriptive character that might attach to a word is so very remote as to be but secondary, so that the word will be understood by the public not as a descriptive but as a fanciful term, it will then accomplish the office of a trade-mark, and to the use of a word which in connection with a particular article is primarily fanciful, an exclusive right can exist. Indeed, it is common to find words, either newly coined or arbitrarily selected, the validity of which as trade-marks has been sustained by the Courts, which contain a suggestion more or less remote of some peculiarity, real or supposed, of the article to which they are attached. An example of this is afforded by the case of *Davis v. Kendall*, (*American Trade-Mark Cases*, 112), where the term "Painkiller" was held to be a proper trade-mark as applied to a medical compound.

I do not think that the word "Invigorator" stamped upon spring bed-bottoms could be regarded as merely descriptive. It is true, perhaps, that by a process of logical deduction it may be resolved into a description in one sense, since a spring bed-bottom may be conducive of sleep, and sleep invigorates; but, in my judgment, the primary signification which the public would attach to this term would be a fanciful one.

The decision of the Examiner is reversed.

59

IN THE UNITED STATES PATENT OFFICE.

EX PARTE OLIVER.

DECIDED 31 MAY, 1880.

REPORTED 18 OFFICIAL GAZETTE, 923.

“Raleigh” Case.

A geographical name, although also the name of an historical personage, is not a proper subject for trade-mark registration. The word “Raleigh” refused.

APPLICATION of R. W. Oliver and J. E. Robinson, filed March 3, 1880.

MARBLE, *Commissioner*:

Applicants in this case seek to register the word “Raleigh” as a trade-mark for manufactured tobacco, whether such word be accompanied by a portrait of Sir Walter Raleigh or not. The Examiner holds the word alone to be geographically descriptive when used upon tobacco, it being the name of a leading city of a tobacco growing State, and he has accordingly refused the registration.

It is contended on behalf of the applicants that the word as here used is the name of an historical personage, and that it would

be more likely to be associated with the person than with the place of that name. In this statement of counsel I cannot concur. Situated, as the City of Raleigh is, in the centre of a tobacco growing region, the vast majority of persons, and especially of the inhabitants of that section of the country, as well as many elsewhere whose historical knowledge is defective, would, I think, regard this word as indicative of the place of manufacture. The mere circumstance that the name of a place is also the name of a person, cannot alter the fact that any manufacturer of tobacco in Raleigh, and there are doubtless such there, would have a perfect right to use this mark upon his wares, thus destroying the exclusiveness of the right of user—an essential feature in a lawful trade-mark—nor the fact that many, and I think most, persons would understand the mark as geographically descriptive. The authorities are numerous and conclusive upon the point that, as a rule, geographical names are not proper subjects of a trade-mark. (*Ex parte Knapp*, 16 O. G., 318; *Marsching & Co.*, 15 O. G., 294; *Cornwall & Bros.*, 12 O. G., 312). There have been, it is true, exceptions to this rule, where the geographical words employed were obviously fancifully used, and were of such a character that they could not be misunderstood as indicating the locality in which the goods were made; but this cannot, in my judgment, come under the excepted cases.

The decision of the Acting Examiner of Trade-Marks is affirmed.

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IN THE UNITED STATES PATENT OFFICE.

EX PARTE STRAITON & STORM.

DECIDED 31 MAY, 1880.

REPORTED 18 OFFICIAL GAZETTE, 923.

The "Ribbon" Case.

1. A band of ribbon of such shape and so attached to the wares of a manufacturer as to enable them to be readily distinguished in the market, may properly be allowed registration as a trade-mark.
2. *Ex parte Gordon*, 12 *Official Gazette*, 517, approved.
3. The mere fact that such strip or ribbon may also be the vehicle of other matter, cannot detract from its efficiency as a means of distinguishing the goods upon which it is placed.

APPLICATION of Straiton & Storm, filed August 20, 1879.

MARBLE, *Commissioner*:

Applicants in this case seek to register as a trade-mark for cigars—

“A waved band or ribbon of rectilinear form longer than it is wide, which is fastened to the two ends of a cigar box, and so placed with reference to the cigars within the box as to be below some of said cigars and above the remaining cigars.”

The Examiner denies the registration for the reason, as he states in answer to applicant's appeal, that—

“The matter sought to be registered does not amount to an arbitrary symbol, the band or label serving the office of a mere label, which, besides the descriptive matter contained thereon, may also contain matter indicative of origin and ownership, and thus serve as the vehicle of a lawful trade-mark. A contrivance, design, device, name, symbol, or other thing, to be a lawful trade-mark, must be of such character that its employment in connection with a particular commodity will indicate the origin and ownership of that commodity.”

In support of his position he has cited the following cases: *Ex parte Gordon*, (12 O. G., 517); *Harrington v. Libbey*, (*Ibid*, 188); and *Ex parte Kane & Co.*, (9 O. G., 105).

I fail to see the pertinency of these references to the present case. In the case of *Gordon* the alleged trade-mark consisted of a narrow strip of leaf tobacco placed as a wrapper around the mouth-piece of a cigarette. The Acting Commissioner refused the registration upon the ground that the prime office of this wrapper was a useful one, and its function as a trade-mark was but merely incidental. I shall have occasion, however, to revert to this decision. In the case of *Harrington v. Libbey*, the Court merely decided that the complainant could not enjoy the exclusive right to a decorative tin pail as a collar receptacle, although he had used the same and had registered it as a trade-mark. The Commissioner, in *Ex parte Kane & Co.*, denied registration of an alleged trade-mark consisting of “galvanized iron hoops placed upon liquor barrels of dark color,” upon the ground that their use was not in the particular instance an original appropriation, as such hoops had long been used on other barrels, and if new as applied to whiskey barrels were not sufficiently distinguishable from the same mark on other barrels to indicate ownership. It is not pretended that the device employed by applicant in this case has any mechanical function whatever, nor is it an old form of receptacle applied to a particular use. Indeed, no references whatever are given to show that strips or ribbons have been attached to boxes of any description in a manner resembling this. It is

simply a waved band or ribbon of rectilinear form of a greater length than width arranged in connection with the box containing cigars, in a certain way.

There have been numerous definitions of a trade-mark, the difficulty seeming to be to find one sufficiently comprehensive to embrace the many means which a manufacturer may employ to distinguish his wares. The Acting Commissioner, in the *Gordon Case* before referred to, says:

“Thus a box, barrel or wrapper, containing merchandise, whatever its form, cannot, *per se* be a trade-mark, but a name, symbol, figure, letter, form or device, cut, stamped, cast, impressed, or engraved thereon, or in some other manner attached thereto or connected with the article itself, may be a proper trade-mark.”

This statement is fully sustained by the case of *Moorman v. Hoge*, (2 *Sawyer*, 78), to which reference is there made. Surely under so broad a definition, applicants' mark must find some place. It is a “device” “attached to the box and connected with the article itself,” for the purpose of indicating the origin of the goods. Will it serve this purpose? An inspection of the illustration at such a distance that the printed matter contained on the band cannot be read, shows at a glance that applicants have attached to their wares a device by which it can be readily distinguished from the wares of another. This is the purpose of a trade-mark, and this purpose applicants have, in my judgment, accomplished by means which is clearly comprehended under all the authoritative definitions of a lawful trade-mark. In the case of *Gordon* the following language occurs which although but a dictum, is here in point:

“Perhaps this objection (the useful functions of the mouth-piece of the cigarette) would not lie if, as in the case cited by applicants—that of *Mommer*, for which a trade-mark was granted for a silk band around a champagne bottle—a silk band was attached to the cigarette, or a colored piece of paper or similar device connected therewith, for in such instance the device would answer no other purpose than that of a trade-mark—perform no mechanical function.”

This language would seem to recognize the propriety of granting registration for such marks as applicant's.

The mere fact that applicants' strip can be made the vehicle of other matter which may constitute a trade-mark does not detract from the efficiency of the strip itself as means or device for distinguishing the wares upon which it is placed. The same objection might be urged to a figure in the form of a star or crescent or other fanciful shape, for upon such, as upon applicants' strip, a trade-mark might be stamped, and yet these fanciful figures without any matter marked thereon would certainly be understood as distinguishing marks in the trade as trade-marks. The office has repeatedly allowed the registration of strips, either of peculiar shape or attached in some distinctive manner to various articles, as appears by the numerous cases to which my attention has been drawn.

The decision of the Examiner is reversed.

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SUPREME COURT, STATE OF NEW YORK.
IN EQUITY.

THE ELECTRO-SILICON COMPANY*vs.*

BENJAMIN LEVY.

DECIDED JUNE, 1880.

REPORTED 59 HOW. PR., N. Y., 469.

“*Electro-Silicon*” *vs.* “*Nevada Silicon.*”

1. Plaintiff can have no exclusive right to the word *Silicon*, which is one in common use, and is reasonably, in so far as the substance of this powder is concerned, descriptive.
2. In preparing his article for market, defendant has carefully followed the plaintiff in the size and form of the boxes and the material out of which they are made.

The defendant had once been in the employment of plaintiff, was entirely familiar with its business and trade-marks and had been in communication with its customers.

3. By honest and conscientious effort there is no possible objection to his successful manufacture and sale of the article he produces, but he should not be allowed by any unfair artifice, to impose upon others his

article for the plaintiff's, and in this way deceive buyers and injure the plaintiff.

4. A close examination, it is true, does disclose many differences in the printed matter, but the general appearance of the two packages is much alike. The coincidence was not accidental and was evidently disguised.
5. **HELD:** that defendant should be restrained not because he is prohibited from using the word "Silicon," or for the reason that he uses a round wooden box or yellow paper with border and printing thereon. To these separately, the plaintiff is not entitled to the exclusive use. But defendant has combined this word and these things in such a manner as to invade the plaintiff's rights, secured by their first adoption in combination.

Chase & Bestow, for plaintiff.

Otto Horintz, for defendant.

VAN VORST, J.:

1. The plaintiff can have no exclusive right to the use of the word "Silicon," which is one in common use, and is reasonably, in so far as the substance of this powder is concerned, descriptive. Perhaps it is not technically accurate to call the "infusorial earth," used by these parties to produce the powder, and which is found in various parts of the globe in a natural state, "silicon." Silicon largely predominates, but the product itself is silicon *plus* oxygen. The plaintiff however, in its description of the article printed on its boxes, says it has been "ascertained by analysis to be pure silex or silicon." If that representation be true, I do not see why the defendant, if he makes a powder from the same deposit or substance, may not also call it "silicon." Of a word which the plaintiff admits to be descriptive, it can have no monopoly.

In the case of this same plaintiff against Trask, lately decided by me, the defendant clearly enough designed to simulate the peculiar name which the plaintiff had originally adopted to distinguish its article, "Electro-Silicon." Trask called his article "Electric-Silicon." The slight change was itself suggestive of a fraudulent intention.

The evidence showed that Trask's design in adopting that name, and in the manner in which he put up his powder, was to take advantage of the trade which plaintiff had secured. (*Electro-Silicon Co. v. Trask*, 59 *How. Pr.*, N. Y., 189.

The defendant in this case calls his article "Nevada Silicon." But in other respects he has followed Trask's methods, which have been condemned.

2. In preparing his article for market, defendant has carefully followed the plaintiff in the size and form of the boxes used and the material out of which they are made, and he has covered the top and sides with yellow paper, with printed matter arranged on the top within a circular border, one of a heavy, another of a light black line, clearly in imitation of the plaintiff's manner of presenting his article. And as the plaintiff has imprinted on its label its corporate name, "Electro-Silicon Co.," the defendant has printed on his boxes in the same relative position, the name "Nevada Silicon Co.," whereas, as the proof discloses, there was no such company. The defendant had once been in the employment of the plaintiff, was entirely familiar with its business and trade-marks and had been in communication with its customers. It seems to me that his object in so imitating the plaintiff's packages, in his own preparation is quite apparent. The plaintiff had, at much expense and considerable effort, put forth through many years, secured a large trade for what is proved to be a really useful article. I think it quite evident that the defendant, by such imitation, would take to himself some of plaintiff's trade and profit.

3. By honest and conscientious efforts there is no possible objection to his successful manufacture and sale of the article he produces, but he should not be allowed by any unfair artifice to impose upon others his article for the plaintiff's, and in this way deceive buyers and injure the plaintiff.

The testimony of many dealers in the article had been taken, and the weight of the evidence is that the defendant's article is so put up as readily to deceive the ordinary and unobservant purchaser.

4. A close examination, it is true, does disclose many differences in the printed matter, but the general appearance of the two

packages is much alike. The coincidence is not accidental, and was evidently designed. The learned Judge before whom the motion for an injunction was heard in chambers, restrained the defendant, and I think he was correct in his conclusion. The evidence adduced on the hearing justifies a like result.

5. The defendant should be restrained, by the judgment of this Court, not because he is prohibited from using the word "silicon" or for the reason that he uses a round wooden box or yellow paper with border and printing thereon. To these separately the plaintiff is not entitled to exclusive use. But the defendant has combined this word and these things in such a manner as to invade the plaintiff's rights, secured by their first adoption in combination. The defendant has so closely imitated the plaintiff's combined use of these elements as to inflict injury upon him, and in a way well calculated to deceive buyers of the article. The defendant's article should stand on its own merits and be introduced in a manner as not to conflict with the plaintiff's rights. The success of a new enterprize, which is often attended with difficulty, might be at once secured if its proprietors could take to themselves and utilize the good reputation of others, symbolized in part by their marks and badges. But without consent this cannot be done. (*Enoch Morgan's Sons' Co. v. Schwakhofer*, 5 *Abbott's N. C.*, 265; *Brown v. Mercer*, 37 *Superior Court Reports*, 265.

There should be judgment for the plaintiff based upon the principles above indicated.

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SUPREME COURT, STATE OF NEW YORK.

IN EQUITY.

STEPHEN A. POTTER, AND OTHERS, RESPONDENTS,*vs.*THOMAS B. MCPHERSON, AND OTHERS, APPELLANTS.

DECIDED JUNE, 1880.

REPORTED 21 HUN, N. Y., 539.

“National System of Penmanship” Case.

1. United States Courts have exclusive jurisdiction of actions for an infringement of a copyright. An author's property in his manuscript is lost by its publication. What combination of words will be protected as a trade-mark. What degree of similarity must be shown to justify an injunction restraining the use of another's trade-mark.

The plaintiffs and their predecessors have, since 1863, published and offered for sale, as a system for teaching and learning penmanship, books containing the copies to be written and also directions for learning, acquiring and practicing the said art, with such illustrations as are required to convey and explain the ideas sought to be inculcated. On the cover of each book was printed “Payson, Dunton & Scribner's National System of Penmanship,” and the book has been called and known as the “National System of Penmanship.”

The defendants thereafter published a book substantially in the same form, so far as its general appearance, binding and color was concerned, having upon the cover the words "Independent National System of Penmanship," such words being printed in the same manner, and the letters being of the same size and form, and occupying the same position as they do upon the cover of the plaintiff's book. The directions, instructions and illustrations contained in the two books were, in many cases, literally, and in the remaining cases, substantially the same.

On an appeal from an order restraining the defendants from publishing or selling the said book, or any other book representing or imitating those of the plaintiffs, and from using the words "National System of Penmanship," in connection therewith. HELD:

2. That as to the printed instructions, the injunction could not be maintained for the reason that if the plaintiffs had copyrighted their book, the United States Courts had exclusive jurisdiction of all actions for an infringement thereof, and that if they had not copyrighted it, they had lost their exclusive property in the said instructions and directions by publishing the same in a printed book and offering it for sale.
3. That so far as the injunction restrained the defendants from using the words "National System of Penmanship," in connection with their work, it was proper and should be affirmed.
4. That the injunction was properly issued if it appeared that persons, desiring to purchase the plaintiffs' publication, might well accept that of the defendants, supposing and believing it to be the plaintiffs, even though persons engaged in the trade of buying the books with an intention to re-sell them, might not be misled by the resemblance, and though the difference could be readily detected by a comparison of one book with the other.

APPEAL from an order made at Special Term continuing an injunction granted herein.

This action was brought to restrain the defendants from publishing and selling certain copy-books. The complaint alleged that the plaintiffs were the owners of a trade-mark or right of property in the name "National System of Penmanship," as applied to certain books, containing a system for teaching and learning penmanship, published and sold by them, the specific name of their publication being "Payson, Dunton & Scribner's National System of Penmanship." That the defendants, McPherson &

Greene, had issued one number of a copy-book similar to that of the plaintiffs, and imitating it exactly in style of binding, color and ornamentation. The name of the defendants' book differed from that of the plaintiffs' only in the use of the word "Independent" as a substitute for "Payson, Dunton & Scribner."

Artemas B. Smith, for the appellant.

The words, "National System of Penmanship," cannot be a trade-mark. No person can acquire exclusive property in the common words of language. (*Taylor v. Gillies*, 59 *N. Y.*, 331; *Am. Trade-Mark Cases*, 736; *Stokes v. Landgroff*, 17 *Barb.*, 608; *Browne on Trade-Marks*, secs. 144, 148; *Canal Company v. Clark*, 13 *Wall.*, 311).

Betts, Atterbury & Betts, for the respondents.

The plaintiffs have a clear right of property in the words "National System of Penmanship," as applied to a copy or writing-book; and this whether the words "Payson, Dunton & Scribner" are added to the said name or not. (*Sebastian on Trade-Marks*, 167; *Matsell v. Flanagan*, 2 *Abb. Pr.*, *N. S.*, 459; *Snowden v. Noah*, 1 *Hopk.*, 355; *Hogg v. Kirby*, 8 *Ves.*, 215; *Chappel v. Shead*, 2 *Kay & J.*, 117; *Messerole v. Tynberg*, 36 *How. Pr.*, 14; *Congress Co. v. High Rock Co.*, 57 *Barb.*, 526; *Hazard v. Caswell*, 67 *How. Pr.*, 1; *Newman v. Alword*, 6 *Sickles*, 189; *Hine v. Lart*, 10 *Jur.*, 106; *Taylor v. Taylor*, 23 *L. J. Ch.*, 255; *Witherspoon v. Currie*, *Law R.*, 5 *H. L.*, 508; *Williams v. Johnson*, 2 *Bosw.*, 1; *Williams v. Spence*, 25 *How. Pr.*, 366; *Field v. Lewis*, *Seton*, 4th *Ed.*, 237; *Hurst v. Denham*, *Law R.*, 14 *Eq.*, 542). It is no answer for the defendants to say that they have not adopted the whole of the trade-mark of the plaintiffs; that they call their books the "Independent National System of Penmanship," whereas the plaintiffs' are called "Payson, Dunton & Scribner's National System of Penmanship." (*Clement v. Maddock*, 1 *Giff.*, 98; *Mack v. Petter*, *Law R.*, 14 *Eq.*, 431; *Gillott v. Esterbrook*, 47 *Barb.*, 455; 48 *N. Y.*, 374; *Braham v. Bustard*, 9 *L. T.*, *N. S.*, 198; *Orr v. Johnson*, 27 *Weekly Rep.*, 575). It does not protect the defendants that the first purchasers from them would distin-

guish between their goods and those of the plaintiffs. The copy-books are sold to wholesale buyers for the purpose of re-sale to retailers, and from them to users. (*Clark v. Clark*, 25 Barb., 76; *Orr v. Johnson*, *Weekly Notes*, January 31, 1880; *Singer Manufg. Co. v. Wilson*, 26 W. R., 664; *Witherspoon v. Currie*, Law R., 5 H. L., 508; *Edelsten v. Edelsten*, DeG., J. & S., 185; *Seixo v. Provezende*, Law Rep., 1 Ch., 192; *Ford v. Foster*, Law R., 7 Ch., 611).

DANIELS, J..

The injunction issued in this case, and continued by the order from which the appeal has been taken, restrained the defendants from publishing, selling, or exposing for sale the books referred to in the complaint, and from publishing, selling or exposing for sale any imitation of such books or pamphlets, or any books or pamphlets made to represent the books and pamphlets sold by the plaintiffs and called "Payson, Dunton & Scribner's National System of Penmanship," and from using the name of "National System of Penmanship," in connection with books or pamphlets published or sold by the defendants. The books referred to in the complaint and also in the order itself, are published as a system for teaching and learning penmanship. They contain as well the copies to be written, as detailed directions for learning, acquiring and practicing the art of penmanship, together with illustrations required to convey the ideas to be inculcated. In these respects the books published by the plaintiffs and those of the defendants are to a great extent literally the same, and where that is not their character they are substantially the same. These directions, instructions, and illustrations are contained in three printed pages of the books, and so far as they extend they do not differ substantially in theory or detail from other books published for the purpose of being used in teaching the arts or sciences taught in schools. The system is as complete in itself as that which is contained in the most elaborate publications made upon other subjects, and this publication substantially constitutes a book in and of itself. In support of the injunction restraining the defendants from publishing his book,

affidavits have been presented on the part of the plaintiffs tending to show that their book had been copyrighted, but this statement has been fully controverted by the affidavits and proofs presented on the part of the defendants. It is unnecessary, in the disposition of this case, to determine which of these statements may be correct, for if the book has been copyrighted under the laws of the United States, while that would secure to the plaintiffs the right to restrain its publication by the defendants under those laws, it would not afford this Court jurisdiction over the subject-matter of the controversy.

1. The right, arising under the laws of the United States, would be one which would be within the exclusive jurisdiction of the Federal judiciary to vindicate and maintain. (*Dudley v. Mayhew*, 3 *Comst.*, 9). If it be conceded, therefore, that the plaintiffs' book has been copyrighted, as this Court has no jurisdiction over an action brought for redress, upon that ground, it could not, by means of an injunction, restrain the defendants from making an improper publication of the plaintiffs' work. But if, as it is contended on the part of the defendants, the fact is that the book never was regularly copyrighted, then the publication and sale of it deprived the plaintiffs of their exclusive property in its composition, for, by the common law, while an author has property in his manuscript, that continues only so long as it is not made the subject of publication and sale. When it becomes embodied in the usual manner in a book for general sale, and is sold indiscriminately to all those desiring to acquire it, the author's exclusive right of property is gone, and all other persons, after that, are at liberty to publish and sell the book. (*Shook v. Daly*, 49 *How. Pr.*, 366; *Palmer v. DeWitt*, 47 *N. Y.*, 532). Until published, the work is the private property of the author, wherever the common law rights of authors are regarded, but when published with the assent of the author, it becomes the property of the world. (*Id.*, 539; *French v. Maguire*, 55 *How. Pr.*, 471). The only manner in which this result can be prevented is by the author or publisher availing himself of the rights secured by the copyright laws of the United States. Where he fails to do that, and publishes and sells his work, or permits that to be done by

others with his assent, the exclusive property of the author in the publication is afterwards lost.

2. According to these principles, which are well sustained by the authorities, so much of the injunction ordered as restrains the defendants from publishing this book, or any imitation of any book or pamphlet representing that sold by the plaintiffs was unauthorized, and to that extent, it must certainly be vacated.

3. The only portion of the injunction, therefore, concerning which it can be claimed on the part of the plaintiffs that it should be continued, is that relating to the title under which the plaintiffs' book has been published; for as to that, the law does not deprive them of their rights of property by the mere publication and sale of the book itself. That is the distinguishing incident by which their publication becomes known in the market, and as to that they have a right to maintain the exclusive use, where it has been properly devised, for the purpose of maintaining their trade, and preventing it from being appropriated to the business of other persons. It appears by the affidavits produced on the part of the plaintiffs, that the publication was commenced certainly as early as the year 1863, and that it was then designated, in addition to the name of the composers, as their "National System of Penmanship," and it appears to have been so continued and known from that time down to the present. This fact is not at all disproved by the evidence contained in the defendants' papers; for while the book, in the trade, has been ordered as the book of its writers, or composers, or in some other manner, without using the controverted phrase tending more particularly to describe it, it will not follow from that circumstance, that it was not also known and distinguished by the title given to it, and printed upon its cover. The evidence on the part of the plaintiffs is that the different forms in which the book has been published have at all times been accompanied with this designation, that is, it has been called and known as the "National System of Penmanship," and these words when connected with the names of persons by whom the system was devised and composed, indicated its origin sufficiently to require their use of it to be protected under the laws of the State, relating to the use of trade-marks. Upon that subject, the

law protects manufacturers and dealers in the use of words, phrases or other devices employed by them to distinguish their commodities from those of other dealers, when they are such as to indicate the origin or ownership of the article to which they are applied. (*Farina v. Silverlock*, 39 *Eng. L. & Eq.*, 514—where the exclusive right to use the term “*eau-de-cologne*” was maintained; *Seixo v. Provezende*, *L. R.*, 1 *Ch. App.*, 192; *Colman v. Crump*, 70 *N. Y.*, 573—where the use of the device of a bull’s head was sustained as a trade-mark; *McLean v. Fleming*, 96 *U. S.*, 245;—which held the right to use the name of “Dr. McLean’s Liver Pills” to be one which should be protected; *Newman v. Alword*, 49 *Barb.*, 588). The principles sustained by these and other cases, has been so far extended as to include other devices adopted for the purpose of distinguishing one person’s business and the commodities in which he may deal, from those of others. (*Glen Manufacturing Co. v. Hall*, 61 *N. Y.*, 226). And it has also been applied to the protection of the rights of the publisher in the title to newspapers, books and pamphlets.

In *Bell v. Locke*, (8 *Paige*, 75), its application to the publication of a competing newspaper was considered, and the injunction denied only because the title of the defendants’ paper was so clearly distinguishable from that of the plaintiff’s as not to be calculated to mislead, or deceive the public. A similar point was considered in the case of *Clement v. Maddock*, (1 *Giff.*, 98), where the defendant was prevented, by means of an injunction, from selling a publication bearing substantially the same title as one made by the plaintiff. In *Mack v. Potter*, (*Law R.*, 14 *Eq.*, 431), the same principle also was applied. There the title of the plaintiff’s book was that of “*Birthday Scriptural Text Books*,” while the defendant published his work under the title of “*Children’s Birthday Text Books*,” and the latter was held to be so clearly an appropriation of the title previously applied to the publication of the plaintiff’s work, as to be the proper subject of restraint, by means of an injunction. The same point was considered in *Bradbury v. Dickens*, (27 *Beav.*, 53), where it was held that the title of “*Household Words*” given to a magazine was property, and for that reason the subject of a sale, under an

order of the Court of Chancery. While, therefore, the plaintiffs' book itself may be published in case it has not been copyrighted,—which is a subject over which this Court has no jurisdiction—the title given to it cannot be appropriated, and used by the defendants. That they have used the same title has been denied by the defendants, but it is very evident from the affidavits read on the part of the plaintiffs, and the books themselves, that they are not correct in this denial. An inspection of the books discloses the facts that they are published substantially in the same form so far as general appearance, binding, and color of the covers are concerned; and upon the cover of the defendants' book the phrase “National System of Penmanship,” which has long been the title of the plaintiffs' publication, is printed in the same manner, the same size and forms of letters, and occupying the same position as they do upon the cover of the plaintiffs' book. The resemblance of the words and letters composing this phrase is as complete as it could well be made, and from the identity of the contents of the books, their size, and general appearance, the conclusion seems to be well warranted, that they could not in that manner have found their place upon the defendants' book, unless it was the result of design upon their part to imitate the plaintiffs' book.

4. They have claimed that, even if this were so, the difference between the title-page of their book, and that of the plaintiffs, is such as to prevent the use of this descriptive phrase from misleading purchasers, and it is conceded by the plaintiffs that that would be the case as to persons engaged in the trade and purchasing books, for the purpose of afterwards selling them. But that the one would not be readily purchased as the publication of the other by a person buying the work for use, is denied, and the contrary of this is asserted to be the truth. In order to render it necessary that a publication or imitation of this nature should be restrained, it is sufficient that persons who may desire to purchase the plaintiffs' publication, might very well accept that of the defendants, supposing and believing it to be the same. That the difference might be readily detected by a comparison of one book with the other, is not sufficient to allow the defendants

to appropriate and use the plaintiffs' title. If in its use, persons under ordinary circumstances, desiring to purchase one, would receive the other in its place, believing that they had obtained the work intended to be bought, that will not only justify, but require the Court to interfere, for the purpose of preventing the use of the plaintiffs' title. This has been the principle by which the Courts have been governed in imposing restraints of this nature, and it is well sustained by the authorities already referred to, and also by the cases of *Williams v. Johnson*, (2 Bos., 1), and *Falkinburg v. Lucy*, (*Cox Am. Trade-M. Cas.*, 449).

Two of the defendants were in the employment of the plaintiffs, before they commenced business for themselves. In the course of that employment, they acquired a minute knowledge of the plaintiffs' business, including the extent and advantages of their sales of the book now in controversy. And when they applied to the imitation of the one published and sold by themselves, the name by which the plaintiffs' book had become extensively known in the market, it is to be inferred that it was done for the purpose of promoting their own interests, by inducing purchasers to believe that their article was the same as that they had previously been accustomed to buy. It could not have been transcribed from one to the other, by the same type, in the same form, and occupying the same relative position on the page, without design on the part of the defendants, and it is not reasonable to suppose that this design was either formed or executed without the expectation that they would derive advantages from the resemblance which it would give their book to that of the plaintiffs.

It is claimed by the defendants that this designation was of no value to the book, and that its omission would not have affected their sale. If that were the case, then why should this apparent effort have been made, to place the title of the one upon that of the other, in the identical manner in which it had so long been used by the plaintiffs? The fact itself, that it has been so used, is at variance with the truth of this statement.

Where such a simulated resemblance is found in the title made use of by one person to that previously used by another, long engaged in the same business, the inference is just and natural that

the motive for doing so is to acquire improperly the patronage and trade of the other, and no reason exists for excluding this case from the control of that presumption. The law does not allow one person in that manner to acquire the advantages in trade which may have been secured by the efforts and reputation of another, previously engaged in the same line of business. On the contrary, it will protect the party whose wares, commodities, or publications have become identified in the market, under any appropriate symbol, words, phrases or devices, from the appropriation and use of them by other and competing dealers, in the same description of property. It has been urged that the phrase "National System of Penmanship" could not be so exclusively appropriated by the plaintiffs and their predecessors, and the cases of *Taylor v. Gillies*, (59 *N. Y.*, 231), where it was held that the phrase "Gold Medal" could not be so appropriated; and *Canal Co. v. Clark*, (13 *Wall.*, 311), holding that the phrase "Lackawanna Coal" could not be exclusively used by one party so as to deprive another obtaining coal in the same nominal locality from making use of it, have been relied upon in support of this position. But they are manifestly different in their circumstances from the case which the Court is now required to decide. The phrase made use of by the plaintiffs is a combination of words not otherwise employed in this trade, and which appropriately express the publication made by them. Within the authorities already referred to, they are entitled to be protected in its enjoyment and use against the defendants in this case; and while the injunction, in other respects, should be vacated, so far as the use of the phrase "National System of Penmanship" is restrained, it should be sustained.

Order modified.

DAVIS, P. J., and BARRETT, J., concurred.

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COURT OF APPEALS, STATE OF NEW YORK.
IN EQUITY.

ALEXIS GODILLOT, RESPONDENT,*vs.*EDWARD C. HARRIS, ET AL., APPELLANTS,

DECIDED 1 JUNE, 1880.

REPORTED 81 N. Y., 263.

“Conserves Alimentaires” Case.

1. It is not essential to property in a trade-mark that it should indicate any particular person as the maker of the article to which it is attached; it may represent to the purchaser, the quality of the things offered for sale, and in that case is of value to any person interested in putting the commodity to which it is applied, upon the market, and he is entitled to protection in its use.
2. Plaintiff devised the ingredients of a vegetable compound which was manufactured and put up in Paris expressly for him, and was imported by him; sales were made in the names of third parties, but he was interested in the result. To designate the article, he prepared and had engraved and printed a label containing words designating the origin and the article itself, which he attached to the packages as a trade-mark. Defendants, after a market had been established for the

article, prepared and offered for sale substantially the same kind of goods, placing upon the packages a label so nearly like that of plaintiff's, that a buyer would be easily deceived. **HELD:**

That plaintiff had acquired the right to the exclusive use of the trade-mark, by its prior use and application, and this although the goods were manufactured for and not by him, and that an action restraining defendant from using the label was maintainable.

APPEAL from judgment of the General Term of the Superior Court of the City of New York, affirming a judgment in favor of plaintiff, entered upon a decision of the Court on trial at Special Term.

This action was brought to restrain the defendants from using plaintiff's trade-mark.

The complainant alleged and the Court found, in substance, that the plaintiff, for more than three years, had been engaged in putting up in packages of about one pound each, and importing an article known as "Julienne," a compound of various vegetables for making Julienne Soup, devised by plaintiff, upon which packages he had placed a label or trade-mark devised by him. The article was, as the Court found, manufactured and put up in Paris expressly for plaintiff.

The device consists of the words "Conserves Alimentaires," under which is the coat-of-arms of the City of Paris; upon either side of the monogram "A. G." in a circle, and underneath the words "Paris" and "Julienne," with directions for preparing for use and using.

The device adopted by the defendants is, in all respects, like the plaintiff's device, except the monogram is "F. G." In size, type, color and appearance, the two devices are alike; and the Court found "that the similarity of the two labels is such that the customers and patrons of the plaintiff are liable to be deceived." The judgment restrained defendant from further using their label, or one resembling plaintiff's upon such packages; and from selling or offering any for sale with such label upon them.

Hugh Porter, for appellants.

The right to a trade-mark can exist in him only who possesses an exclusive right to the property to which it is appended. (*Congress & Empire Spring Co. v. High Rock Congress Spring Co.*, 45 N. Y., 291; *Walton v. Crowley*, 3 Bl. Circuit Ct., 440, [U. S. Circuit Ct., N. Y.]; *Ferguson v. Davol Mills*, 2 Brewst., 314; *The Leather Cloth Company v. The Am. Leather Cloth Co.*, 23 L. J., [N. S.], Ch., 199, and *Cox's Am. Trade-Mark Cases*, 668; *Upton's Trade-Marks*, 25-30, both inclusive; *Collins v. Cowen*, 3 Kay & Johns., 428). Only two classes of persons in a community can become the owners of a trade-mark for an article of trade or commerce; the person who manufactures the article and the merchant who sells the article, and who has been vested by the manufacturer with the exclusive right to sell it. (*D. & H. C. Co. v. Clark*, 13 Wall., 311; *The Amoskeag Manufacturing Co. v. Spear*, 2 Sandf., [Sup. Ct.], 599; *Newman v. Alword*, 51 N. Y., 194; *Partridge v. Monck*, 2 Barb. Ch., 101; *Carmichael v. Labumer*, 5 N. Y. Weekly Dig.), 46; *Osgood v. Allen*, 1 Holmes, 185; *Dixon Crucible Co. v. Guggenheimer*, 2 Brewst., 321; *Upton's Trade-Marks*, 22, 23, 24). When under a mark or symbol which fails to indicate the plaintiff as either the manufacturer or vendor, an article of merchandise has acquired a favorable reputation, all persons dealing in such merchandise have an equal right to use such mark or symbol. (*Upton's Trade-Marks*, 95-103).

Nelson Smith, for respondent.

A person for whom goods are manufactured is entitled to protection in the use of the device or symbol which is invented and adopted by him to designate the goods which he sells thereunder. (*Amoskeag Manuf. Co. v. Spear*, 2 Sandf., 599; *Walton v. Crowley*, 2 Blatchf., 440). Even though the vendor had no direct relation to the manufacturer, he has a right to protection. (*Partridge v. Monck*, 2 Barb. Ch., 103; *Taylor v. Carpenter*, 2 Sandf. Ch., 603, 614; 11 Paige, 292). The property and right to protection in such case is not in the goods, but in the device or symbol adopted by the plaintiff. (*Wotherspoon v. Currie*, L. R.,

5 *H. L.*, 508). The plaintiff's label with the words, marks, pictures, symbols, and arrangement thereof, embracing his monogram, constituted a good trade-mark. (*Colman v. Crump*, 70 *N. Y.*, 753; *Taylor v. Carpenter*, 2 *Sandf. Ch.*, 603, 614; 11 *Paige*, 292; *Partridge v. Monck*, 2 *Barb. Ch.*, 103; *S. C.*, 1 *How. Ct. of App. Cases*, 547; *S. C.*, *Cox's American Trade-Mark Cases*, 72; *Morrison v. Case*, 9 *Blatchf.*, 548). A picture of a public building belonging to the State, or of a foreign nation, may be adopted as a trade-mark and will be protected. (*Brie v. Tarband, Browne on Trade-Marks*, secs. 258, 259, 262). The rule that there can be no right to the use of generic words, nor words merely indicating name or quality, only applies when the words are expressed in English; it has no application when the words used are in a foreign or dead language. (*Raggett v. Findlater*, *L. R.*, 17 *Eq. Cases*, 36; *Ford v. Forster*, *L. R.*, 7 *Ch. App.*, 611; 11 *Abb. L. J.*, 169; *Wotherspoon v. Currie*, *L. R.*, 5 *H. L.*, 508; *Braham v. Bustard*, 1 *Hem. & Mill.*, 447). A word which indicates a mere fancy name will be protected in favor of the person who first adopts it. (*Knott v. Morgan*, 2 *Keen*, 213; *Croft v. Day*, 7 *Beavan*, 85; *Mesrole v. Tynberg*, 4 *Abb.*, [*N. S.*], 410; *Newman v. Alword*, 49 *Barb.*, 588; *Rillet v. Cartier*, 11 *Abb.*, [*N. S.*], 186; *Carver v. Bowker, Sebastian's Trade-Mark Cases*, 581; *In re Rotherham*, *Id.*, 647; *S. C.*, 27 *W. R.*, 503). The moment a person has selected a symbol or device to indicate his mark, and applies the mark to his goods, the act is complete and his right consummated; no particular duration of time as to the user is necessary. (*Browne on Trade-Marks*, sec. 252; *Taylor v. Carpenter*, 2 *Sandf. Ch.*, 603, 614; 11 *Paige*, 292; *Partridge v. Monck*, 2 *Barb.*, 103; *S. C.*, 1 *How. Ct. App. Cases*, 547).

DANFORTH, J.:

We can discover no ground upon which the judgment in this case should be reversed.

1. It is not essential to property in a trade-mark that it should indicate any particular person as the maker of the article to which it is attached. It may represent to the purchaser the quality of the thing offered for sale, and in that case is of value to any per-

son interested in putting the commodity to which it is applied upon the market. This was the plaintiff's position. He was not the actual manufacturer of the "Julienne," but the trial Court found, and there is evidence to sustain the finding, "that it was manufactured and put up in Paris, expressly for him."

2. He devised the ingredients, and became the importer of the prepared article. To designate the substance, when so prepared for sale, he designed and had engraved and printed, a label, which he attached to the packages containing it. He was interested in the result of sales, and although these were made in the names of third persons, and not his own, his legal right to protection is the same. By any increase in the market demand for the commodity, he was benefited, and by every thing which either supplanted it or diminished the public estimate of it, he was a sufferer. The defendant subsequently offered for sale substantially the same kind of goods, and placed upon the packages a label very similar to that used by the plaintiff. It is in most respects a copy, and except upon close inspection seems to be literally a copy. The plaintiff's monogram "A. G." is omitted, but that of one of the defendants, "F. G." is put in its place. A purchaser having in mind the article he wanted would not notice the difference, while the crown and armorial bearings, representing the arms of the City of Paris, with the persuasive words, "conserves alimentaires," the word Paris designating its origin, and the word "Julienne" the thing itself, are identically the same. A buyer, however deliberate, would be easily deceived by the resemblance, and while the compound purchased might be equally as good as that of the plaintiff's, it is clear that the plaintiff would have lost the sale of his preparation, and so received injury. This is a very brief statement of the plaintiff's case, but it exists in the finding of the trial Court, and in the evidence. It is sufficient to warrant and require the judgment which has been pronounced. (*Hostetter v. Vowinkle*, 1 Dill. C. C., 329). The conclusion of the trial Judge has received the approbation of the Supreme Court, and is concurred in by us. It stands not only upon principle, but upon authority. The plaintiff acquired the right to the exclusive enjoyment of the trade-mark, not done by devising it, but "by its prior use and application in

the manner in which it has been imitated by the defendant." (*Walton v. Crowley*, 3 *Blatchf. C. C.*, 440), and this is so, although the goods were manufactured for him, and not by himself, for he had the same legal right to affix and maintain a special trade-mark in one case as in the other. (*Walton v. Crowley*, *supra*; *Amoskeag Manuf. Co. v. Spear*, 2 *Sandf.*, 599; *Taylor v. Carpenter*, 2 *Sandf. Ch.*, 614). To the same effect is the decision of this Court in *Congress Spring Co. v. High Rock Spring Co.*, (45 *N. Y.*, 291), where the rule laid down in *Amoskeag Manuf. Co. v. Spear*, *supra*, is cited and enforced.

I have examined the evidence contained in the case, and am satisfied that it maintains the findings of fact made by the trial Court. Nor do the cases cited by the learned counsel for the appellant support his contention that error was committed in the conclusions of law depending upon those facts. The defendants' claim in this matter seems to be without merit. They appear to have deliberately invaded the plaintiff's right, and the latter to be clearly entitled to the relief which has been given to him by the judgment appealed from. I think it should be affirmed with costs.

All concur.

Judgment affirmed.

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IN THE COURT OF COMMON PLEAS, NEW
YORK CITY. IN EQUITY.

HEGEMAN & CO., APPELLANTS,

vs.

THOMAS & O'BYRNE, RESPONDENTS.

DECIDED 7 JUNE, 1880.

REPORTED 9 DALY, 264.

"Eagle and Mortar" Case.

The plaintiff had a right of trade-mark in a symbol which consisted of an eagle with outstretched wings, perched on a mortar, in which rested a pestle, which device was used upon labels for medicinal purposes and other articles. **HELD:**

That the use of this symbol by the defendant, as a prominent feature of labels for similar preparations and articles, was an infringement of the plaintiff's rights, although another name appeared conspicuously upon such labels instead of the name of the plaintiff, and notwithstanding the fact that symbols of a similar nature were shown to be in general use by druggists and apothecaries for purposes of ornament.

APPEAL from the judgment of this Court, entered upon findings of a Judge on a trial without a jury.

The action was brought to restrain an alleged infringement by the defendant of a right of trade-mark claimed by the plaintiff. The facts are stated in the opinion of LARREMORE, J. Upon the trial before the Court without a jury, the Judge found for the defendant, and directed that the complaint be dismissed upon the merits, and judgment for the defendant was entered upon his findings.

Geo. F. Betts, for appellant.

James M. Fisk, for respondent.

LARREMORE, J.:

It was not disputed upon the trial that the firm of which William Hegeman was a member, had for many years used as a symbol or trade-mark upon the label affixed to its preparations "an eagle with outstretched wings, perched upon a mortar in which rested a pestle." Nor was it denied that in March, 1878, the corporation of Hegeman & Co., the plaintiff, was formed pursuant to the statute in such case made and provided, and that it acquired by sundry assignments all the property and effects of said firm, including the good-will of said firm, and all its right, title interest in and to all trade-marks, preparations, labels and proprietary interests belonging to said firm. It also appeared that said trade-mark was recorded in the Patent Office of the United States pursuant to law, and duly registered therein, whereby the plaintiff claims a right to the exclusive use of the same for the period of thirty years, from December 4, 1877, the date of such registration.

The plaintiff in its complaint alleges that the defendant, knowing the premises and in utter disregard thereof, has wrongfully and fraudulently prepared and offered for sale medicinal preparations and other articles with intent to deceive and defraud the public, and the buyers and consumers thereof, and has caused to be attached thereto, a label very similar to the plaintiff's, and containing thereon an imitation of its trade-mark, for which it asks damages and prays an injunction. The defendant claims that plaintiff never had any exclusive right to said trade-mark, as the

same had been and was in general public use by druggists prior to such registration; that on or about February 24, 1876, the said firm of Hegeman & Co., sold and assigned to one Joseph H. Collins the drug store owned by said firm, at No. 399 Broadway, including the fixtures, and the right to sell medicines and packages bearing the alleged trade-mark; and that the defendant has succeeded to and become lawfully possessed of all the rights of said Collins in the premises. Issues were joined and tried, and the complaint was dismissed. Judgment was rendered in defendant's favor, and plaintiff appeals.

The learned Judge who tried the cause placed his decision squarely upon the ground that there was no simulation of the trade-mark, and consequently that there was no attempt or design to deceive the public on the part of the defendant. He bases his conclusion upon *Singer Manuf. Co. v. Wilson*, (16 *Moak Eng.*, 846, 847), and deduces therefrom the proposition that by reason of the conspicuousness of Collins' name upon the labels affixed to his preparations no one could be misled or induced to believe that a sale of another article or preparation was intended. The case upon which he relies was reversed by the House of Lords (38 *Law T. Rep.*, 303), and the question involved is relegated to the authorities by which we have hitherto been controlled. These are so numerous and so well understood that the mere citation of a few of them will suffice for our present purpose. *Witherspoon v. Currie*, 5 *H. of L.*, 508; *Rose v. Loftus*, 38 *Law T. Rep.*, 409; *Millington v. Fox*, 3 *Mylne & C.*, 338; *Lea v. Wolf*, 13 *Abb. Pr. U. S.*, 390; *Colman v. Crump*, 70 *N. Y.*, 573.

Independent of plaintiff's right acquired by the registration, how stand the facts as disclosed by reputable witnesses on the trial? The plaintiff's testimony shows that for many years the symbol hereinbefore described had been used by the firm of Hegeman & Co., or its assigns, as a trade-mark in nearly all their preparations. Collins, in his testimony, assumes this fact, and claims an assignment of the trade-mark for his benefit. But the sales and assignment to him conveyed no such right. The subsequent user by him and his vendee derives no warrant of authority

from the purchase of the store fixtures and good-will of the premises No. 399 Broadway.

Contrasting defendant's testimony with this, the case is shorn of its fair proportions. Admitting that the symbol ornamented the doors of druggists and apothecaries, the question remains, what right had defendant to its use upon the label of his preparations? The line of his testimony in this respect was unsatisfactory. If he had nothing to gain by the use of "an eagle with outstretched wings, perched upon a mortar in which rested a pestle," why did he use it? He could have invented and constructed a new device, to which (as he claims) the name of Joseph A. Collins as an *addendum* would have been a sure passport to success. Distrusting, however, the use of that name alone as a surety, he employs plaintiff's symbol to further his object.

Upon the proofs and specimens presented it is apparent that the defendant has simulated the plaintiff's trade-mark and should be enjoined from its further use, and that the judgment appealed from should be reversed and a new trial ordered, with costs to abide the event.

VAN BRUNT, J..

The finding of the learned Judge who tried this cause in the Court below established a common-law right of trade-mark in the plaintiffs to the symbol alleged to be simulated by the defendants. His finding, however, that the label used by the defendants is in no respects an infringement of the right of the plaintiffs in their trade-mark does not seem to me to be supported by the evidence as presented in the case.

As the labels are there shown, the most prominent feature upon both is the eagle with outstretched wings, perched upon a mortar in which rests a pestle, and it is this device which would be the first to attract the attention of any purchaser.

Pictures are much longer retained in the mind than words, and a purchaser who had entirely forgotten the words upon a label will remember the device displayed thereon, and seeing the same device upon the label upon an article he will take it for granted that it is the same.

I think that the use of the symbol in the manner in which the defendants make use of it upon their trade-mark is a clear infringement of the plaintiff's rights.

Judgment should be reversed, new trial ordered, costs to the appellant to abide the event.

Judgment reversed, and new trial ordered, with costs to abide event.

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SUPREME COURT OF IOWA. IN EQUITY.

SHAVER*vs.*SHAVER, ET AL.

DECIDED 21 JUNE, 1880.

REPORTED 54 IOWA, 208.

“Shaver Wagon” Case.

TRADE-MARK.

1. PROTECTION OF.—JURISDICTION.—Courts of Common Law and of Equity will, in the absence of any statute upon the subject, protect the proprietor of a trade-mark in its exclusive use.
2. REQUISITES OF.—The exclusive right to a trade-mark is acquired by its use, which the law does not require shall be continued for any prescribed length of time.
3. ILLEGAL USE OF.—The use, by another, of a trade-mark used to indicate the quality of an article sold, though placed on articles of equally good quality, and without any intention to defraud either the proprietor or the public, will be restrained by a Court of Chancery, and this, although it is not copied with the fullest accuracy, if the copy is calculated to deceive and may be taken for the original.

4. RULES APPLIED.—Where the plaintiff, who was a manufacturer of wagons for sale, had uniformly for some years painted upon the sides of the wagons made by him, the words “Shaver Wagon, Eldora,” it was HELD, that the painting of the same words upon wagons made and offered for sale by the defendants, in the same general style as those upon plaintiff’s wagons, was an infringement of his rights, which would be enjoined by a Court of Equity.

APPEAL from Hardin Circuit Court.

E. W. Eastman, W. V. Allen and Brown & Bindford, for appellants.

Porter & Moir and Huff & Reed, for appellee.

Action in Chancery to enjoin defendants from the use of a trade-mark. Upon the final hearing, a decree was entered granting the relief sought in plaintiff’s petition. Defendants appeal. The facts of the case appear in the opinion.

BECK, J.:

I. Counsel for defendants maintain that the right to the exclusive use of a trade-mark, by the person first adopting it, is not recognized by the common law, and that, in the absence of statutes, the Courts will not afford relief to the person injured, by awarding damages for the unauthorized use of the trade-mark, or restrain, by injunction, such use. This position finds no support in the books. For three hundred years the common law has recognized the right of the proprietor of a trade-mark to its exclusive use, and has awarded damages for the deprivation of such use. *Southern v. How, Popham (King’s Bench)*, 143-4.

The right has been, without interruption, recognized and protected by the Courts of England and the United States from that day to the present, in the absence of statutes declaring the existence of such right, or providing regulations for its exercise, and remedies for its deprivation. Many cases involving the subject have been decided by the Courts. They are too numerous to be cited here. For a collection thereof see *American Trade-Mark Cases*, by Rowland Cox.

The jurisdiction of Chancery to restrain the use of a trade-mark, without the consent of the proprietor, was first recognized at a later day. In 1742, Lord Hardwicke denied it, (*Blanchard v. Hill*, 2 *Atkyns*, 484), but within the last fifty years it has been repeatedly exercised in England and in this country. I have not found an American case denying it.

It has been expressly held that the right to the exclusive use of a trade-mark, where statutes exist regulating and protecting it, does not depend upon such statutes. *Derranger v. Plate*, 29 *Cal.*, 292; *Filley v. Fassett*, 44 *Mo.*, 173.

Using the language of Ames, Chief Justice, in *Barrows v. Knight*, 6 *R. I.*, 434, we conclude that "it never could have been a question that a designed imitation by the defendant of the trade-mark of the plaintiff, whereby the former fraudulently passed off his goods in the market as goods manufactured by the latter, and to his injury, would support an action."

We may express with equal positiveness the conviction that the rule is firmly settled that Chancery will, in a proper case, by injunction, protect the proprietor of a trade-mark in its exclusive use.

II. Chancery affords protection to the exclusive use of a trade-mark upon the ground of the injury sustained by the proprietor when it is appropriated by another, and of the fraud and deception practiced upon the public. The law will never fail to protect a citizen in the enjoyment of the fruits of his industry and enterprise. When through these he has acquired a reputation which brings him trade and patronage, he is entitled to its benefits as fully as to the enjoyment of property acquired in the same manner. The means and instruments he adopts to indicate to the public his place of business and the goods he manufactures and sells, whereby trade is acquired, cannot be appropriated by another. The people who have bought his goods and given him patronage, or who have a knowledge of the reputation he has acquired in his business, and, therefore, desire to purchase the articles he manufactures and sells, ought not to be deceived and induced by fraud to trade with another. Chancery will restrain the injury to the trader and public by such fraudulent acts.

III. We will briefly state certain principles and rules pertaining to the subject of trade-marks, which, in our opinion, are applicable to the case before us.

2. A trade-mark is a name, sign, symbol, mark, brand, or device of any kind, used to designate the goods manufactured or sold, or the place of business of the manufacturer or dealer in such goods. The exclusive right in a trade-mark is acquired by its use, which the law does not require, shall be continued for any prescribed time.

3. IV. The trade-mark is often intended to indicate the quality of the goods, and it is unlawful to appropriate it to indicate goods of a quality equal to those manufactured or sold by its proprietor. *Taylor v. Carpenter*, 11 *Paige*, 292; *Coats v. Holbrook*, 2 *Sandf. Ch. R.*, 586.

V. The use of a trade-mark ignorantly or innocently, with no intention to defraud or deceive the proprietor or the public, will be restrained by Chancery. *Millington v. Fox*, 3 *Mylne & Craig*, 338; *Cartier v. Carlisle*, 31 *Beavan*, 292.

VI. In order to authorize the interference of Chancery, it is not necessary that the trade-mark should be copied with the fullest accuracy. An imitation which varies from the original, in some particulars, will be restrained. The rule is, that if the imitation is calculated to deceive and may be taken for the original, its use will be restrained. *Filley v. Fassett*, 44 *Mo.*, 173; *Boardman v. The Meriden Britannia Co.*, 35 *Conn.*, 402; *Falkenburg v. Lacy*, 35 *Cal.*, 52; *Woodward v. Lazer*, 21 *Cal.*, 448; *Seixo v. Provezende*, L. R., 1 *Ch. App.*, 192; *Witherspoon v. Carrie*, S. R., 5 *Eng. and Irish App.*, 508; *Bradley v. Norton*, 33 *Conn.*, 157; *Davis v. Lendall*, 2 *R. I.*, 566.

In support of the doctrines we have above stated, see the cases cited in the notes in 2 *Hilliard on Torts*, p. Ch. 2, et seq.; 2 *Story's Eq. Jurisp.*, (Eleventh Ed.), sec. 951; *High on Injunctions*, chap. XVI; *Addison on Torts*, (Fourth Ed.), p. 874, et seq., and many decisions collected in *American Trade-Mark Cases*, by Rowland Cox.

4. VII. We are now required to determine the facts of the case before us, which we find to be as follows: The plaintiff has been

for many years engaged in the manufacture of wagons at Eldora. His business has never been extensive, and his sales are largely confined to the county in which he lives. The business, for a time, was prosecuted by copartnerships composed of plaintiff and the defendants, his brothers, and another person. Upon dissolution of these copartnerships, plaintiff continued the business and acquired all the property of the firm. For several years the plaintiff conducted the business on his own account, and some time before his brothers had commenced business for themselves, they had been employed by plaintiff. In 1874, plaintiff adopted as a trade-mark the words, "Shaver Wagon, Eldora," which was at first, with some variation in form, painted conspicuously on all wagons manufactured and sold by him. He adhered to a general style of work and painting, and his trade-mark for the last few years has been painted upon his wagon in substantially the same form and manner. The defendants, more than two years after they ceased to be copartners of plaintiff, commenced the manufacture of wagons and painted thereon the identical words used as a trade-mark by plaintiff. They changed somewhat the form of inscribing the words, and painted their own initials near the trade-mark. The wagons in general style, and in painting, resembled those manufactured by plaintiff, and were not inferior thereto. They did but little at the business before this suit was commenced, constructing and selling but one or two wagons.

We are clearly of the opinion that the trade-mark of plaintiff is used by defendants with so little variation that their wagons would be readily taken to be of the manufacture of plaintiff. The imitation used by defendants, we have no doubt is calculated to deceive customers, and thus defraud them and injure and defraud plaintiff. Applying the doctrines we have above announced, we are of the opinion plaintiff has made out a case calling for the interposition of the power of equity to enjoin defendants from the further use of his trade-mark.

VIII. It is said that plaintiff is not entitled to the relief he claims, for the reason that defendants, before the suit was commenced, had made but one or two wagons. But this objection is completely answered by the consideration that defendants, in their

pleadings, admit the use of the trade-mark, in the manner we have above stated, and, as we understand the records, have continued to use it since the suit was commenced, and claim that they have a right so to do. They propose to continue its use. Under these circumstances, equity will restrain their further use of plaintiff's trade-mark.

IX. The Court below excluded evidence offered by defendants tending to establish the following facts:

That the "scroll work" upon which plaintiff caused his trade-mark to be painted, was generally used in painting wagons; that plaintiff had never called the words, "Shaver Wagon, Eldora," his trade-mark, and had not instructed his partner to put it on; that the wagon sold by defendants was disposed of without regard to the trade-mark; that the painting of defendants wagons is readily distinguishable from that of the plaintiff's, and that they are different in size; that defendants' wagons were not sold because of any notoriety on account of the trade-mark, and that defendants had not sought to increase their sales by means of the trade-mark.

When it is remembered that the gist of the action is the use of plaintiff's trade-mark and not the imitation of the wagons he constructed; that no formal act or declaration is necessary in order to adopt a trade-mark which rests upon use alone; that if defendants, without fraud and innocently, used plaintiff's trade-mark, when these things are remembered, it will be readily seen that the proposed evidence was correctly excluded. It may be further remarked, that if defendants honestly expected no advantage in the sale of their wagons by the use of the trade-mark, they would not have attempted to appropriate it, and would not tenaciously cling to its use at the expense of a law suit. If, as they say, it is a matter of so little importance, they have acted a very unwise part in incurring so much expense in efforts to establish their right to use plaintiff's trade-mark.

In our opinion, the decree of the Court below is in accord with the law and facts of the case. It is, therefore,

Affirmed.

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UNITED STATES CIRCUIT COURT, NORTHERN
DISTRICT OF ILLINOIS. SPECIAL TERM. IN
EQUITY.*

THE ROYAL BAKING POWDER COMPANY

vs.

PETER G. MCQUADE AND MARVIN S. MORRIS.

DECIDED 12 JULY, 1880.

“Royal Baking Powder.”

Action brought to restrain defendant from using the word “Loyal” to denote a brand of “Baking Powder.” **HELD:**

1. That the word “Loyal” was substantially *idem sonans* with the word “Royal,” and when rapidly spoken by people not accustomed to the nice distinction of speech, they might be taken for the same word.
2. The adoption of a label which in colors, in its design and collocation of the letters, and even of the vignette and in all the characters which strike the eye, is so identical with that of the plaintiff, that it confirms the impression which would be created by the use of the general name, or generic term, that there was an intention on the part of the manufacturer of defendant’s goods, to avail himself of the reputation of the plaintiff.

* Not reported.

3. The class of persons who would naturally be sent to a grocery store to buy this class of goods, would be such as might be imposed upon readily by the similarity of these two names.
4. Injunction ordered until the hearing of the cause, and until the further order by this Court.

THIS was an action brought to restrain the use by the defendants of a label containing the word "Loyal" to denote a brand of baking powder, on the ground that it was a palpable imitation of complainant's trade-mark "Royal."

OPINION.

BLODGETT, J..

I think that it is very manifest there was an intention on the part of the manufacturer of this, the defendants', powder, to obtain the benefit of whatever labor and effort the complainant has used to give reputation and character to his goods.

1. There is the adoption, in the first place, of a word which is substantially *idem sonans* with the word "Royal." The words are not, of course, precisely the same, but when rapidly spoken by people not accustomed to notice the nice distinctions of speech, they might be taken for the same word.

2. There is also the adoption of a label which in colors, in its design, and collocation of the letters, and even of the vignette, and in all the characters which strike the eye, is so identical with that of the plaintiff, that it confirms the impression which would be created by the use of the general name, or generic term; that there was an intention on the part of the manufacturer of defendants' goods to avail himself of the reputation of the plaintiff. It is true that the defendants have announced on the face of their label that this is not the "Royal," but that is in a place where it would perhaps be the last thing that would be read, and that after the goods had been obtained and paid for, and it is after all a reservation which would avail the defendants nothing. It is an explanation which comes too late in the transaction to really exculpate the defendants. The make-up generally of the package is so similar, and the imitation of the name is so similar, as to create naturally, and be calculated to create, the impression upon

people who are not particular in reference to terms, that they were buying the "Royal" when they were buying the "Loyal."

3. The class of persons who would naturally be sent to a grocery store to buy this class of goods would be such as might be imposed upon readily by the similarity of these two names.

DECREE.

And now on this day comes the complainant by Dexter, Herreck & Allen, its solicitors, and moves the Court to grant a writ of injunction pursuant to the prayer of said bill, and thereupon said motion coming on to be heard on the bill, and affidavits filed herein, and the complainant appearing by its solicitors, and the defendant by Charles E. Pope, his solicitor, and it appearing to the Court that the defendant Morris has been served with notice of said motion, and the Court having heard the arguments of counsel, and being fully advised in the premises, duly order that * * * * an injunction be awarded to restrain the defendants, Peter G. McQuade and Marvin S. Morris respectively, and each of them and the respective servants, agents and workmen of the said defendants and every and each of them, from affixing or causing to be affixed to any cans, boxes or packages containing baking powder or other compounds manufactured for or bought, procured or sold by them, or otherwise using or employing, or causing, or permitting to be used or employed any label or labels having thereon the word "Loyal," like the labels attached to exhibits "C," "H," and "I," in said bill mentioned, or any label or labels similar to or colorably differing from the labels made or used by the complainant as in the complainant's bill mentioned, or so contrived and prepared as to represent or lead to the belief that the baking powder or other compound manufactured or sold by the defendants is the manufacture of the complainant; and also from selling, consigning or otherwise disposing of any baking powder, or other compound, in cans, boxes or packages having or bearing thereon any such label or labels as in the said bill mentioned, or any labels only colorably differing from said labels of the complainant, until the hearing of this cause, and until the further order of this Court.

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COURT OF COMMON PLEAS, PHILADELPHIA.
IN EQUITY.

WHITE

vs.

SCHLECT.

DECIDED 17 JULY, 1880.

REPORTED 14 PHIL., 88.

“Drum Collar” Case.

1. An injunction will be dissolved where the plaintiff has slept upon his rights for more than a year after it was granted, and has not prosecuted the case further.
2. Where the bill disclosed no other title than an assignment to plaintiff of a registered trade-mark, which registry has since been declared void as based on unconstitutional legislation, and the answer sets up a total denial of originality or appropriation by the registered owner, and alleges common use of the symbol for eight years in the same manner by defendants and others, the injunction will be dissolved.
3. HELD, that a trade-mark, to be valid, must indicate the *true origin or ownership* of the goods on which it is used, and that a mere device of of a “drum,” without more to identify it with its proprietor. does not confer on plaintiffs the exclusive right of appropriation, and the bill

will be dismissed for want of title; following *Davol Mills*, 7 *Phila.*, 253, and *Dixon v. Guggenheim*, 7 *Phila.*, 408. The doctrine of *Sheppard v. Stewart*, 13 *Phila.*, 117, dissented from.

4. It is the settled doctrine of the Courts of England as well as America's, that a special injunction will be dissolved upon the coming in of an answer or affidavits denying the equities of the bill.

Thomas J. Diehl, Esq., for plaintiff.

Pierce Archer, Esq., for defendant.

ALISON, P. J..

A special injunction was granted in this case to restrain the defendant in the use of a device or design as a trade-mark, to which plaintiff claimed to be entitled by assignment to him by Edward J. Frost, who claimed to be the inventor, and to have first appropriated it to paper boxes, in which were put up for sale paper collars, having on the outside a representation of a "drum," which trade-mark was known in the market as indicating the "drum collar." This device of a drum constituted the trade-mark, to the exclusive use of which plaintiff claimed to be entitled, and that the right was to him a valuable one, which was infringed by the defendant. The claim of Frost, from whom plaintiff derives title, is made to rest mainly, so far as the right is disclosed by the averments of the bill, upon the registration in the Patent Office of the United States of the said trade-mark, and a certificate issued to him by the Commissioner of Patents, on the 5th day of December, 1876, which protected the same for a period of thirty years. The Act of Congress authorizing the issuing of such certificates has, since the granting of the special injunction, been declared to be unconstitutional by the Supreme Court of the United States, and we are therefore to look to the remaining portions of the bill as disclosing grounds for equitable protection by special injunction, in order to properly decide the question which is now before us on bill and answer, on the motion of the defendant to dissolve the special injunction. An examination of the bill discloses no other averment of title, except the alleged assignment of Frost, by virtue of the aforesaid certificate. The claim to priority of invention and appropriation is nowhere distinctly asserted, and rests chiefly

on the inferences to be drawn from the fact, that claiming to be the inventor and appropriator of the trade-mark, the said certificate was issued to Frost in due form of law, which the plaintiff claims established *prima facie* his right to the exclusive use of said trade-mark.

The affidavits of Frost and others, which were considered on the motion for the special injunction, fully warranted the granting of the order, which defendant now claims should be set aside; these affidavits have, however, spent their force, and on the motion to dissolve the injunction on the coming in of the answer, the motion is to be granted or denied upon this ground, or the sufficient or insufficient denial of the equity of the bill; a special injunction being always granted until answer or further order. The answer, after setting up that the only claim of the plaintiff, according to the registered letters, was "essentially of the representation of a drum," having no name, description, symbol or letters, indicating the plaintiff or any one else as the owner, proprietor or designer thereof, and that all the boxes issued by the plaintiff bear the name of the "Franklin Collar Company, Philadelphia," and no other name.

The answer asserts that an examination of the claim as registered shows nothing but a claim for the mere figure of a drum, and that said device or symbol of a drum had been in common use, in various trades and businesses, for forty-five years, and in the collar trade for eight years, and that the plaintiff has not the exclusive right to said drum device; that it did not originate with him; he did not put his name on it at any time, and that it was in common use for about three years before the registration by Frost.

This substantially denies the claim of Frost to the invention or appropriation of the device of a drum, as a cover for paper collar boxes, and it asserts that it was in use in the collar trade as far back as 1871.

It is laid down in *Carpenter v. Burden*, 2 *Parsons' S. E. Cases*, 24, that it is the universal practice of a Court of Chancery, on an affidavit or answer under oath by the defendant, denying the facts and the equity in the bill on which it was granted, to dissolve the

injunction. Nor can counter affidavits of the plaintiff, sustained by many other witnesses, prevent it; nor will they be received, except in certain cases, clearly pointed out in equity practice. Judge King cites from *Clapham v. White*, 8 *Vesey R.*, 34, the statement of Lord Eldon that if the answer denies all the circumstances upon which the equity is founded, the universal practice, as to the purpose of dissolving or reviving an injunction, is to give credit to the answer. The Chancellor further remarked, save in a few excepted cases, though five hundred affidavits were filed, not one could be read by the plaintiff.

In *Poor v. Charleton*, 3 *Sumner*, 75, Mr. Justice Story questions the principle referred to, and says he would be sorry if any such practice had been established, and that after answer, the question of dissolving an injunction is addressed to the sound discretion of the Court. But even the great authority of Judge Story cannot overthrow a principle, and the practice founded on it, for time out of mind. The authorities cited in note to *Daniel's C. P.*, vol. 3, p. 1831, edit., 1846, show how firmly the practice is established in this country. Under the English practice the rule is almost universal.

It is also laid down by *Daniel*, at page 1831, that when an injunction is continued, the cause in equity ought to be prosecuted; if it is not, and the Court is satisfied that there is any intentional delay on the part of plaintiff, the injunction will be dissolved. By *Lord Bacon's 24th ordinance* it is provided, that if no prosecution is had for the space of three terms, the injunction shall fall of itself without further motion. Under the English practice it is usual to move that the bill be dismissed for want of prosecution, and this, if successful, carries with it the special injunction. This special injunction was granted more than a year ago.

1. Since that time plaintiff has slept. Judge Butler, of the United States District Court, recently dissolved a special injunction upon this ground, holding that the delay on part of plaintiff for a year and over, required that the injunction should fall.

But we also hold that this injunction ought not to stand, under the authority of *Davol Mills*, 7 *Phila. R.*, 253, and *Dixon v. Guggenheim*, 7 *Phila. R.*, 408.

2. The syllabus of the last named case, which was decided by Judge Paxson, is, that a trade-mark adopted by a manufacturer or merchant for his goods, to be clothed with the attributes of property, entitling the appropriator to protection in its exclusive use, must designate the true ownership or origin of the goods. The same principle had previously been asserted in the case of Davol Mills, which case does not seem to have been called to the attention of Judge Paxson, when he wrote his learned and able opinion in *Dixon v. Guggenheim*, but in which the same doctrine is most clearly held. We have no reason to change our view of the law as previously expressed, notwithstanding the opinion of Judge Finletter, in *Sheppard v. Stewart*, 13 *Phila.*, 117, maintaining a contrary doctrine. We prefer to stand by the former decisions of the Common Pleas upon this point.

This device of a drum does not indicate ownership or origin, and falls under the statement of the true doctrine, in *Stokes v. Sandgraff*, 17 *Barb.*, 608, by Chief Justice Duer, decided by the Superior Court of New York City, that the use of the words "Club House" to designate gin imported from Holland, did not confer on plaintiffs the exclusive right of appropriation, because the term thus applied did not indicate origin, ownership or place of manufacture, or that the commodity was sold by the plaintiffs.

Without elaborating this principle further, we dismiss the bill, and this order carries with it of necessity the dissolution of the special injunction.

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IN THE UNITED STATES PATENT OFFICE.

EX PARTE FARNUM & CO.

DECIDED 9 AUGUST, 1880.

REPORTED 18 O. G., 412.

“Lancaster and a Rose.”

1. As a rule geographical names cannot be allowed registration as trade-marks.
2. DICTA, FRAUD.—Undoubtedly Courts of Equity have granted injunctions to restrain the fraudulent use of words of this character; but the grounds of such decisions have been invariably, I think, the fraud of the defendants, and not any exclusive right of the plaintiff. Examples quoted, *C. D.* 1872, *p.* 128; *Newman v. Alvord*, 49 *Barb.*, 588; *Brooklyn White Lead Co. v. Masaury*, 25 *Barb.*, 416.
3. Before any geographical name can be said to be registrable, it must clearly appear that the place of that name is such a one that the word will be understood by the general purchasing public as primarily fanciful, and that manufacturers of like goods at such place, cannot so mark their wares and claim the protection of our laws.
4. The essential features of a trade-mark are those only which serve in whole or in part to distinguish the goods of the party by whom such mark is adopted, and it is not proper that any thing should be described as essential which the Courts would hold otherwise.

5. Words calculated to deceive the public as to the place of manufacture, should not be allowed registration.
6. The word Lancaster refused registration although accompanied by a rose, and although the rose by itself was held to have been a proper symbol for registration.

APPEAL from Examiner of Trade-Marks.

TRADE-MARK—Tickings.

Messrs. A. H. Evans & Co., for the applicants.

MARBLE, *Commissioner* :

Applicants in this case seek to register as a trade-mark for ticking the word "Lancaster," accompanied by the symbolical representation of a rose.

As this case was presented in the first instance the word alone was described and claimed as constituting the one essential feature of the mark ; but the registration having been refused by the Examiner upon the ground that this word was geographically descriptive, an amendment to the application was made, and the symbolical representation of a rose was also included. This amendment was held by the Examiner not to relieve the case of the previous objection, and from his unfavorable decision upon this point the present appeal has been taken.

Counsel for applicants, in support of their appeal have urged that the action of the Examiner is erroneous for the reasons (1) that it is inconsistent with the previous practice of the Office, the word "Lancaster" being a proper trade-mark, and (2) that, even admitting that the word alone is not properly registrable, this objection is avoided by the use in connection therewith of the arbitrary symbol of a rose.

It might not be necessary, perhaps to consider the first of the above points, did not the numerous cases referred to by counsel in their brief, convince me that the Office practice relative to the granting of certificates of registration for trade-marks, in which words having geographical signification occur, has been neither

uniform nor, in my judgment, in accordance with the plain requirements of the statute. The fact, however, that such practice has prevailed can afford no warrant for its continuance or its application to the present case. (*Ex parte Lawrence & Co.*, 10 O. G., 163). Section 4937 of the Revised Statutes indicates as the proper parties to receive certificates of registration such persons only as "are entitled to the exclusive use of any lawful trade-mark," and section 4938 prescribes as a condition precedent to such certificate a declaration of the party seeking the same "that no other person, firm, or corporation has a right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive." From these extracts it must appear that the veriest essential of a valid trade-mark is the exclusiveness of the right of the user. It is not attempted in the statutes to indicate specifically all the classes of marks to which exclusive use cannot attach, but in the next section (section 4939) it is prescribed that "the Commissioner of Patents shall not receive and record any proposed trade-mark which is not and cannot become a lawful trade-mark," and the determination of this question must be reached from the consideration of the decisions in which it has been the subject of adjudication. It is not necessary, nor do I propose, to discuss at this time the broad question as to what may constitute a valid trade-mark, nor need the decisions bearing upon this question be referred to, except in so far as they relate to the use as trade-marks of geographical terms.

The manifest office of a trade-mark is to indicate to the public the origin or ownership of the goods to which such mark may be attached, and unless it is of such a character that it can accomplish this end it must logically follow that it cannot be said to constitute a proper trade-mark. The wrong done by the infringement of a trade-mark consists in one party falsely representing his wares as those of another, thus not only injuring the party whose mark has been so adopted, but also perpetrating fraud upon the public. (*Amoskeag Manuf. Co. v. Spear*, 2 Sandf., 599). When, therefore, a party using a mark appropriated by another can be said to be guilty of no misrepresentation in so doing he must be held to have an equal right to the use of the same. The

Supreme Court, in the leading case of the *Canal Co. v. Clark*, (1 O. G., 279), has fully discussed this question. Justice Strong in delivering the opinion of the Court, uses the following language :

“No one can claim protection for the exclusive use of a trade-mark or trade-name which would practically give him a monopoly in the sale of any goods other than those produced or made by himself. If he could, the public would be injured rather than protected, for competition would be destroyed. Nor can a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, be employed as a trade-mark and the exclusive use of it be entitled to legal protection. * * * And it is obvious that the same reasons which forbid the exclusive appropriation of generic names or of those merely descriptive of the article manufactured, and which can be employed with truth by other manufacturers, apply with equal force to the appropriation of geographical names designating districts of country. Their nature is such that they cannot point to the origin (personal origin) or ownership of the articles of trade to which they may be applied. They point only at the place of production, not to the producer, and could they be appropriated exclusively the appropriation would result in mischievous monopolies. Could such phrases as “Pennsylvania wheat,” “Kentucky hemp,” “Virginia tobacco,” or “Sea Island cotton” be protected as trade-marks, could any one prevent all others from using them or from selling articles produced in the districts they describe under those appellations, it would greatly embarrass trade and secure exclusive rights to individuals in that which is the common right of many. It can be permitted only when the reasons that lie at the foundation of the protection given to trade-marks are entirely overlooked. It cannot be said that there is any attempt to deceive the public when one sells as Kentucky hemp or as Lehigh coal that which in truth is such, or that there is any attempt to appropriate the enterprise or business reputation of another who may have previously sold his goods with the same description. It is not selling one man’s goods as and for those of another. Nothing is more common than that a manufacturer sends his products to market

designating them by the name of the place where they were made. But we think no case can be found in which other producers of similar products in the same place have been restrained from the use of the same name in describing their goods."

2. In the above decision also are collated and discussed the leading prior decisions in which the question as to the employment of a geographical word as a trade-mark has arisen, and these clearly establish the doctrine that to the use of such words no exclusive right can attach. Undoubtedly Courts of equity have granted injunctions to restrain the *fraudulent* use of words of this character; but the grounds of such decisions have been invariably, I think, the fraud of the defendants, and not any *exclusive* right of the plaintiffs. (*C. D.*, 1872, *p.* 128.) Examples of this are afforded by the familiar cases of *Newman v. Alword*, (49 *Barb.*, 598), and the *Brooklyn White Lead Co. v. Masaury*, 25) *Barb.*, 416).

3. The decisions of the office in cases involving this question have not been altogether uniform, although it has always been held that as a rule geographical names are not proper subjects of trade-mark registration. (*Ex parte Knapp*, 16 *O. G.*, 318; *Marshing & Co.*, 15 *O. G.*, 294; *Cornwall & Bros.*, 12 *O. G.*, 312). Doubtless, as stated by the Acting Commissioner in the last cited case, exceptions may exist to this general rule. Where the word adopted is of such a character that it will be readily understood by the public as a purely arbitrary and fanciful term, and not as one indicative of the place of manufacture, it may serve the office of a lawful trade-mark, and the mere fact that this word is a geographical one would not, of itself, be a valid objection to its registration. Before this can be said to be the case, however, I am clearly of the opinion that the place bearing such name must be such a one that the public not only cannot be deceived, but that the manufacturers of like articles in such place could not with equal right so mark their wares and claim the protection of our laws. In the case of *Cornwall & Bros.*, above referred to, the name "Dublin" was allowed to be registered as a trade-mark for soap; but I can see no reason why any manufacturer of soap in the City of Dublin could not with equal truth,

and consequently with an equal right, adopt and use this word as a trade-mark for his wares, and I cannot, therefore, approve of such decision as a guide for my action.

Applicants in this case are engaged in the manufacture of ticking at Philadelphia, Pennsylvania, and the mark sought to be registered has, it is stated, been used by them upon their goods for the past ten years. The Examiner, in rejecting the case, stated that the City of Lancaster in Pennsylvania was renowned for its cotton manufactories; but whether this statement, which is controverted by counsel, be true or not, it appears that in this city "there are three large cotton-factories, erected in 1846-48, employing over one thousand operators." (*New Am. Cyclopaedia*, 1868). Such being the case, I fail to see how applicants can rightfully claim the exclusive use of this word in connection with tickings when other manufacturers of tickings at such place can so mark their wares with equal truth. Nor can this fact be changed by the mere circumstance that the name of the city is also that of a historical personage. In this past particular the present case is parallel with that of *Oliver and Robinson*, (*MS. Dec. of Com.*, vol. 21, p. 99). Here, as in that case, the primary signification of the word to the general public would be indicative of the place of manufacture, and it would consequently fail to point to origin or ownership. It may undoubtedly be true that to some persons versed in history it might be regarded an arbitrarily selected historical name; but in cases of this character it is the signification conveyed to the general purchasing public, and not to a particular few, that must determine.

The fact that the applicants have used this word for the period named can give them no right thereto which they would not otherwise have. In the case of the *Glendon Iron Company v. Uhler*, (6 *Official Gazette*, 154) the doctrine was clearly laid down, the Supreme Court of Pennsylvania there holding that the name of an incorporated borough cannot be protected as a trade-mark, even though it was adopted and used before the borough was incorporated or there was a town in the place.

It remains now to consider the question whether the word "Lancaster," when there is joined therewith the representation of a rose,

can constitute a valid trade-mark. The Examiner, in his answer to the reasons of appeal, admits (and properly I think) that the symbol alone would be registrable. It would serve to distinguish in the market the goods of applicants, notwithstanding the fact that others would be at liberty to use the word, and it would thus accomplish the prime object of a valid trade-mark. In their specification however, applicants state that the essential feature of their mark is the *word* accompanied by the rose, and counsel insist in their argument that the two combined should be allowed registration. Is this statement in the specification correct, and can the word be truthfully said to be an essential feature of this mark? This word, as must appear from what has already been stated, is merely descriptive of the place of manufacture, and any other descriptive words, such, for instance, as "superfine" or "superior"—might be substituted therefor, and with equal reason be said to constitute an essential feature. The essential features of a trade-mark are those which serve, in whole or in part, to distinguish the goods of the party by whom such mark is adopted; but, as has been already shown, this the word "Lancaster," cannot do. Mr. Upton, in his work on "*Trade-Marks*," page 136, states as a principle deducible from the leading case of the *Amoskeag Manuf. Co. v. Spear*, that a violation of a trade-mark can only be predicated of a copy or imitation of a trade-mark or *those portions of a trade-mark which truly designate the origin and ownership of the goods*, and the rule may I think, be regarded as fully sustained by the weight of authorities. (*Cornell v. Davis*, *Am. Trade-Mark Cases*, 429; *Brooklyn White Lead Co. v. Masaury*, 25 *Barb.*, 416; *Boardman v. Britannia Co.*, 35 *Conn.*, 414).

From the above it appears that it is the essential features of the mark, and those only, to which the Courts will extend their protection, and to such alone should the office allow registration. I cannot regard it as proper that an applicant should be permitted to describe and claim as an essential part of his mark a word which the Courts would obviously hold otherwise. If the meaning conveyed to the general public by the word "Lancaster with the accompanying rose" were that contended for by counsel—viz: the historical "Rose of Lancaster"—the word might then

truly be considered essential ; but since as already stated, the two would be regarded as totally distinct, the one indicating the place of manufacture and the other origin and ownership, such cannot be said to be the case.

Were I to admit the word "Lancaster" to be an essential feature of the mark, the case would then seem to be open to the further objection that the use of such word would convey a false impression to the public—viz: that the goods were manufactured in Lancaster, when, in fact, they were made in Philadelphia, and that any one making like goods in Lancaster might obtain an injunction against the use of such word by parties manufacturing elsewhere. (*Newman v. Alword*; *Armstead v. Blackwell*, *Blackwell v. Dibrell & Co.*, 14 O. G., 633; *Ex parte Knapp*, *supra*). In the above cited case of *Blackwell v. Dibrell & Co.*, the defendants, manufacturing tobacco at Richmond, Virginia, adopted as a trade-mark the word "Durham," accompanied by the symbolical representation of a short-horned bull. The plaintiff, a manufacturer of tobacco at the town of Durham, North Carolina, using the same mark, brought suit for infringement, and the Court decreed in his favor, holding that the use of the principal characteristic of the trade-mark by manufacturers not conducting their business at the town of Durham was a deception upon the public, and should be enjoined upon this ground alone, irrespective of any exclusive right as against other manufacturers in such town.

In the case of *Ex parte Knapp*, in which the applicant sought to register the word "London" as a trade-mark, the following language occurs:

"The word 'London' is objectionable because it may readily convey the impression that the food is manufactured in London. Whatever is descriptive cannot be registered as a trade-mark, as every one is entitled to use proper descriptive language in regard to his articles of manufacture, and no one should be given a monopoly therein. Neither is one authorized by the trade-mark law to deceive the public by using terms which convey a false impression."

As deducible from the above considerations, I must therefore hold—

1. That as a rule geographical names cannot be allowed registration as trade-marks.

2. That before any geographical name can be said to be registrable it must clearly appear that the place of that name is such a one that the word will be understood by the general purchasing public as primarily fanciful, and that manufacturers of like goods at such place cannot so mark their wares and claim the protection of our laws.

3. That the essential features of a trade-mark are those only which serve in whole or in part to distinguish the goods of the party by whom such mark is adopted, and it is not proper that anything should be described as essential which the Courts would hold otherwise; and,

4. That words calculated to deceive the public as to the place of manufacture should not be allowed registration.

The decision of the Examiner of Trade-Marks is accordingly affirmed.

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SUPREME JUDICIAL COURT OF MASSACHU-
SETTS. IN EQUITY.

LAWRENCE MANUFACTURING COMPANY*vs.*

LOWELL HOSIERY MILLS, AND OTHERS.

DECIDED 9 SEPTEMBER, 1880.REPORTED 129 MASS., 325.

“523” *Case.*

Numerals, arbitrarily selected, and used on goods in combination with other devices to denote the origin of the goods, and not their quality, are a valid trade-mark, and a person who uses them in combination with other devices which he has a right to use, may be restrained by a bill in equity from so using them, if he does so for the purpose of imitating the trade-mark, and his use is calculated to deceive, and does deceive persons buying his goods.

L. M. Sargent, for the plaintiff.

G. F. Richardson, (*D. S. Richardson* with him), for the defendant.

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COLT, J.:

This is a bill in equity, to restrain the defendant from using the plaintiff's trade-mark, and for compensation for the injury occasioned by such use. It was heard by a single justice of this Court, upon the pleadings and proofs. The Judge was of opinion that the plaintiff was entitled to the relief prayed for, and reported the case for the consideration of the full Court.

The alleged trade-mark of the plaintiff consists of the figure of an eagle, surmounting a wreath formed of the branches of the cotton plant. The wreath encloses the words "Lawrence Manufacturing Company" printed in a circle, having underneath it the word "trade-mark," and below all, the figures "523," printed in large hollow block numerals. This device had been stamped for many years on hosiery of a certain grade, and was known and recognized as indicating that the goods so marked were of the plaintiff's manufacture. Before this, the plaintiff had used an eagle and scroll in combination with other numerals as a trade-mark, upon the same grade of hosiery; and the wreath and eagle of the present device, without the numerals "523," or any other numerals, had been previously used on other grades of its goods.

The stamp adopted by the defendant, in alleged imitation of the plaintiff's stamp, consists of an eagle surmounting a double circle or garter, on which are printed the words "extra finish iron frame," and beneath which are the figures "523," printed in large hollow block numerals, of the size and description used by the plaintiff, and occupying the same position with reference to other parts of the device. This stamp the defendant has placed upon hosiery goods made by it for the purpose of imitating the plaintiff's stamps, and in order that such goods might be supposed to be of the plaintiff's manufacture; and it was found by the Judge that the plaintiff's customers had been misled and deceived thereby. The eagle and garter were used by the defendant before the alleged trade-mark of the plaintiff was adopted; and, at the argument, the plaintiff made no claim to the exclusive use of them, when not combined with the numerals "523."

The only question presented upon this report, therefore, is whether the plaintiff's stamp, including the figures, constitutes such a trade-mark as the law will protect. The statutes of this Commonwealth protect a person who uses any peculiar name, letters, marks, devices or figures, upon an article manufactured or sold by him, to designate it as an article manufactured by him. *Gen. Sts., ch. 56, sec. 1.* It has been said that there can be no exclusive right to use marks, figures and letters which are intended merely to indicate the quality of the fabric manufactured, as distinguished from those marks which are intended to indicate its origin, because one has no right to appropriate a sign or symbol or mark, which, from the nature of the fact it is used to signify, others may use with equal truth, and therefore have an equal right to employ for the same purpose. *Manuf. Co. v. Trainer*, 101 U. S., 51. And in *Canal Co. v. Clark*, 13 Wall., 311, it was declared by Mr. Justice Strong, that no one can claim protection for the exclusive use of a mark which would practically give him a monopoly in the sale of any goods other than those of his own manufacture. See also *Gilman v. Hunnewell*, 122 Mass., 139. Letters and figures, when used only for the purpose of denoting quality, are from the very nature of the use incapable of exclusive appropriation.

These considerations would be decisive, if the plaintiff claimed the exclusive right to the numerals "523," when used only to indicate the quality, and not with reference to the origin of the goods. But such is not the plaintiff's position. Its claim is that the purpose of using these figures in connection with the other parts of its trade-mark, was to aid the buyer in distinguishing its goods from similar goods made and sold by others.

A trade-mark when applied to manufactured articles, may well consist of the name and address of the manufacturer, with the addition of some peculiar device or emblem, some curious forms or figures, so disposed as to attract attention, impress the memory, and advertise more effectually the origin of the article to which it is attached. This affords a wide field for ingenuity in producing designs, which the increasing variety of modern trade-marks shows is not wholly neglected, and it may be that even numerals or

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letters of the alphabet can be combined and printed in such unusual and peculiar forms, that the result would be quite sufficient for use as a trade-mark. The difficulty of giving to bare numbers the effect of indicating origin or ownership, and of showing that the numbers used were originally designed for that purpose, was recognized in *Boardman v. Meriden Britannia Co.*, 35 Conn., 402. But it was said in that case that, if once shown to have been used for that purpose, and to have had that effect, it would not be easy to assign a reason why they should not receive the same protection as trade-marks. The numbers in that case were, however, associated with the name of the plaintiffs, and with the form, color and general arrangement of the labels used. and were held by virtue of that connection to form an important part of the trade-mark itself. See also *Gillott v. Esterbrook*, 48 N. Y., 314; *Glen & Hall. Manuf. Co. v. Hall*, 61 N. Y., 226; *Kinney v. Allen*, 1 Hughes, 106; *Ransome v. Bental*, 3 L. J. (N. S.), Ch. 161.

In coming to this conclusion, the Judge who heard the present case found that the plaintiff adopted and used the numerals "523" as part of its trade-mark; and this finding is supported by the evidence. It appears that these figures were selected arbitrarily; that they were of unusual and distinctive form; that they were added to the original device, consisting of the eagle, the wreath and the plaintiff's name, at the time when the word "trade-mark" was also added; and that the whole, so composed, has been used as one trade-mark ever since. This mark was recognized and known as the plaintiff's mark, and goods so marked were described and called for as "523's."

The defendant's imitation was produced by using the same figures, printed in the same style, and placed as to the other parts of the device in the same relative position as the plaintiff's. These numerals constituted one of the most prominent features in the plaintiff's design, and, when used in connection with the rest of the defendant's mark, were calculated to aid in deceiving the public.

It is not necessary that the resemblance produced should be such as would mislead an expert, or such as would not be easily

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detected if the original and the spurious were seen together. It is enough that such similitude exists as would lead an ordinary purchaser to suppose that he was buying the genuine article and not an imitation. *McLean v. Fleming*, 96 U. S., 245; *Gorham Co. v. White*, 14 Wall., 511; *Metzler v. Wood*, 8 Ch. D., 606.

The imitation in this case accomplished the result intended; and the entry must be

Decree for the plaintiff.

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COURT OF COMMON PLEAS, PHILADELPHIA.
IN EQUITY.

DREYDOPPEL• *vs.*YOUNG, ET AL.

DECIDED 2 OCTOBER, 1880.

REPORTED 14 PHIL., 226.

“Dreydoppel’s Borax Soap” Case.

1. The commercial name of an article which every man has a right to make and sell, cannot be appropriated as a trade-mark.
2. But when coupled with other distinctive features, the whole may be so appropriated.
3. Printed copies of the medals awarded by United States Centennial Commission, and the French Republic, with the words Dreydoppel’s Borax Soap printed underneath, held to be as a whole, a valid trade-mark.
4. A man cannot openly appropriate and sell in the market, the commercial reputation which another has acquired by his industry and skill.

5. Even if the resemblance between the plaintiff's wrappers and those used by the defendants was accidental, the plaintiff would be entitled to protection against its injurious results to his trade.
6. The former practice of the Courts of Chancery in England of dissolving an injunction upon the filing of an answer denying the equity of the bill, was abolished by the Statute 15 and 16 Vict. ch. 86, sec. 59, which enacted that thereafter, the answer should be regarded merely as an affidavit, and that affidavits may be recorded and read in opposition thereto.

MOTION FOR A SPECIAL INJUNCTION.

William D. Witherall, Esq., for plaintiff.

E. P. Smithers, Esq., for defendant.

THAYER, P. J.:

1. It is true that no one can appropriate as a trade-mark the commercial name of an article which every man has the right to make and sell.

2. The plaintiff, therefore, has no exclusive right to the name "Borax Soap."

3. He has however, acquired a right to the trade-mark as a whole which he has adopted, consisting of printed copies of the medals awarded him by the United States Centennial Commission, in 1876, and the French Republic at the Exposition Universelle Internationale, held at Paris in 1878, with the words "Dreydoppel's Borax Soap" printed underneath, and he is entitled to protection against such a fraudulent imitation of his wrappers and labels as will enable the defendants to deceive the public and injure his business. It is too plain to admit of doubt that the defendants in the present case have studiously copied the plaintiff's wrappers, not only their general design, arrangement and appearance, but their very phraseology, and to increase the counterfeit resemblance they have added devices which may be readily mistaken for the medals of the plaintiff by unlettered persons, or persons not making a careful and critical comparison between the two. There is such a general resemblance of forms, words, arrangements, symbols and accompaniments, that the one wrapper

might easily be mistaken for the other. In its general appearance the one is a servile imitation of the other, the differences being merely colorable, and evidently designed to evade the consequences of the unlawful infringement of the plaintiff's rights, and to preserve a sufficient individuality to enable the defendants to reap the benefit of their fraud.

4. It is distinctly proven by a number of witnesses that in point of fact the fraud has been successful, and that the defendants' soap, which is ordinarily sold for a less price than the plaintiffs, has, by means of this fraudulent imitation of the wrapper, been sold by grocers as the plaintiff's soap, and for the same price. Upon such dishonest practices a Court of Equity will lay its strong hand, that those who are guilty of them may learn that, although in their opinion there may be no such thing as a morality in trade, a man cannot openly appropriate and sell in the market the commercial reputation which another has acquired by his industry and skill.

5. Even if the resemblance between the plaintiff's wrappers and those used by the defendants was accidental, the plaintiff, according to all the decisions, would be entitled to protection against its injurious results to his trade. But there are internal evidences of the most convincing character that the resemblance is by no means accidental, but that it is an intentional imitation, carefully designed, and worked out with much ingenuity. The only wonder is that the defendants should have the hardihood to deny it deliberately in their answer. But their answer upon such an application as this is only to be regarded as an affidavit, and entitled to be considered along with the other evidence in the cause.

6. The former practice of the Courts of Chancery in England, of dissolving an injunction upon the filing of an answer denying the equity of the bill, was abolished by the Statute 15 and 16 Vict., c. 86, s. 59, which enacted that thereafter the answer should be regarded merely as an affidavit of the defendant, and that affidavits may be received and read in opposition thereto. The Supreme Court of this State has decided that the new practice introduced in England by the statute was adopted in this State by

virtue of rule 88 of the equity rules adopted in 1865. *The Warren & Franklin Railroad Co. v. The Clarion Land Co.*, 4 P. F. Smith, 28.

An interlocutory injunction is awarded to restrain the defendants from the use of the wrappers complained of, or of any other wrappers or labels having a substantial resemblance in words, design, arrangements, devices, or general appearance to those used by the plaintiff.

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SUPREME COURT OF WISCONSIN. IN EQUITY.

LEIDERSDORF, AND ANOTHER*vs.*FLINT.

DECIDED NOVEMBER, 1880.

REPORTED 50 WIS., 401.

“Nigger Hair Smoking Tobacco” Case.

Trade-Mark. (1) *Rule as to demurrer to the complaint in actions, to restrain use of trade-mark.* (2) *What relief may be demanded in such cases.*

1. In an action to restrain defendant from using a trade-mark alleged to have been devised by him in imitation of that of plaintiffs, and to be in fact deceptive to purchasers, etc., if *fac similes* of the two trade-marks are annexed to the complaint, it will not be held, *on demurrer*, that the one is not sufficiently similar to the other to mislead, and to constitute an infringement, unless the dissimilarity is so marked as to leave no doubt in the mind of the Court; but the question of infringement will be reserved until the coming in of the proofs.

2. In such an action, plaintiff may without misjoinder, ask for an accounting as to profits and for damages.

APPEAL from the County Court of Milwaukee County.

The action is brought to restrain the infringement by defendant of plaintiff's trade-mark, and for damages. The parties are dealers in tobacco in the City of Milwaukee. It is stated in the complaint that the plaintiffs and their predecessors, to whose right they have succeeded, for eleven years last past "have manufactured and sold a special article of smoking tobacco, put up in packages of a certain form, in paper wrappers of a particular color and mark, and stamped with the words and name 'Nigger-Hair Smoking Tobacco,' and otherwise distinctively marked and designated as hereinafter set forth; that during all the said period of eleven years they have exclusively used and are now using, and had and still have the right so to use, the said name and mark hereinafter more particularly described as a trade-mark for such smoking tobacco; and that no other person than the said firm has at any time had the right to make use thereof, or of any like mark or name, or of any near resemblance thereto." Then follows a partial description of the trade-mark. A *fac simile* of it is annexed to and made a part of the complaint. It is impracticable to reproduce it here, and it is unnecessary to give a minute description of it. It is sufficient to state that the most marked feature of it is a representation of the head of a negro surmounted with a copious crop of wool, and having a large ring pending from the nose and another from the ear. Below the figure is the name of the brand, and the firm-name and residence of the manufacturers.

The complaint further alleges that "said smoking tobacco is known to the trade, and to the public, and to the buyers and consumers thereof, by the name of 'Nigger-Hair Smoking Tobacco,' and by the plaintiff's own peculiar device and trade-mark aforesaid; that the said tobacco is a low-priced tobacco, and is to a very large extent bought and consumed by a class of people who cannot read, and whose necessities and manner of living do not require them to practice more than ordinary caution when pur-

chasing the commodities most frequently procured; and to this class of people the said tobacco has become known and is easily recognized, largely by reason of the said peculiar and distinctive trade-mark aforesaid." It is then charged that in 1878 the defendant devised a trade-mark in imitation of the plaintiff's said mark, which he placed upon the wrappers of an inferior quality of tobacco manufactured by him, and which so closely resembled the plaintiff's trade-mark that purchasers were deceived thereby, and bought the defendant's tobacco when they supposed they were buying the genuine "Nigger Hair." This alleged imitation represents the head of an Indian with a ring in his ear, but none in his nose. Under the vignette are the words "Big Indian" instead of "Nigger Hair," printed in similar type, and the name and residence of the manufacturer. A *fac simile* of the defendant's mark is also annexed to the complaint, and marked "Exhibit B." That of the plaintiffs is referred to as "Exhibit A."

The complaint then proceeds as follows:

"And the plaintiffs further say they are informed and believe that said defendant so as aforesaid continued to use said imitation of plaintiffs' trade-mark, until, believing he could retain and keep the trade so as aforesaid already attracted and diverted to him by means of further using a less close and striking resemblance to plaintiffs' trade-mark, he artfully contrived and executed certain changes in his said imitation of plaintiffs' trade-mark, so as to be able to assert the pretence and excuse that he had ceased using the imitation shown at Exhibit B, whereas, in fact, the said modification and changes were not in the chief characteristic of said label, and the same still presents to the public the impression and idea that the same is the badge or mark of the plaintiffs so as aforesaid described, and now does strongly resemble the plaintiffs' trade-mark in all its chief and most essential features; a copy of which said second device of the defendant, and a specimen of the same, together with its paper wrapper, is hereto attached and marked 'Exhibit C.'

"And the plaintiffs further allege that the imitations aforesaid are calculated to deceive the general public, and especially the

small purchasers and consumers of tobacco, and that the form, size, color and devices of the packages of tobacco of the defendant are intended to be and are in such imitation of and resemblance to those of the plaintiffs, as are contrived and calculated to, and actually do, mislead the public in that regard, and cause among consumers the idea that the two articles of tobacco are identical, and are manufactured by the plaintiffs.

“And the plaintiffs further say that for several months last past, beginning at a date which is unknown to them, the defendant has manufactured and sold smoking tobacco in packages of the kinds above described, and has, as they are informed and believe, put forth the same in the market, and has endeavored to procure others to sell and deal in the same, as the identical ‘Nigger-Hair’ tobacco of the plaintiffs. And the plaintiffs are informed and believe that in many instances the said tobacco of the defendant has been sold as and for the said ‘Nigger-Hair’ tobacco, on account of the similarity of the appearance of the packages and marks as hereinbefore stated.’”

Exhibit C is very much like Exhibit B, except that it displays no ring in the ear of the Indian, and the words “Big Indian” thereon are placed in a different position.

The prayer of the complaint is for an injunction, for an accounting as to profits, and for damages. The defendant demurred to the complaint on the grounds—*first*, that it does not state facts sufficient to constitute a cause of action; and *second*, that several causes of action are improperly united therein. The Court overruled the demurrer, and the defendant appealed from the order.

For the appellant, there was a brief by *Jenkins, Elliott & Winkler*, and oral argument by *Mr. Jenkins*.

For the respondents, there was a brief by *Carpenter & Smith*, and oral argument by *Winfield Smith*.

LYON, J.:

Doubtless if the *fac similes* of the various trade-marks of the parties are disregarded, the complaint states a cause of action in

equity for an injunction to restrain the infringement of the plaintiffs' trade-mark. This is not controverted. But it is urged in support of the demurrer, that, inasmuch as these marks are attached to and really made a part of the complaint, they cannot be disregarded, but have the force and effect of averments; and that they show on their face, notwithstanding averments to the contrary, that no one could be misled, as charged, by the marks used by the defendant.

1. It may well be that two trade-marks are so entirely dissimilar that a Court can properly say on demurrer that one is not and cannot be an infringement of the other, and this, although the pleading demurred to avers that it is an infringement and misleads the public. But to justify such a ruling the dissimilarity should be so marked as to leave no doubt in the mind of the Court.

We do not think this is such a case. Although in several particulars there are differences between Exhibit A on the one hand, and Exhibits B and C on the other, (and this is especially so as between Exhibits A and C), yet there are some points of resemblance common to all of them. By a mere inspection of them we are not prepared to determine whether B and C, or either of them, so nearly resemble the plaintiffs' trade-mark that ordinary purchasers, proceeding with ordinary caution, are likely to be misled thereby. This, we understand, is the test of infringement in such cases. Much less are we prepared to hold that there is no such resemblance in the face of the positive averments in the complaint that there is. From an examination of some of the cases we are led to believe that the usual practice is to reserve the question of infringement until the coming in of the proofs. In cases of any doubt this seems to be the better and safer practice; for the evidence will undoubtedly throw more or less light on the question. We have concluded to adopt that course in this case. Hence, without intimating any opinion as to whether the *fac similes* of defendant's trade-marks, considered alone, are or are not infringements of plaintiffs' trade-mark, we hold, for the purposes of the demurrer; that the complaint states a cause of action in equity. This leaves the question of infringement to be deter-

mined as an original question upon the pleadings and proofs, in case the defendant answers denying the infringement.

The other cause of demurrer assigned, to wit, the improper joinder of several causes of action, was not argued by the learned counsel for the defendant.

2. It is quite apparent that there is no such misjoinder in the complaint.

BY THE COURT:

The order overruling the demurrer is affirmed.

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COURT OF APPEALS, STATE OF NEW YORK.
IN EQUITY.

JOHN N. HEWER, APPELLANT,

*vs.*NICHOLAS DANNENHOFFER, ET AL., RESPONDENTS.

DECIDED NOVEMBER, 1880.

REPORTED 82 N. Y., 499.

“Silex” Case.

The parties hereto were formerly partners in the business of manufacturing glass chimneys for lamps, and they adopted the word “Silex” as a trade-mark. The firm was dissolved in June, 1877; the defendants sold to the plaintiff their interest in the real estate used for the business, and in certain specified personal property connected with it. Nothing was said at the time about the good-will of the business, or the trade-mark, and there was no reference to it in the bill of sale. Thereafter the plaintiff continued the business at the same place, using the same trade-mark. In October, 1877, defendants commenced and thereafter carried on the same business in the same city, using the same trade-mark. In an action to restrain such use, **Held:**

That assuming the word “Silex” could be used as a trade-mark, and that the firm while it existed, had the exclusive right so to use it, such exclusive right was not acquired by plaintiff, and the action was not

maintainable; that after the dissolution, either of the late partners could use it until in some way he had divested himself of that right; that as the trade-mark was not in its nature local, it did not pass as an incident to what was sold, that it was incumbent upon the plaintiff to show himself vested by some agreement, with the exclusive right to use it, and that this he had failed to do.

Congress and Empire Spring Co. v. High Rock Spring Co., (45 N. Y.), distinguished.

APPEAL from order of the General Term of the City Court of Brooklyn, reversing a judgment in favor of defendants, entered upon a decision of the Court on trial at Special Term, and granting a new trial.

This action was brought to restrain defendants from the use of the word "Silex" as a trade-mark and for damages, etc.

The facts sufficiently appear in the opinion.

John O'Byrne, for appellant.

The word "Silex" is the proper subject for a trade-mark to designate the origin and ownership of glass chimneys. (*Burnett v. Phalon*, 3 Keyes, 594; 5 Abb., [N. Y.], 212; *Schneitzer v. Atkins*, 19 Law Times, [N. S.], 6; *Prot v. Cabridens*, 20 Ann. de la Pro., 369; *Coddington on Trade-Marks*, 449; *Godillot v. Hazard*, 12 J. & S., 427-431; *Rillett v. Cartier*, 11 Abb., [N. S.], 186). The trade-mark passed, without express mention, with the assignment of the business. (*Leather Cloth Co. v. American Leather Cloth Co.*, 11 Jurist, [N. S.], 513; *Congress & Empire Spring Co. v. High Rock Congress Spring Co.*, 45 N. Y., 291; *Shipwright v. Clemens*, [1871], 19 Wend., 599; *Dixon Crucible Co. v. Guggenheim*, 7 Phila., 408; *Lockwood v. Bostwick*, 2 Daly, 521; *Ainsworth v. Walmsley*, 14 Law Times, [N. S.], 220; *Hudson v. Osborne*, 39 Law Jour., [N. S.], Ch. 79; *Hazard v. Caswell & Massey*, Daily Reg., Dec. 16, 1878; *Glen & Hall Manuf. Co. v. Hall*, 61 N. Y., 226). When defendants relinquished all claim to the Long Island Flint Glass Works, they relinquished all right to that which particularly designated its products, which the law will not permit them to carry away and exercise in another

place. (*Samuel v. Berger*, 24 Barb., 163; *Browne on Trade-Marks*, sec. 361, et seq).

Geo. H. Fisher, for respondents.

The trade-mark in suit is not a proper trade-mark. (*Bump's Law of Trade-Marks*, 347; *Webster Dict.*, titles *Silex*, *Silicia*, *Silicic Acid*, *Glass*; *American Cyclopædia*, title *Glass*; *Law's American Dig.*, 1789-1862, 686; *Browne's Law of Trade-Marks*, 102-191; *U. S. Act concerning Trade-Marks in U. S. R. S.*, or *Cox's Am. Trade-Mark Cases*, or *Bump's Trade-Marks*; 1 *Philip's Ev.*, [4th Am. Ed.], 626). Words may not be appropriated by one to mark an article of his manufacture, when they may be used truthfully by another to inform the public of the ingredients which make up an article made by him. (*Caswell v. Davis*, 58 N. Y., 223, 234).

EARL, J.:

For over three years prior to June, 1877, the plaintiff and defendants, under the firm name of Hewer & Dannenhoffer, carried on the business of manufacturing glass chimneys for lamps, in the City of Brooklyn. Their place of business was called "The Long Island Flint Glass Works," and they adopted the word "Silex" as a trade-mark for the designation of their goods.

In June, 1877, the firm was dissolved and the defendants sold to the plaintiff their interest in the real estate whereon the business was conducted, and also in certain personal property connected with the business; and thereafter the plaintiff continued the same business at the same place, using the same trade-mark. In the month of October, thereafter, the defendants commenced to carry on the same business in the City of Brooklyn, and they used the same trade-mark for the designation of the goods manufactured by them.

The plaintiff claiming, that at the time of the sale to him of the real estate and personal property, as above mentioned, he acquired the exclusive right to the trade-mark which had been used by the firm, commenced this action against the defendants to recover damages for the wrongful use of the trade-mark by them,

and to restrain its further use. The Court, at Special Term, decided the case in favor of the plaintiff; but, upon appeal, the General Term reversed the judgment of the Special Term, and granted a new trial on the ground that the exclusive right to the use of the trade-mark had not been acquired by the plaintiff, and this appeal is from the order granting the new trial.

I will assume, for the purposes of this case, that the word "Silex" could be used as a trade-mark, and that the firm of Hewer & Dannenhoffer, while it existed, had the exclusive right to use it; and yet I am of opinion that the judgment at Special Term was properly reversed, for the reasons given in the opinion pronounced at the General Term.

After the dissolution of the firm, either one of the persons who constituted the firm could use the trade-mark, until in some way he divested himself of the right to use it. It is undoubtedly true that the defendants could, by agreement, vest the exclusive right to use it in the plaintiff. The question is whether they did. And this question must be determined upon the facts found at Special Term, or upon facts not disputed. There was a deed of real estate to the plaintiff, and there was a bill of sale specifying the personal property sold to the plaintiff. It was found that nothing was said at the time of the sale to the plaintiff about the good-will of the business or about the trade-mark, and there was no reference to the trade-mark in the bill of sale; and there was no agreement on the part of the defendants that they would not engage in manufacturing the same kind of goods, or that the plaintiff should have the exclusive right to continue in Brooklyn the business before carried on by the firm.

The deed and bill of sale showed what the defendants sold to the plaintiff. There is no finding that they were executed or taken by the plaintiff in consequence of any fraud or mistake, and hence they must be held to embody the contract between the parties. (*Pickering v. Dowson*, 4 Taunt., 779; *Munford v. McPherson*, 1 Johns., 414; *Durgin v. Ireland*, 14 N. Y., 322; *Polen v. Le Roy*, 30 Id., 549).

A trade-mark is a specie of property which may be sold or transmitted by death with the business in which it has been used.

(*The Leather Cloth Company v. The Am. Leather Cloth Company*, 4 *De Gey, J. & S.*, 137; *S. C.*, 11 *House of Lords Cases*, 523; *The G. & H. Manuf. Co. v. Hall*, 61 *N. Y.*, 226). There was no finding and no evidence that the defendants intended by their sale to the plaintiff to divest themselves of their property in this trade-mark. This property did not pass as incident to what was sold. It was no necessary part of what was sold. The trade-mark was not in its nature local. It did not import that the goods upon which it was placed were manufactured or produced in any particular locality. It could truthfully be used upon goods manufactured anywhere, and in these respects it was unlike the trade-mark under consideration in the case of *The Congress and Empire Spring Co. v. The High Rock Congress Spring Co.*, 45 (*N. Y.*, 291). Under the circumstances of this case it was incumbent upon the plaintiff to show that the exclusive right to use the trade-mark was actually, by agreement, vested in him, and this he failed to show.

The order appealed from should, therefore, be affirmed, and judgment absolute rendered against the plaintiff with costs.

All concur.

Order affirmed and judgment accordingly.

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COURT OF APPEALS, STATE OF NEW YORK.
IN EQUITY.

JOHN P. HIER, ET AL., APPELLANTS,

vs.

ABRAHAM ABRAHAMS, ET AL., RESPONDENTS.

DECIDED 16 NOVEMBER, 1880.

REPORTED 82 N. Y., 519.

“Pride Cigar” Case.

1. Trade-marks may consist of pictures, symbols, or a peculiar form or fashion of label, or they may consist simply of a word or words.
2. Where the trade-mark is of the first kind, to constitute an infringement, there must be such an imitation as to amount to a false representation, liable to deceive the public.
3. Where, however, the trade-mark consists of a word, it continues to be the distinguishing mark of the manufacture to which it is applied, in whatever form it is printed or represented, and its use by another, in any form, applied to similar articles, is unlawful and may be restrained.
4. The use of the word by another is not justified, although used in connection with different words from those in connection with which it is used by the party who has appropriated it as a trade-mark.

5. To entitle a party to restrain another from continuing the unlawful use of his trade-mark, it is not essential to show an actual intent to defraud.
6. Nor is it essential that the party shall first establish a legal right to the trade-mark, in an action at law.

Plaintiffs, for three years before the commencement of this action, had adopted and used the word "Pride" as a trade-mark in the manufacture and sale of, and to designate their cigars. Defendants, with knowledge of this, used the same word on the labels and boxes of cigars manufactured by them. **HELD:**

That said word, as applied to cigars, was arbitrary, not descriptive of the article, and one which could lawfully be appropriated as a trade-mark, and that plaintiffs were entitled to an injunction restraining its use by defendants.

Also **HELD**, that as the infringement charged was the appropriation of a word, not an imitation of a symbol or label, it was no defence that defendant's labels did not resemble those of plaintiffs.

APPEAL from the order of the General Term of the Supreme Court, in the Fourth Judicial Department, reversing a judgment in favor of plaintiffs, entered upon a decision of the Court on trial at Special Term, and granting a new trial.

This action was brought to restrain the defendants from infringing upon plaintiff's alleged right to the use of the word "Pride" as a trade-mark, and for damages, &c.

The facts are set forth sufficiently in the opinion.

John C. Hunt, for appellants.

In equity, aside from the statute, plaintiffs are entitled to the relief asked for, (4 *Abb.* [N. S.], 410; 48 *N. Y.*, 374; 61 *Id.*, 226; 2 *Daly*, 521; 49 *Barb.*, 588; 51 *N. Y.*, 189; 45 *Id.*, 291; 1 *Weekly Dig.*, 529; 8 *Id.*, 514; 7 *Alb., N. C.*, 17; 21 *Alb. Law Jour.* 340; 5 *Weekly Dig.*, 283). Defendants are precluded by admissions in the answer, from denying that plaintiffs had a prior adoption of the word "Pride." (38 *N. Y.*, 28).

W. E. Lansing, for respondents.

Protection to trade-marks rests upon the principle of preventing a fraudulent appropriation of a name, by which only the pro-

ducts or manufacture of another is designated, and of shielding the public against deception. (*Wolfe v. Burke*, 7 *Lans.*, 155). To entitle a party to relief, the resemblance must amount to a false representation of facts indicated by the genuine mark; that is, of the manufacture or proprietorship of the article. (*Popham v. Cole*, 66 *N. Y.*, 75; *Amoskeag Manuf. Co. v. Spear*, 2 *Sandf.*, 599). Where the points of difference are so prominent and striking as to produce the impression that the articles are different, an action for the injunction cannot be maintained. (*Talcott v. Moore*, 6 *Hun.*, 106; 2 *Sandf. Ch.*, 622; *Howard's App. Cases*, 547; 66 *N. Y.*, 69). The Court is not bound to interfere when ordinary attention will enable purchasers to discriminate between the trade-marks used by different parties. (2 *E. D. Smith*, 387; 25 *Barb.*, 79; *Upton's Trade-Mark*, 203, 4, 8, 14; 47 *N. Y.*, 104). A party cannot appropriate a word in common use as his trade-mark so as to exclude others. (18 *How. Pr.*, 64; 7 *Lans.*, 151; 56 *N. Y.*, 115; 57 *Barb.*, 524; 6 *Hun.*, 106; *Caswell v. Davis*, 58 *N. Y.*, 234, 235). A trade-mark is protected only when it denotes the origin and the manufacture of the article; that is, that the origin and manufacture is in the plaintiff. (17 *Barb.*, 608; 7 *Id.*, 226; *Upton's Trade-Marks*, 100, 177; *Fetridge v. Wells*, 13 *How.*, 385). When a trade-mark does indicate the origin and manufacture of the article, the party must have the exclusive right to use the same. (*Upton's Trade-Marks*, 23, 98, 99, 209; 2 *Barb. Ch.*, 103; 2 *Sandf. Ch.*, 599). Plaintiff's right being disputed, the application could not be allowed until they had established a legal right in an action at law. (2 *Sandf. Ch.*, 599, 622; 3 *Abb. Pr.*, 166; 13 *How. Pr.*, 342; 2 *Barb. Ch.*, 101; 3 *Abb. Pr.*, 318; 18 *Barb.*, 64; 24 *Id.*, 163).

RAPALLO, J..

The plaintiffs, composing the firm of Hier and Aldrich, and being engaged in the business of manufacturing cigars in the city of Syracuse, claim to have adopted as a trade-mark, to be placed on boxes of cigars manufactured by them, the word "Pride," and that this trade-mark was infringed by the defendants, who were

also manufacturers of cigars in the same city, doing business under the firm-name of Abrahams & Co.

The trial Court found as facts that the plaintiffs had, for three years before the commencement of the action, adopted and used as their trade-mark, in the manufacture and sale of cigars, the word "Pride," and that the defendants, well knowing the adoption and prior use of said word by the plaintiffs, as a trade-mark for cigars manufactured and sold by the plaintiffs to the public, imitated and used the said word "Pride," on the labels and boxes of cigars manufactured and vended by the defendants, and the said defendants, in violation of plaintiffs' rights, did manufacture and sell cigars under the color of such labels, to the public, whereby the said public were deceived into believing that they were purchasing cigars manufactured by the plaintiffs, and plaintiffs were damaged thereby.

The Court held that the plaintiffs were entitled to protection in the use of their said trade-mark "Pride," and that the defendants were not entitled to use the same, and awarded a perpetual injunction, with a reference to ascertain the damage of the plaintiffs should apply therefor before the entry of judgment. The application was not made, and judgment was entered for a perpetual injunction simply, with costs.

On appeal to the General Term, this judgment was reversed, but on what ground does not appear, as no opinion was delivered. The judgment or order of reversal does not state that it was upon any question of fact, and consequently all that we have to consider is whether any error of law appeals, calling for the reversal.

The facts found clearly justify the judgment rendered. The word "Pride," as applied to cigars, was an arbitrary word, not descriptive of the article, and one which the plaintiffs could lawfully appropriate as a trade-mark. No prior appropriation of it by the defendants, or any one else, is alleged in the pleadings, or found, nor does anything appear in the findings of fact showing the conclusions of law to be erroneous.

The counsel for the respondents argues in support of the reversal, that the defendants' labels, as they appear in the pleadings,

do not resemble the plaintiffs' labels. That the words, pictures and color of the labels are different.

The infringement charged is not an imitation of a symbol or label, but the appropriation of a word.

1. Trade-marks are of two kinds. They may consist of pictures or symbols or a peculiar form and fashion of label, or simply of a word or words, which, in whatever form printed or represented, continue to be the distinguishing mark of the manufacturer who has appropriated it or them, and the name by which his products are known and dealt in. This distinction is recognized in the statutes for the protection of trade-marks as well as in the cases. The Act of 1862, (chap. 304), sections 1 and 3, make it a misdemeanor, punishable by fine and imprisonment to counterfeit or imitate the stamp, brand, wrapper, label or trade-mark of a manufacturer, etc., or to keep for sale goods upon which counterfeit labels or trade-marks are placed. And section 4 makes it a like misdemeanor to affix to any package, any label, etc., which shall designate the article by a word or words, which shall be wholly or in part the same to the eye, or in sound to the ear, as the word or words previously used by any other person to designate goods manufactured by him.

2. Where the trade-mark consists of a picture or symbol, or in any peculiarity in the appearance of the label, the imitation must be such as to amount to a false representation, liable to deceive the public and enable the imitator to pass off his goods as those of the person whose trade-mark is imitated. And when there is such an absence of resemblance that ordinary attention would enable customers to discriminate between the trade-marks of different parties, the Court will not interfere. The case of *Popham v. Cole*, (66 N. Y., 75), is an illustration of this rule. In that case the trade-mark was on lard, and consisted of the figure of a hog, with the name of the manufacturer and the words "prime leaf lard." The words being merely descriptive of the article, could not be appropriated as a trade-mark, but the figure of the hog was claimed to be protected as such. It represented a large, fat, well-conditioned domestic hog, while the alleged infringement represented a small, lank and lean wild boar, and the lettering and

arrangement of the two were entirely different, and it was held that no deceptive imitation was established.

3. But where the trade-mark consists of a word, it may be used by the manufacturer who has appropriated it, in any style of print, or on any form of label, and its use by another in any form is unlawful. The statute requires only that the imitation should be either the same to the eye, or in sound to the ear as the genuine trade-mark, and this accords with the authorities. The goods become known by the name or word by which they have been designated, and not merely by the manner or fashion in which the word is written or printed, or the accessories surrounding it, and the unlawful use of the name or word in any form may be restrained. In the case of the *Akron Cement Company*, (*Newman v. Alvord*, 51 *N. Y.*, 189), the trade-mark consisted of the name "Akron." The genuine label was "Newman's Akron Cement Co., manufactured at Akron, New York. The hydraulic cement known as the Akron water lime." The label held to be an infringement was "Alvord's Onandaga Akron Cement or Water lime, manufactured at Syracuse, New York." The judgment was a perpetual injunction restraining the defendants from using the name "Akron." In the *Congress Spring Co. v. High Rock Spring Co.*, (45 *N. Y.*, 291), the trade-mark was the word "Congress," and was used by the proprietors by branding the words "Congress Water" on their bottles. The infringement was a brand of "High Rock Congress Spring Water" and was restrained. In *Gillett v. Esterbrook*, (48 *N. Y.*, 374), the trade-mark was "303." "Joseph Gillott extra fine" on steel pens, and the pens were known as 303 pens. The figures did not express any size or quality of the pens, but were selected arbitrarily by the plaintiff. The infringement was, "303" "Esterbrook and Co. extra fine," and the pens were put up in boxes similar to those of plaintiff. It was held that the plaintiff had acquired an exclusive right to the use of the figures "303" as a trade-mark.

In the present case the word "Pride" was the trade-mark. Plaintiffs' labels were "Hier & Aldrich's," and beneath that in large letters in a different type "Pride" and beneath that "Havana;" on the inside of the box was a similar label except that

between the firm name and the word "Pride" was the picture of a cigar. Defendant's label was "The Pride of Syracuse," and beneath that "Abrahams & Co." The injunction was only against the use by the defendants of the word "Pride" as a trade-mark on cigars. Its use in connection with different words or names from those in connection with which the plaintiffs use it, does not sanction its being pirated any more than did the like use of the word "Akron," "Congress" or the figures "303" in the cases cited, or a like variation in many others that might be cited. In the Akron cement case the difference between the labels was quite as striking as in the present case.

4. The dissimilarity in the form or accessories of the label can make no difference. The trade-mark consisted in the word simply, and the plaintiffs might have printed it on any form of label they might fancy, without losing the protection of the law. The defendants had no right to adopt it by merely putting it on a label of different fashion from that which the plaintiffs had been in the habit of using.

5. It is also claimed that it was not established that the defendants used plaintiff's trade-mark with intent to defraud, and the case of *Low v. Hall* (47 N. Y., 104) is cited. That was an action for a penalty under section 4 of the Act of 1862, chapter 306, as amended by section 3 of chapter 209 of the Act of 1863, and by that statute the intent to defraud is made an essential element of the offense. An actual intent to defraud can hardly be deemed necessary to entitle the plaintiffs to restrain the defendants from continuing the unlawful use of the plaintiffs' trade-mark whereby the plaintiffs are sustaining damage. The defendants cannot justly contend that they are entitled to continue to injure the plaintiff's business by acts which are in violation of their legal rights, on the ground that they do not intend to defraud them. The violation of their rights is in legal contemplation a fraud, and the finding that the defendants, with knowledge of those rights, invaded them and caused them damage, would justify an intent, if one were necessary, that they did so with intent to defraud.

6. The only other points made by respondent's counsel are that the finding that the plaintiffs had adopted the word "Pride" as their trade-mark is unsupported by evidence, because their trade-mark, if any, was "Hier & Aldrich's Pride" with the figure of a cigar, and that the plaintiffs were not entitled to an injunction because their right was disputed and the injunction could not be allowed until they had established a legal right in an action at law. The first point has already been answered, and the second is not sustained by the authorities, but is in conflict with the cases already referred to.

The order of the General Term should be reversed and the judgment at Special Term affirmed, with costs.

All concur.

Order reversed, and judgment affirmed.

Joseph Dixon Crucible Co. *vs.* Benham.

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CIRCUIT COURT UNITED STATES, DISTRICT
OF CONNECTICUT. IN EQUITY.

JOSEPH DIXON CRUCIBLE COMPANY*vs.*BENHAM.

DECIDED 22 NOVEMBER, 1880.

REPORTED 4 FEDERAL REP., 527.

“Dixon Stove Polish.”

TRADE-MARK—WRAPPERS AND LABELS—STOVE POLISH.

Imitation of wrappers, labels, arrangement of printed characters, and language on wrappers and labels. **Held:**

That there was a conscious attempt to imitate the form in which the successful article had been presented to the public. Injunction granted against the use or imitation, colorable or otherwise, of the plaintiff's wrappers, labels or trade-mark.

Morris W. Seymour, for plaintiff.*H. C. Baldwin*, for defendant.

SHIPMAN, D. J.:

This is a bill in equity, brought by a citizen of the State of New Jersey against a citizen of the State of Connecticut, to restrain the defendant from the use of the plaintiff's trade-mark, and for an account. The trade-mark had never been registered in pursuance of any Act of Congress.

Joseph Dixon commenced the manufacture of stove polish in Taunton, Massachusetts, at least as early as in the year 1840, and was engaged in the business until 1868, either alone or as a member of the firm of Joseph Dixon & Co. He removed to Jersey City, in the State of New Jersey about the year 1849. The plaintiff corporation was formed in 1868, and has been continuously manufacturing said article to a large extent.

At a certain time during the period (the precise time being the only matter in dispute) Mr. Dixon commenced to put up his stove polish in elongated cubes, wrapped about by a blue paper wrapper, with printing thereon in black ink, surrounded by a heavy, double black rule or border. The ends of the wrapper were held in place by a yellow label covering the ends of the cube, with printing thereon in black also, surrounded by a double black rule. The same form, style, language, and appearance of the cube, wrapper, and label have been continued to the present time, except that the word "prepared" was substituted for "pure" in the year 1851 or 1852, and the necessary changes of the name of the manufacturers have been made. *Fac similes* of the present styles of wrapper and label, with the printed matter thereon, are given in the bill.

The answer denies only the priority of the use of the trade-mark by the plaintiff. Slight evidence of the truth of the allegations, which were not denied, was given by the plaintiff; but it may be considered as proved that large amounts of money have been spent by the plaintiff and its predecessors in the manufacture of the article contained in this kind of wrapper; that the article has attained an established and high character, and that its form and appearance are well known to the public. The wrappers and label, and the arrangement of the printed characters, and the language of the wrappers and labels, have become a well-known

trade-mark, indicating to all purchasers that the article which is contained in the wrappers is the Dixon polish, and is made by the plaintiff. The good-will of the business, and the right to the exclusive use of the trade-mark, are valuable to the plaintiff. Joseph Dixon duly and legally assigned and transferred all his rights in the trade-mark to the plaintiff.

The defendant, a manufacturer of stove polish, under the name of the New England Lead Works has, since 1876 or 1877, put up his article in wrappers and labels almost identical in appearance, arrangement, style of printing, and language with the plaintiff's wrappers and labels, except the necessary changes of name and address. It is not denied that two wrappers and labels are substantially identical. The question in the case is as to priority of use. The defendant contends that he has continuously used substantially the same form and style since 1853, and that the adoption of this style by Mr. Dixon was after that date.

The plaintiff's theory is that it has satisfactorily shown that Dixon commenced the use of this trade-mark at least as early as 1847. The defendant's theory is that he commenced the manufacture of stove polish in the year 1844, and that in 1853, and before Dixon's use of the wrapper, he began to put up his article in elongated cubes, in a blue wrapper, with a yellow label, under the name of the Straitsville East India Lead Works; that, with the exception of the years between 1863 and 1867, when he was engaged in other business, he continued the use of these wrappers and labels until 1876 or 1877, when he changed to the present style, and adopted the name of the New England Lead Works, and inserted his own name as proprietor.

Mr. Benham has kept a country store in Straitsville, a village in the town of Naugatuck, and has had from \$500 to \$1000, invested in the stove-polish business. It is manifest that the bulk of the product having the "East India" label was sold to peddlers, as this article was not known to the trade. He testifies, in answer to the question "Who composed the printed matter on your first label on the cube?" "I am not certain; I think Giles (Josiah Giles, a printer in Hartford) got the label up. I left it

with him to get the label up. It was either him or a man named Hurlburt."

He further testifies, in substance, that this wrapper was used till 1876 or 1877, when he changed to the New England Lead Works Wrapper. The printing was done by the Waterbury Printing Company. In answer to the question, "Did you send them a copy from which you instructed them to print a certain number of labels?" He said: "I do not know whether I took up one of Exhibit A, (the East India wrapper), or sent them one when I made the change; that is, whether I took up a package like Exhibit A, or took up a label or sent them one."

It is clearly proved that in the latter part of 1876, the Waterbury Printing Company made for the defendant as near an imitation of the plaintiff's wrapper and label as was possible, with the necessary alteration of names, and that the Dixon trade-mark was furnished by some one to the printing company for that purpose. Indeed, it is manifest from a comparison of the two wrappers that one was copied from the other. There is not so close a resemblance between the latter and the wrapper of the New England Lead Works. The "directions" are entirely different. But it is apparent, from reading the descriptions of the polish which are printed on each wrapper, that the two had but one author; they are almost identical. Did Dixon copy from Benham, or did Benham copy from Dixon? It is sufficiently established that Dixon commenced the use of his wrapper as early as in 1848. Benham does not claim to have commenced until 1853. I have no doubt that the mind and the hand which prepared the Benham wrapper for the press in 1835 used the Dixon wrapper as a pattern, and that there was a conscious attempt to imitate the form in which the successful article had been presented to the public. It did not appear that the plaintiff was chargeable with laches after it discovered the defendant's wrappers and labels.

Let there be a decree for an injunction against the use or imitation, colorable or otherwise, of the plaintiff's wrappers, labels, or trade-mark, and for an accounting.

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CIRCUIT COURT UNITED STATES, EASTERN
DISTRICT OF MISSOURI. IN EQUITY.

SINGER MANUFACTURING COMPANY

vs.

STANAGE.

DECIDED MARCH, 1881.

REPORTED 6 FEDERAL REP., 279.

“Singer Sewing Machine” Case.

1. TRADE-MARK—PATENTED ARTICLE—SPECIFIC DESIGNATION.—Where a word indicates a patented machine of peculiar mechanism, such word cannot be protected as a trade-mark upon the expiration of the patent.
2. SAME—“SINGER” MACHINE.—Certain patented sewing machines were known as the “Singer” machines. HELD:

That the word “Singer” even if a trade-mark became common property upon the expiration of the patent.

Taylor & Pollard, for plaintiff.*Marshall & Barclay*, for defendant.

TREAT, D. J.:

THIS is a suit for an alleged violation of plaintiff's trade-mark. It seems that the plaintiff has pursued its controversy on both

sides of the Atlantic, generally with success. The decisions of the foreign and American Courts have been cited and examined. While reference is made in many of them to actual or supposed patents, issued and expired, no one of said cases, except that by Judge Drummond, states with directness what should be the turning point in the controversy. The case of the plaintiff against Wilson (3 *Appeal Cases*, 376), turned more on questions of practice than on the rules by which the rights of the parties were to be ultimately determined. That case and others in England, and the great number of cases in American Courts, (notably, *Manuf'g Co. v. Trainer*, 101 U. S., 51), ought to make clear the rules controlling this litigation. It would be tedious and unprofitable to review the many authorities cited. In the case from the English House of Lords, (*supra*), and in the case (*supra*) from the United States Supreme Court, there were differing opinions on the merits. Each of the many cases cited has its distinctive peculiarities, and, while all Courts agree that property interests in trade-marks should be protected, there is a strange diversity of reasoning as to the true basis on which such interests should rest.

It is not necessary for the solution of the rights of parties litigant in this suit to enter upon so wide a field of analysis or discussion. At the opening of the argument, this Court directed the attention of counsel to what seemed to be a matter of large moment, but as the pleadings and evidence had been prepared in the light of leading English and American cases, the cause progressed at great length, calling for the remark that despite these cases a large amount of irrelevant testimony was presented; or rather, that while counsel had been diligent in their preparation, not knowing what views this Court might entertain, much of the evidence seemed to apply rather to infringements of patents than a violation of trade-marks. Still, many of the leading cases have taken that course, to what seems to be a confusion of rights.

This case furnishes an apt illustration. The plaintiff and its predecessors had, in connection with others, through patents, a monopoly as to certain sewing machines known as the "Singer" machines. When these patents expired every one had an equal right to make and vend such machines. If the patentees or their

assignees could assert successfully an exclusive right to the name "Singer" as a trade-mark, they would practically extend the patent indefinitely. The peculiar machine which had become known to the public under that name during the life of the patents was so known as a specified article of manufacture, and at the expiration of the patent would still be known on the market by that designation, irrespective of the name of the special manufacturer. No one had an exclusive right to the use of the generic name. If one wished to acquire a trade-mark in connection therewith he could do so, distinctively. The plaintiff accordingly adopted specific devices, including its own name, whereby its products could be distinguished. The defendant adopted a different device, with the name of his manufacturer, "Stewart," and advertised the sale sometimes of the "Stewart" machines, and sometimes of the "Stewart Singer" machines, attaching his name as "late general manager of the Singer Manufacturing Co."

It is contended that, although he and others had an indubitable right to manufacture and sell the "Singer" machines—that is, machines known as such in the market—so far as their mechanism is concerned, they had no right to advertise or sell them by their right names, with or without a prefix. How is it that the plaintiff corporation acquired a monopoly of the *name*, whereby it could exclude, after the expiration of the patent, all others from making or vending the machines under the only name known to the public?

A review of the many cases cited leads to the following conclusions:

First. That when a patented article is known in the market by any specific designation, whether of the name of the patentee or otherwise, every person, at the expiration of the patent, has a right to manufacture and vend the same under the designation thereof by which it was known to the public.

Second. That the original patentee or his assignees have no right to the exclusive use of said designation as a trade-mark. Their rights were under the patent, and expired with it.

Third. If a corporation or person wished to establish a trade-mark or name, indicative of its own special manufacture of such

a machine or product, the right must grow up, just as all other rights of the kind are established—by use and acquiescence. Thus, as every one at the expiration of the patent had a clear right to manufacture and vend what was known as the “Singer” sewing machine, the plaintiff could acquire no exclusive right to the name “Singer,” but could by proper trade-mark appropriate to itself names or devices indicating its own manufacture of such machines.

Fourth. The plaintiff did adopt special names and devices to indicate what it put on the market as its manufacture, viz., “The Singer Manufacturing Company,” imprinted on the shield and arm of the machine, etc. The defendant placed on its shield and arm the words, “The Henry Stewart’s Manufacturing Co.,” with another device. Now, as each corporation had an equal right to make and vend that class of machines known in the market as “Singer” machines, and as the defendant used neither the name nor device of the plaintiff, there is no violation of the plaintiff’s trade-mark or name. While the Courts are prompt to protect the property rights of any skilled person in his trade-mark or name, whereby he may have in the market the benefit of his skill and reputation, they must also guard against every effort to secure a monopoly not arising therefrom. When a marketable product is publicly known and designated by a generic name, no one should be permitted to shut out all just competition by claiming the exclusive right to use that name. If there is a peculiar excellence, real or supposed, in his manufacture, he can establish by his trade-mark or name the right to protection against the piracy thereof; but he cannot go further and insist that, independent of his skill or manufacture, he can cover by his trade-mark or name whatever may properly distinguish the common article which every one has a right to make or vend.

Fifth. Inasmuch as the word “Singer” indicates a machine of peculiar mechanism, and every one has a right to make such a machine, the word “Singer” attached to such machines is common property.

Sixth. The distinctive names and devices of the plaintiff corporation were not used by the defendant, and no one of ordinary

intelligence could suppose that the "Stewart" manufacture was the manufacture of the plaintiff. Each had its distinctive and detailed names and devices, so that there was no probability that the machine made by one would be mistaken for the manufacture of the other.

These views dispose of the case, yet it is important to remark that the plaintiff is seeking, after the expiration of one or more patents, to perpetuate a monopoly under the guise of a trade-mark. The propositions involved have undergone so much judicial investigation in transatlantic and cisatlantic Courts, that a summary disposal of the question may seem inadequate to the exigency of the case; yet each of said cases would show, if properly analyzed, that the general rule is admitted by all.

There are many technical objections interposed with respect to evidence offered; yet, giving the objector the largest benefit therefrom, there still remains the clear fact that the plaintiff, even if its assignment covered the name as a trade-mark, (which is very doubtful), is seeking to create a monopoly for the practical extension of a patent beyond its legal term. The plaintiff has established no such right, nor has the defendant consequently violated any of the plaintiff's rights.

The bill will, therefore, be dismissed at plaintiff's cost.

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SUPERIOR COURT OF THE CITY OF NEW
YORK. IN EQUITY.

JOHN THORNTON, ET AL., APPELLANTS,

vs.

ROBERT CROWLEY, RESPONDENT.

DECIDED 7 MARCH, 1881.

REPORTED 47 N. Y. SUP. CT., 527.

“Smith’s Needles.”

TRADE-MARK—INFRINGEMENT OF—WHAT CONSTITUTES.

1. Where the special features of complainant’s trade-mark have been for many years used upon labels of the same character by persons engaged in the same trade, and the appearance of said labels apart from the names, is such as results from an ordinary and rightful use in an appropriate manner, without intention of making by such use, a definite effect of the whole taken together, and these particulars are not so employed by complainants that an original design or combination has resulted which can be perceived by itself apart from its components, and the labels of defendants could be mistaken for those of plaintiffs only on account of a resemblance in these particulars used in an ordinary and rightful manner, and the name of defendant appearing prominently on his labels and is conspicuously different from the firm-name upon plaintiff’s labels. **Held:**

That defendant was entitled to a dismissal of the complaint on the merit.

APPEAL from judgment dismissing plaintiff's complaint upon the merits.

Cook & Schuck, attorneys, and *Douglas Campbell* and *George C. Lay*, of counsel for appellants.

Albert G. McDonald, attorney, and *Charles W. Sloane*, of counsel, for respondent.

FREEMAN, J.:

This action was brought to restrain the defendant from the use of two labels used by him. The plaintiffs brought it as the representatives of the firm of James Smith & Son, of England, who are manufacturers of needles and whose labels it is claimed the defendant fraudulently simulated.

The complaint alleges, among other things, "that before the needles manufactured by said James Smith & Son are distributed to dealers in the United States, by the plaintiffs, they are usually packed into small packets or wrappers of twenty-five needles, each bearing the firm-name of James Smith & Son, as a trade-mark, printed, pressed or stamped on labels of two colors, red and blue, etc., etc., fac similes of which labels are annexed; that such needles are known throughout the United States by two principal colors of packages or wrappers, viz: red and blue, the red label containing a crown-stamped or pressed in said label, with the words and letters 'Jas. Smith & Son's Genuine Drill'd Ey'd Sharps (*) warranted, John Thornton,' running from No. 1 to 12, separate and assorted; and the blue label containing the royal British coat of arms printed in black ink, with the words or letters 'Jas. Smith & Son's Improv'd Drill'd Ey'd Sharps,' running from No. 1 to 12, separate and assorted; 'warranted, John Thornton,' all of which appears more plainly and fully in the foregoing labels forming a part of this complaint; and that the needles of the other manufacturers have never been enclosed in packets bearing labels of precisely the shade of colors nor the design of said labels and the printing and impression thereon, and adopted by said

James Smith & Son as aforesaid, except in a simulated form by the defendant; Robert Crowley, as hereafter more particularly referred to, and others."

The Court at General Term, said: "It is now so well settled that it is no longer necessary to cite authorities, that a trade-mark may consist of marks, forms, symbols or even words in common use, provided they are used in such a way as to designate the true origin or ownership of the article and have not already been appropriated by others in connection with the same article. In case of prior appropriation of part, or parts, by others, the combination of the plaintiff, as a whole, must be new, and intended and calculated to designate origin or ownership. No right accrues to the use of mere generic words used to designate the article or its quality.

"In every case in which the interference of a Court of Equity is sought for the protection of a label or trade-mark, the plaintiff must, first of all things, bring himself within these rules. When he has done that, the Court, upon proof of infringement, will liberally protect him, not because he has any property in the word or words of the combination, but upon the principle that defendant's imitation constitutes a fraud upon one who has established a trade-mark and a reputation. Plaintiffs' prior and exclusive right to the use having been established, the test is whether the imitation is calculated to deceive purchasers. Upon the question of tendency to deceive, it may not be necessary to show that a person giving ordinary attention, or any attention, is likely to be misled. Perhaps it is sufficient that the careless and unwary may be misled. Upon this point the authorities are not uniform. But before the Court can be called upon to apply any test at all, plaintiffs' prior and exclusive right must be clearly established.

"In the case at bar, the plaintiffs failed to establish such prior and exclusive right as was necessary to sustain the action."

After consideration of the testimony, the Court further said: "Upon this state of facts the learned Chief Justice who tried the case below, was correct in finding:

"*First.* The particulars, except the firm-name of James Smith & Son, and the name of agent, which make up the labels used by

the plaintiffs and set forth in the complaint, have been used for many years in labels of the character as such labels of the plaintiffs commonly and rightfully by persons engaged in the needle trade.

“ ‘*Second.* The appearance of such labels of the plaintiffs apart from the names aforesaid is such an appearance only as results from an ordinary and rightful use of these particulars in an appropriate manner without the intention of making by such use a definite effect of the whole taken together.

“ ‘*Third.* These particulars are not so employed in such labels of plaintiffs that an original design or combination has resulted which can be perceived and considered by itself apart from its components.

“ ‘*Fourth.* The labels of the defendant which are set forth in the complaint could be mistaken for the aforesaid labels of the plaintiffs only on account of a resemblance in these particulars used in an ordinary and rightful manner as aforesaid.

“ ‘*Fifth.* The name of defendant's firm appears prominently on his aforesaid labels, in the ordinary mode of observation, would be read first, and is conspicuously different from the firm-name upon the plaintiffs' aforesaid labels.’

“ Upon these findings, the defendant was entitled to a dismissal of the complaint on the merits.” The case of *Walton v. Crowley* (3 *Blatchf.*, 440), is distinguishable in this, that in that case the defendant claimed the privilege of using a label similar to that of James Smith & Son, with the name of Smith at the top, on the ground that a firm of like name existed in this country, needles of which firm he had on sale. It was the use of this name which chiefly caused the Court to order the temporary injunction. The present case is analogous to *Popham v. Wilcox*, (38 *Supr. Ct.* 274; *affirmed* 66 *N. Y.*, 69), and should be determined by the same rule that was applied there.

Judgment affirmed, with costs.

SPEIR, J., concurred.

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IN THE ST. LOUIS COURT OF APPEALS.
IN EQUITY.

H. H. SKINNER, ET AL., RESPONDENTS,

vs.

ANNIE OAKES, ET AL., APPELLANTS.

DECIDED 8 MARCH, 1881.

REPORTED 10 MO. APP., 45.

"Peter Oakes' " Case.

1. A conveyance good *inter partes*, made in fraud of creditors, can only be impeached by the creditors themselves.
2. Affidavits filed in support of a motion for a new trial will not, on appeal, be considered as evidence of anything affecting the merits of the case.
3. A man who voluntarily parts with the right to use his own name as a trade-mark, cannot voluntarily recall it by marrying or carrying on business in his wife's name; nor can she, by marrying him, acquire any higher right to use his name as a trade-mark than he himself had.
4. A trade-mark which consists of the name of a third person, is not such a species of property as can be disconnected from the business with which such person was formerly connected, and sold from man to man.
5. Where the assignee of the naked right to use a trade-name, claims the exclusive right to sell goods bearing this name, he must show that the

name was originally used to designate goods of a certain quality or description, and is being used by him to designate, substantially, goods of the same quality or description, and that the use of the name does not operate to deceive the public into the belief that the goods are made by the man whose name they bear.

6. Where goods are sold and delivered, but owing to a secret contract, the right to a part of the thing sold is subject to be defeated, an innocent purchaser for value takes a title unaffected by the terms of the secret defeasance, of which, owing to the laches of the original vendor, he had no notice.

APPEAL from the St. Louis Circuit Court, BOYLE, J.

W. H. H. Russell and *David Murphy*, for the appellants.

The use of the word "Oakes" wrongs the appellants and is a fraud upon the public, and its use should be enjoined. *Fetridge v. Wells*, 13 *How. Pr.*, 387, 389, 394; *Leather Cloth Co. v. American Leather Cloth Co.*, 11 *H. L. Cas.*, 544, 546; *Upton on Trade-Marks*, 26-53; *Carmichael v. Latimer*, 11 *R. I.*, 407-410; *Little v. Page*, 44 *Mo.*, 412; *Griffin v. Pugh*, 44 *Mo.*, 326. "The good-will of an establishment is an accessory thereto; separate therefrom, it is of no value. And the same rule applies to trade-marks." *Upton on Trade-Marks*, 27; 2 *Pars. on Cons.* (6th ed.), side p. 378, 379; *Kidd v. Johnson*, 10 *Otto*, 620; *Churton v. Douglas*, 1 *Johns. Eng. Ch.*, 176. A party is not entitled to use a proper name as a trade-mark, except in connection with some mark, symbol or device, both of which must be in fact true; and even then there can be no infringement of a trade-mark in the use of it, except by affixing it to articles manufactured or prepared by another, or so simulating it as to cause purchasers to be misled and deceived. *Seixo v. Provezendo*, L. R., 1 Ch., 192; *Browne on Trade-Marks*, sect. 361; *Partridge v. Menck*, *Cox's Trade-Mark Cas.*, 80; *Corwin v. Daly*, *Id.*, 265; *Canal Co. v. Clark*, 13 *Wall.*, 323-326; 2 *Pars. on Con.* (6th Ed.), 257; *Meneely v. Meneely*, 62 *N. Y.*, 431 *et seq.*; *Fleming v. McLean*, 6 *Otto*, 252. A person who, in connection with his business, sells the right to use the *fac simile* of his autograph as a manufacturer's mark, to be affixed to his goods, may, in the absence of a covenant restraining

him from again engaging in the same business, at once engage therein, and in the same street, and even the next door, and use his own name. *Canal Co. v. Clark*, 13 *Wall.*, 323; *Churton v. Douglas*, 1 *Johns. Eng. Ch.*, 176; *Crutwell v. Lye*, 17 *Ves.*, 335; *Hall v. Barrows*, 10 *Jur.*, (U. S.), 55; *Williams on Pers. Prop.*, 258; *Howe v. Searing, Cox's Trade-Mark Cas.*, 253. The agreement between Probasco and Oakes, either in its several parts or as an entire contract, shows the intent of the parties to be that the use of the name "Oakes' Candy" was limited to Probasco as a personal license or privilege only; that in consideration of the continuation of Oakes as the manufacturer, its use was lawful; but not after that connection ceased, or, at the farthest, after Probasco abandoned the business and the establishment ceased to have an existence. And it matters not whether this determination of the license or privilege was the result of the agreement or by operation of law. *Upton on Trade-Marks*, 80; 2 *Pars. on Con.* (6th Ed.), side p., 664; *Curtis on Pat.*, 197; *Kidd v. Johnson*, 10 *Otto*, 618; *Howe v. Searing, Cox's Trade-Mark Cas.*, 244.

Dryden & Dryden, with *Harris Baldwin*, for the respondents.

It is competent for a person to so sell his name as to deprive himself of the right to use it in his own business, and to give that right to another. *Probasco v. Bouyon*, 1 *Mo. App.*, 244; *Stonebreaker v. Stonebreaker*, 33 *Md.*, 257, 268; *Cox's Trade-Mark Cas.*, 596; *Codd. Dig. of Trade-Marks*, sec. 611; *Ayer v. Hall*, 3 *Brews.*, 512, 513; *Dixon Crucible Co. v. Guggenheim*, 2 *Brews.*, 330-332. Peter Oakes has not, nor have he and his co-defendants combined, the right to the name "Oakes" in the manufacture and sale of candy in this city, because he has bound himself by a valid agreement to abstain from its use in that connection. *Probasco v. Bouyon*, 1 *Mo. App.*, 246; *Crutwell v. Lye*, 17 *Ves.*, 346. If a substantial part of a trade-mark has been pirated, relief will be granted. *Filley v. Fassett*, 44 *Mo.*, 178. If the trade-marks are simulated in such manner as will probably deceive customers or patrons, the piracy will be checked at once by injunction. *Churton v. Douglas*, 1 *Johns. Eng. Ch.*, 184; *Clark v. Clark*,

Cox's Trade-Mark Cas., 206; *Brooklyn White Lead Co. v. Masury, Id.*, 210; *Bradley v. Norton, Id.*, 331.

THOMPSON, J., delivered the opinion of the Court.

This was a suit in equity to restrain an alleged piracy of certain trade-marks, and for an account. It appears that prior to May 17, 1869, Hiram S. Probasco and the defendant, Peter Oakes, were partners, in St. Louis, engaged in the manufacture and sale of candies. On that day they dissolved partnership, Oakes selling out to Probasco, by a contract of sale duly acknowledged and recorded, which conveyed to Probasco, his executors, administrators, and assigns, all of the Oakes interest in the partnership assets, and "also the good-will of the business and name of the firm of Probasco & Oakes, and the exclusive right to make and sell Oakes' candy, and to use the name thereof;" the contract further reciting, "it being the intent hereof to convey to said Probasco all my interest in all the property and assets of said firm of Probasco & Oakes, and all the franchises thereof."

This statement of the facts brings us to the point in the history of these transactions in which the rights of Probasco under the contract were determined in this Court, in the suit of *Probasco v. Bouyon*, 1 *Mo. App.*, 241. The rights there declared to exist in Probasco under this contract are the same rights claimed by the plaintiffs in this suit, derived, as is alleged, from Probasco, by two subsequent sales and transfers. It was there adjudged that by the above instrument of sale Probasco acquired the rights of the previous firm of Probasco & Oakes to the use of the name of "Oakes" in the manufacture and vending of the candies which Probasco & Oakes had previously manufactured and sold under that name. It was also held that Oakes could so sell his name as to deprive himself of the right to use it for his own manufacture, and give that right to another, under the circumstances of the case as shown in evidence. It was further held, that "Oakes may make and sell candy, but not under the name, the use of which he has, for this purpose, sold. He may make and sell the very same candies, and is not obliged to conceal the fact that they are made and sold by him; but he may not, in St. Louis, advertise

them. either by sign over his shop door, or by label on the boxes in which they are packed, or in any other general and public way, as Oakes' candies."

We are not asked to review this decision, or to modify it; if we were, we could not do so consistently with well-settled rules of law, adherence to which is of the very highest importance. That decision, not having been reversed by a higher tribunal, is not only a rule of property generally, for the government of other like cases, should any arise, but it is in a peculiar sense the law of this particular case. It is a solemn adjudication of the rights of Probasco under the contract in question, on the faith of which the two sales under and by virtue of which the plaintiff's claim must be taken to have been made, for they were both made subsequently to its rendition. The books abound in cases which would support the conclusion reached by this Court in that case, could it be reopened for controversy.

On the twenty-eighth day of May, 1877, after the rights of Probasco in the premises had thus been settled by this Court, he sold out the business to W. J. Hammon, and executed to him a separate bill of sale, in which he undertook to convey to him, and, if the instrument is good, did convey to him, the trade-mark, name, good-will, and reputation connected with the manufacture, production and sale of certain candies and confections, commonly known and called "Oakes' Candies," "Oakes' Home-Made Candies," and "Oakes' Pure Home-Made Candies," reciting that such trade-mark, name, good-will, and reputation had been theretofore purchased by him from Peter Oakes, and concluding with the words, "I hereby sell and convey to said W. J. Hammon all the rights and privileges connected, as aforesaid, with such candies and confections, which I may have, or did at any time derive from said Peter Oakes."

An attempt was made, under objection, to prove that this was not a *bona fide* sale, but merely a fraudulent conveyance, designed to hinder and delay the creditors of Probasco. This evidence should have been excluded; but its admission worked no harm to the plaintiffs, for the Court, in finding the issues in their favor must have disregarded it. It was wholly immaterial that this

conveyance may have been made to hinder, delay, and defraud the creditors of Probasco.

1. It is well settled that a conveyance in fraud of creditors can only be impeached by the creditors themselves. It is good as between the parties and their privies. As no creditors of Probasco, nor any one claiming rights under such creditors of Probasco, are before the Court complaining of this sale, it is as good, for the purposes of this suit, as though Hammon had purchased of Probasco *bona fide*, and at full value.

A question of more importance is presented in a fact which did not appear in the suit of *Probasco v. Bouyon*. On the same day (May 17, 1879) that Oakes executed and delivered to Probasco the bill of sale above quoted from, a further agreement was entered into, on a separate sheet of paper, between Oakes and Probasco, delivered to Oakes and retained by him, and never recorded, which provided that Oakes should work for Probasco for two years at manufacturing candy, at a stated salary, and which also contained this provision. "And the said Probasco, on his part, covenants with the said Oakes, that should he, said Probasco, sell out his said business of candy making and selling within said two years, or at any other time, then said Oakes shall be released from all obligations under this agreement, and the right and privilege of making and selling 'Oakes' Candy,' and of using said name, 'Oakes,' shall revert to said Oakes."

The testimony is, that when Probasco sold to Hammon the rights in reference to "Oakes' Candy" which he had acquired from Oakes under the contract of May 23, 1877, Hammon had no knowledge of this agreement, and that when Hammon undertook to sell the same rights to Skinner, Skinner had no knowledge of it.

2. The affidavit to the contrary that Oakes filed, on motion for a new trial, is not evidence: for reasons which will be stated hereafter. The position of the defendants, as we understand it, is that these two contracts, the bill of sale, and this agreement made on the same day between Oakes and Probasco, were parts of the same contract, relating to the same subject-matter; that they are to be taken and construed together, and treated as though they

had been drawn up on the same piece of paper and embodied in one instrument; that the operation of these two instruments was no more than to convey to Probasco a right in the manufacture and sale of "Oakes' Candy" personal to himself, and which he could not convey to another; that Probasco could not convey to Hammon, nor Hammon to Skinner, any higher rights than Probasco in fact acquired from Oakes under the two instruments, taken together; and that, by the terms of the agreement, whenever Probasco should undertake to sell his rights under the contract, they should revert to Oakes. And it is urged that the effect of these two instruments was nothing more than to make a conditional sale of the right to manufacture and vend "Oakes' Candy," so as to bring the case within the rule laid down in the following cases by the Supreme Court of this State: *Parmlee v. Catherwood*, 36 Mo., 480; *Little v. Page*, 44 Mo., 412; *Griffin v. Pugh*, 44 Mo., 326, and *Ridgeway v. Kennedy*, 52 Mo., 24.

These cases are not authority for the position taken. They go no further than to hold that where personal property is sold and delivered upon agreement that the title is not to pass *until the purchase money is paid*, until that condition is performed, the vendor, if guilty of no laches, can recover it from an innocent purchaser of the vendee. This rule, it may be observed, was found so productive of fraud, so injurious to innocent purchasers, and of such a tendency to obstruct the free transfer of personal property, that in 1877 it was repealed by the Legislature, 1 Rev. Stats., sec. 2505. It was, however, a rule of property at the time the sale of Oakes to Probasco was made; and if we could see that it governed the contract in question, we should not hesitate so to declare.

6. But there is a wide distinction between a sale which is made conditional upon the payment of the purchase-money, and a sale—such as the one in question—where the purchase-money is paid, the vendee put in possession, and allowed to remain in such possession for a long time, but where his right to a part of the thing sold is subject to be defeated by an event which may never occur, under a secret contract not embodied in the recorded bill of sale or known to the subsequent purchaser. If we look to the

equities of the case, there can be no room for argument. Oakes should have been more careful to put this contract of defeasance in the bill of sale itself, or else to notify Hammon and Skinner of it before they purchased. If we look simply to the authority of the cases just cited, they do not govern; for there the title did not pass to the vendee, while here it did pass.

2. It is seriously urged in the defendants' supplemental brief, that it is shown by the affidavits of Oakes and Sickles in support of the defendant's motion for a new trial that Hammon was personally served with a written notice of this agreement, in August, 1877, just after the sale of Probasco to Hammon. It is scarcely necessary to suggest that no *ex parte* affidavit filed in support of a motion for a new trial can be looked to as evidence of anything affecting the merits of the case. Parties must produce their testimony in such a manner as to afford the other side the right of cross-examination. Affidavits in support of a new trial, when they relate to matters which may have materially affected the rights of the party moving for the new trial, and which do not appear on the records of the Court, and are unknown to the Court itself, are admissible. That a party has been surprised by testimony introduced against him, or that he has discovered new evidence on a material point, or that a juror has been guilty of misconduct, are instances of this. But we know of no rule of practice under which a party can be permitted to file affidavits of matters directly affecting the merits of the case and the issues which have been tried, of which he might have introduced evidence at the trial, so as to make the evidence to overthrow the judgment which has been rendered. The affidavits of Oakes and Sickles should have been stricken from the files. But even if these affidavits were evidence, they would have no effect, for they merely show that *after* Hammon bought the rights in controversy from Probasco he was notified of the secret agreement. This, therefore, would not affect his title, nor prevent him from conveying a good title to Skinner, even though Skinner, at or before his purchase of the right, had known of the agreement.

3. A point is made in behalf of the defendant Annie Oakes, that before the plaintiff's acquired the alleged right to use the

name of Oakes in the manufacture of candies, she, by marrying with Oakes, had acquired a right to use his name in the same connection, of which the plaintiffs cannot lawfully deprive her. There is nothing in this point except novelty. Peter Oakes could not confer upon Annie McLaughlin, by marrying her, any higher rights in the use of his own name than he himself had. A son cannot acquire from his father the right to use his father's name as a trade-mark, if the father had parted with the right by contract. (*Filkins v. Blackman*, 13 *Blatch.*, 440), and we do not see how a wife could stand in a better position as to the name of her husband.

There remain two questions in the case, either of which is of more serious import. There is nothing in the record to show that Hammon sold to Skinner any property whatever, except the naked right to use the trade-marks in question.

4. The first question therefore, is, whether a trade-mark which consists of the name of a person is such a species of property that it can be disconnected from the business with which such person was formerly connected, and sold from man to man. The second is, whether the use of the name of the third person in such a way does not involve such a fraud upon the public as will prevent a Court of Equity from protecting it.

The first question cannot be answered intelligibly without some consideration of the grounds upon which Courts of Equity proceed in protecting trade-marks.

4. The principle on which all cases on the subject of trade-marks unite is, that one man will not be permitted, by imitating the distinctive name or mark used by another person to designate articles of the latter's manufacture, to impose articles of his his own manufacture upon the public as the articles of the former. The cases so holding rest upon two considerations: First, that it would be a fraud on the rights of the former person thus to permit his trade-mark to be imitated; second, that it would also be a fraud on the public. See *Gilman v. Hunnewell*, 122 *Mass.*, 139; *McLean v. Fleming*, 96 *U. S.* 245, 251; *Colman v. Crump*, 70 *N. Y.*, 573; *Fairbanks v. Jacobus*, 14 *Blatch.*, 337; *Devlin v. Devlin*, 67 *Barb.*, 290; *Amoskeag Manuf. Co.*

v. Garner, 54 *How. Pr.*, 297; *Curtis v. Bryan*, 2 *Daly*, 312; *S. C.*, 36 *How. Pr.*, 33; *Amoskeag Manuf. Co. v. Spear*, 2 *Duer*, 607; *Peterson v. Humphrey*, 4 *Abb. Pr.*, 394; *Howe v. Howe Machine Co.*, 50 *Barb.*, 236; *Sykes v. Sykes*, 3 *Barn. & Cress.*, 541; *Burgess v. Burgess*, 3 *De G., M. & G.*, 896, 904; *Burke v. Cassin*, 45 *Cal.*, 467; *Emerson v. Badger*, 101 *Mass.*, 82; *Ellis v. Zeilin*, 42 *Ga.*, 91; *Lord Kingsdown, in Leather Cloth Co. v. American Leather Cloth Co.*, 11 *H. L. Cas.*, 538; *Perry v. Truefitt*, 6 *Beav.*, 66; *Walton v. Crowley*, 3 *Blatch.*, 448; *Dixon Crucible Co. v. Guggenheim*, 1 *Cox's Trade-M. Cas.*, 559.

The Courts have proceeded upon the twofold principle, that the public have a right to know that goods which bear the signature or mark of a particular manufacturer or vendor are in fact the goods of such manufacturer or vendor, and that the manufacturer or vendor of such goods has a right to any advantage which may accrue to him from the public knowing that fact. *Congress Spring Co. v. Rock Spring Co.*, 45 *N. Y.*, 291; *Glenn & Hall Manuf. Co. v. Hall*, 61 *N. Y.*, 226, 229. In the early English cases it was laid down that Courts of Equity, in protecting trade-marks, proceed on the idea of fraud, and not on the idea of property; and this doctrine found its way even into a recent decision of Sir W. Page Wood (Lord Hatherley), *Collins Company v. Brown*, 3 *Kay & J.*, 426. But, upon whatever idea the Courts proceeded, as soon as their decisions established in a particular individual a right, exclusive as against the world, to use a particular label or a particular advertising device whereby trade was attracted to him, that right at once became a thing of value, and hence, property, in a sense more strict than that in which many other incorporeal rights, such as the elective franchise or the right of presentation to a vacant benefice, have been regarded as property. Moreover, the Courts of Chancery were often appealed to, successfully, to enjoin the infringement of trade-marks in cases where no fraud was intended, and where the relief could hence be granted only on the idea of property. Accordingly, it has become a settled doctrine of the English and American Courts that trade-marks are protected, not exclusively on the ground of fraud, but also on the ground of property. *Hall v. Barrows*, 4 *De G.*,

J. & S. 150, 158; *Filley v. Fassett*, 44 *Mo.*, 168, 177; *Gilman v. Hunnewell*, 122 *Mass.* 139; *Ainsworth v. Walmsley*, *L. R.*, 1 *Eq.*, 518; *Maxwell v. Hogg*, *L. R.*, 2 *Ch. App.*, 314.

There are some *quasi*-property rights, such as the elective franchise, which are incapable of assignment. But it would be obviously unjust so to restrict the right to use a trade-mark. The advantages which accrue from the use of a particular trade-mark or advertising device are often the result of a life-time of integrity, skill, perseverance, and business capacity. Ought it to be held that a right so valuable should die with the person who created it, it being incapable of assignment, when, by reason of age, or other considerations, he might desire to cease using it? The custom of trade, which solves many questions in advance of the Courts, has declared that this should not be; and the Courts, in adopting the view that the right to use a trade-mark is assignable, did no more than declare a result which followed from the concession that it was property; for the *jus disponendi* is embodied in the very idea of property. It is, hence settled law that the right to use the trade-mark is not a mere personal privilege, but that, within certain limits, it is capable of being bought and sold as other property. "A trade-mark," says Strong, J., "like the good-will of a store or manufacturing establishment, is a subject of commerce, and it has been many times held entitled to protection at the suit of vendees." *Fulton v. Sellers*, 4 *Brews.*, 42. See also *Berry v. Bedford*, 33 *L. J.*, (Ch.), 465; *Hall v. Barrows*, 33 *L. J.*, (Ch.), 204; *Glenn & Hall Manuf. Co. v. Hall*, 61 *N. Y.*, 226; *Peltz v. Eichele*, 62 *Mo.*, 171.

A trade-mark may, and often does, consist in the name of a person or partnership firm; and the exclusive use of such trade-mark is upheld, with this limitation, that another person of the same name is not to be prevented from using his name in the same way, provided there are no special circumstances—which make it inequitable for him to do so. *Meneely v. Meneely*, 62 *N. Y.*, 427; *Wolfe v. Burke*, 7 *Lans.*, 151; *Probasco v. Bouyon*, 1 *Mo. App.*, 241.

But where the trade-mark consists of a name, how far it is capable of assignment is a more difficult question. We think that

the answer to this question depends upon the effect which the use of the name in each particular instance is shown to have upon the minds of the public. If it leads the public to believe that the particular goods are, in fact, made by the person whose name is thus stamped upon them, or in whose name they are advertised, whereas they are, in fact, made by another person, then such a use of the name will not be protected by the Courts; for to do so would be to protect the perpetration of a fraud upon the public. Thus, if an author were to assign to another the privilege of publishing books with his name upon their title-page, or if a painter were to sell to another the privilege of placing the former's signature on pictures painted by the latter, it cannot for a moment be supposed that any Court would protect such a supposed right, even as against the original assignor. This point is absolutely clear, both upon principle and authority. *Leather Cloth Co. v. American Leather Cloth Co.*, 11 *H. L. Cas.*, 523, 534, 544; *Samuel v. Berger*, 4 *Abb. Pr.*, 88.

But there are many cases where the Courts uphold the use of a name as a trade-mark, trade-name, or advertising engaged in the trade, and although in order to do so it is necessary to enjoin the person whose name is so used, from a similar use of the name. These cases, so far as I have been able to discover and classify them, are twofold: First, where the business is sold together with the good-will thereof, in which case, either by the usages of trade or by the express contract of the parties, the name passes with the business to the assignee. In such cases, in view of the Courts, no deception is, in fact, practiced upon the public; since, in conformity with the usages of trade, the names used in the style of a business firm are not understood by the public as necessarily implying that persons of that name are actually members of the firm. Such was the case of *Churton v. Douglass*, *Johns. Eng. Ch.*, 174, where John Douglass, of the firm of John Douglass & Co., having sold out his interest in the property and good-will of the firm, was enjoined from taking in other partners and setting up a similar business near the old place, under the same firm-name of John Douglass & Co. Such, also, was *Dixon Crucible Company v. Guggenheim*, 2 *Brews.*, 321; *S. C.* 1 *Cox's Trade-Mark Cas.*, 559;

and such was this case, as it stood between Probasco and Oakes, as will be seen by reference to *Probasco v. Bouyon*, 1 *Mo. App.*, 241.

4. Some Courts, indeed, have gone so far as to assimilate a trade-mark to the species of property known as good-will, inso-much as to hold that it is not vendible except as a part of the establishment or business with which it was originally connected. *Leather Cloth Co. v. American Leather Cloth Co.*, *supra*; *Witt-haus v. Mattfeldt*, 44 *Md.*, 303, 306.

But it is obvious that it cannot in all cases be so restricted; for there is a second class of cases, where the name is merely used as an adjective to identify goods of a particular description, or articles which embody a particular result in chemistry or manufacture. In these cases, the right to use the name may be sold in connection with what is called the right to manufacture and vend the goods. But since there can be no exclusive right in any one to manufacture or vend goods which are not patented, such a contract of sale amounts to nothing more than that the vendee may, if he chooses to make the same goods, call them by the name of the original inventor or maker, and that such inventor or maker will not in any manner obstruct him in so doing. To this class of cases belong those cases which uphold the exclusive right to make and vend a proprietary medicine which has become known by the name of the vendor. *Fulton v. Sellers*, 4 *Brews.*, 42, *Filkins v. Blackman*; 13 *Blatch.*, 440; *McLean v. Fleming*, 96 *U. S.*, 245, 251. In these cases, the name thus used is but an adjective of quality or description, which is not understood by the public as a warranty that the person who bears the name is maker of the article, but only that the article is made after the same formula as when he made it. Upon the same principle, where a hotel or theatre bears the name of one who has owned or occupied it, and has been sold out or leased by him under that name, he cannot enjoin a subsequent purchaser or lessee from calling it by his name. *Booth v. Jarrett*, 52 *How. Pr.*, 169. See also *Willington v. Fox*, 3 *Myl. & Cr.*, 333.

These distinctions have been clearly presented by the Supreme Court of Rhode Island in *Carmichael v. Latimer*, 11 *R. I.*, 395, 401, where Potter, J., after examining many cases with a view of

determining whether a trade-mark is assignable, says: "Upon this question there has been a great variety of decisions, and it is difficult to reconcile them. A proper classification of the cases would probably remove some of the difficulty. Where, from its being a peculiar invention, a secret process, or particular mode of manufacture not generally known to the public, the knowledge of the process might be communicated to others, and the public and the purchasers should be protected against imitations. This circumstance would give a value to the process, and assimilate it to the nature of property which might be disposed of. In some of the cases there has been a question between partners, or there has been a sale of the business, to be continued by the vendee, and more or less connected with the place and the good-will of the business; and in many of these cases the sale of the trade-mark would be upheld. So where the name denotes the product of a particular property—*e. s.*, 'Congress Spring,' or wine made from a particular vineyard. In such cases there is no property in the words, but only as the means of designating a property. But where the reputation of the goods and of the name has grown out of the excellence of manufacture, depending on the honesty and skill of the maker, it is more difficult to hold that it can be sold to a stranger, or that it is generally assignable."

5. So, in the case before us, if we could gather from the record that the plaintiffs are the successors in business of Probasco & Oakes, that they had become the assignees, not merely of the trade-marks and tokens, but also of the establishment and the business, so that they are really carrying on the same business and manufacturing and selling the same goods as Probasco & Oakes, we should have no difficulty in holding that they are entitled to the relief which the Court below awarded them. But, so far as we can gather from the record, they stand before us as the naked assignees of certain trade-marks and tokens which were used by the originators of them in the sale of candies, and they claim the general right to sell candies by means of these trade-marks and tokens. This claim can only be supported by alleging and proving that these marks and tokens were originally devised and used to designate goods of a certain quality or description, and that

they are, in fact, using them to designate goods of substantially the same quality or description. *Filkins v. Blackman*, 13 *Blatch.*, 440.

Neither can they, under the circumstances in which they present themselves to the Court, uphold the right to use the name of Oakes in the vending of candies, without making it clear that it is a mere adjective of description, indicating to the public that the candies so marked or advertised are of a certain kind or quality, and that the use of such a name does not operate to deceive the public into the belief that they are, in fact, made by the man Oakes. We cannot gather from the record that they have made these facts to appear, and we must accordingly reverse the judgment and remand the cause.

We have given to this case long and anxious attention, and have considered attentively many decisions bearing upon the subject which we have not thought it necessary to cite. We have done this, not only because it involves important rules of property, but also because questions of public right and public policy enter into it, which Courts of justice cannot ignore. We are disposed to uphold the assignability of trade-marks, trade-names, and the good-will of trading establishments, as far as authoritative Courts have hitherto gone.

4. But we cannot go to the wild length of holding that the name of a man may be segregated from the man himself, and from the business in connection with which the man has used it, erected into an ideal and abstract species of property, be made a subject of traffic and sale in the market from man to man, to be used in any manner in which the purchaser may choose to use it. In so far as the name of Oakes may have been used to designate candies of a particular kind and quality, the plaintiffs may have acquired a right thus to use it, which they may, on a subsequent trial, be able to show; but in so far as it represents to the public the personal skill and integrity of the man Oakes, the right to use it cannot, under any circumstances, become the property of a person bearing another name.

All the Judges concur.

- *Reversed and remanded.*

78

IN THE UNITED STATES PATENT OFFICE.

EX PARTE BRIGHAM.

DECIDED 15 APRIL, 1881.

• REPORTED 20 OFFICIAL GAZETTE, 891.

“Satin Polish” Case.

1. DISTINCTION BETWEEN LABELS AND TRADE-MARKS.—The proper test in distinguishing between trade-marks that savor of description and labels that imperfectly describe, is to consider whether the public will on the whole regard the mark as an arbitrary symbol denoting only the origin and ownership of the goods, or as an advertisement of some desirable quality of the goods themselves.
2. SAME—“SATIN POLISH,” A LABEL.—The words “Satin Polish” are a genuine, if imperfect, attempt to describe the leading characteristic of the goods to which they are attached, and may form part of a label registration.

APPEAL from the Examiner of Trade-Marks.

Registration of a Label.—Application filed January 20, 1881.

Mr. W. E. Simonds, for the applicant.

MARBLE, *Commissioner*:

The Examiner refuses registration to applicant's label, on the ground that the word "satin," as applied to a polish for boots and shoes, is more properly the subject for a trade-mark registration.

The applicant alleges that "the Examiner erred in deciding that the name 'Satin Polish' is so fanciful in its nature as to necessarily amount to a trade-mark." The Examiner does not deny that the word is in some respects suggestive, but holds that if there is "any descriptiveness attached to the word that it is so very remote as to be but secondary."

It is often difficult to distinguish between trade-marks that savor of description and labels that imperfectly describe the goods to which they are attached. I do not know that the line of separation has been or can be defined in general terms.

1. It is a matter of judgment in each case, and the proper test to apply, as intimated by the Primary Examiner, is to consider whether the public will, on the whole, regard the mark as an arbitrary symbol denoting only the origin and ownership of the goods, or as an advertisement of some desirable quality of the goods themselves.

The luster of satin is well known and may be compared as well as anything else to the gloss of a well blacked shoe. The word "satin" as applied, is perhaps as good a description by way of resemblance as can conveniently be found of the effect produced by a fine article of shoe-polish, and I am inclined to think that a customer would be led by this description of the article to expect a satin-like luster as the result of its performances. Whether this representation is a true one or not, is immaterial, so long as it is sufficiently plausible to impose upon the public.

The descriptiveness of the epithet is not so "remote as to be but secondary," in the sense in which that phrase was used in discussing the propriety of the word "invigorator" as a trade-mark for bedsteads. That word was not descriptive of any feature or effect of the bedstead, and was only in a fanciful manner descriptive of the sleep obtained thereon. Nor does the word "satin"

refer generally to the excellency of the article like the words "first-class," "standard," "premium," &c.

2. The words appear in their proposed application to be a genuine, if imperfect, attempt to describe the leading characteristic of the article, and I think the applicant should be allowed to retain them as part of her label.

The Examiner is reversed.

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IN THE LOUISIANA SUPREME COURT.
IN EQUITY.

INSURANCE OIL TANK COMPANY*vs.*JOHN H. SCOTT.

DECIDED MAY, 1881.

REPORTED 33 LA. ANN., 946.

"Insurance Oil" Case.

1. A suit brought in the name of a corporation without designation of any officer, will stand when, on trial of the exception taken on that point, it is shown that the action was instituted by the President with the approval of the Board of Directors.
2. A corporation is entitled to have its trade-mark as well as a private individual, and may sue for its infringement.
3. The infringer cannot justify his wrongful act by showing that the plaintiff has violated some general law of the State, not affecting his right to have a trade-mark, but on a different subject.
4. In the United States, trade-marks may be patented, and when the word *patented* is put on the label of the article sold, though the merchandise itself is not patented but the word is used in reference to the trade-

mark and not for the purpose of deceiving the public, the owner of the trade-mark will not be disentitled.

5. The words "Insurance Oil" are a legal trade-mark.
6. A trade-mark is not necessarily defective because it does not indicate the origin or ownership of the article.
7. The seller is as much entitled to protection in his trade-mark when his goods are manufactured by others under his orders and directions, as when he is himself the manufacturer.

APPEAL from the Fourth District Court for the Parish of Orleans. HOUSTON, J.

Levy & Kruttschnitt, for plaintiff and appellant.

First. "The leading principle of the law of trade-marks is, that the manufacturer or merchant who has produced or brought into market an article of use or consumption that has found favor with the public, and who, by affixing to it some name, device or symbol, which serves to distinguish it as his, and to distinguish it from all others, has furnished his individual guaranty of its value, shall receive the reward of his skill, and shall not be deprived thereof by infringement or imitation." 24 *An.*, 96; *Upton on Trade-Marks*, 97; 6 *Otto*, 245; 1 *Cooley on Torts*, 359; *American Trade-Mark Cases*, 479, 539 and 624.

Second. Any purely arbitrary or fanciful name, device or designation may be used, provided the name selected is not a word in common use, to designate or describe the quality or nature of the article. Such words cannot be exclusively appropriated by any one, as "nourishing" applied to a drink; nor can the name of a place be applied as a trade-mark, because others may see fit to do the same business at the same place. But such words as "Charter Oak Stoves," "Congress Water," "Bethesda Water," "Ethiopian Stockings," "Grenade Syrup," "Excelsior Soap," "Sunlight Oil," "Daylight Oil," "Insurance Oil," are purely fanciful and arbitrary names, and are good trade-marks. 1 *Cooley on Torts*, 362; *Browne, Trade-Marks*, secs. 236, 274; *American Trade-Mark Cases*, 530, 624, 479; *Coddington's Digest, Trade-Marks*, sec. 680, *et seq.*, 1039; 10 *Reporter*, 809.

Third. The trade-mark protects the merchant or seller of an article, as well as the manufacturer. 6 *Otto*, 245; 24 *An.*, 297; *American Trade-Mark Cases*, 45. 166, 573, 627; *Browne on Trade-Marks*, secs. 35, 62; *Upton, Trade-Marks*, 97; *Coddington's Digest*, secs. 7, 10, 11, 14.

Fourth. Mere symbols or devices, or fancy and unmeaning words, by use and association, indicate origin, and thereby become legal trade-marks. Such words as "Excelsior," "Climax," "Empire," "Charter Oak," have been decided to be good words for this purpose. *Browne; Trade-Marks*, sec. 150; *American Trade-Mark Cases*, 736; 13 *Wall.*, 322; 101 *U. S. S. C.*, 51.

Fifth. Complainant will be protected even where there is technically no trade-mark. 6 *Otto*, 245; 96 *U. S.*, 245; 9 *Reporter*, 603; 33 *Md.*, 252; 10 *Reporter*, 154; 11 *Reporter*, 241; 45 *Cal.*, 467.

Sixth. Though a fraudulent trade-mark will not be protected, an innocent mistake will deprive one of remedy under the law. Where there is no motive for fraud in the owner of the trade-mark, and "no intention to deceive," an injunction will issue. *High on Injunctions*, sec. 674; *Coddington's Digest, Trade-Mark Cases*, secs. 548, 561, 565, 570, 571; *American Trade-Mark Cases*, 282, 559; 39 *Conn.*, 450.

And when the record shows the objection is removed, and another writ of injunction would be issued, the injunction will not be set aside. 18 *An.*, 111; 21 *An.*, 324; 22 *An.*, 207, 464; 23 *An.* 171; 25 *An.* 222; *Longue's Dig.*, 315.

Seventh. The admissions and the testimony show that the plaintiffs were legally incorporated under the Acts of 1855, No. 131, and of 1868, No. 73, amending the same, and are properly in Court. Besides the existence of a corporation *de facto*, cannot be inquired into collaterally. 11 *Reporter*, 110, and the authorities there cited; 4 *Otto*, 104; 2 *W. & S.*, 190.

Eighth. While exemplary or punitive damages are not given for violations of trade-marks, a sufficient sum will be allowed to cover all losses;—that by injury to the reputation of the article sold under counterfeit trade-marks; that, for depreciation in price, caused by competition, and loss to complainant of the money

made by defendant by his illegal traffic—"not smart money or vindictive damages, but full atonement for the wrong." *Browne on Trade-Marks*, secs. 503, 505; *Coddington's Digest*, *Trade-Mark Cases*, secs. 246, 1051, 1052; 4 *McLean*, 520.

Chas. S. Rice, for defendant and appellee.

First. Bodies corporate ask judicially through representatives mentioned in their charter. The *Manager* of plaintiff's Company had no lawful authority to bring this suit, sign the affidavit to petition and the bond of injunction. See *Act of Incorporation*, p. 369; *C. P.* 2; *C. C.* 438.

Second. The plaintiff's corporation has no showing in Court to prosecute a suit for the protection of its mercantile or commercial business. Corporations in Louisiana, are, by law, prohibited from such business. *Sec. 60, 9th Ed. Angel & Ames on Corporations*, 427, 432, 446; 4 *Wheaton*, 636; 3 *Wendell*, 583; *Green's Brices' "Ultra Vires,"* 79; *Acts of 1855*, pp. 182 and 183; *Acts of 1868*, pp. 84 and 85; *Rev. Stat. of 1870*, Art. 683; *Act of 1880*, p. 169; 22 *An.* 524; *Vredenburg v. Behan, et als.*, 33 *An.* (not yet reported); *Browne on Trade-Marks*, sec. 370.

Third. The alleged trade-mark is not a valid trade-mark.

Words descriptive merely, and not indicating origin or ownership, cannot constitute a valid trade-mark.

Words descriptive, or adopted because of, or to indicate a certain state of facts, cannot constitute a trade-mark.

A person must be the inventor or have the exclusive right from the inventor to sell the goods of such manufacturer to entitle such seller to a valid trade-mark on the manufacture in question.

Words are descriptive in one combination when not necessarily so in another.

Taylor v. Gillies, 59 *N. Y.* 331 (affirming same case); 5 *Daly*, 285; 101 *U. S. Sup. Court*, 51; 13 *Wal.*, 20; 16 *Pat. Off. Gaz.* 680; Same, 136; 2 *Sandf. (N. Y.)*; *S. C., Am. Trade-Mark Cases*, 103; 14 *Am. Law Rev.*, 419; 45 *Cal.* 467; 7 *Lans.*, (*N. Y.*), 151; 18 *How. Pr. Rep.* 64; *S. C., Am. Trade-Mark Cases*, 226.

Fourth. The representation by plaintiff, in connection with or as a part of his pretended trade-mark, that the article sold by

him was *patented*, forfeited his right to protection even if such mark were otherwise valid. *Rev. Stat. U. S.*, 4900, 4901; *Browne on Trade-Mark*, sec. 72, p. 254; *Coddington's Dig. of Trade-Mark Cases*, secs. 548, 561 and 562; 5 *Law Rep.* [1877], Ch. Div., 850, *Cheavin v. Walker*; *Am. Trade-Mark Cases*, 688, *The Leather Cloth Co. v. The American Leather Cloth Co.*

Fifth. Even if a lawful trade-mark, its protection is forfeited by misuse, *e. g.*, by selling goods not manufactured exclusively by plaintiff or for plaintiff by the Standard Oil Company; by selling as Insurance Oil, oil manufactured by and for other persons; and by doing so knowingly and repeatedly,—*this* on the principle that plaintiff must come into the Equity Court with clean hands, and the aid of the Court will not be given to assist in perpetrating a fraud on the public. *Browne on Trade-Marks*, sections 327, 374; *Coddington's Dig.*, secs. 530 to 572; *Am. Trade-Mark Cases*, 180; *Pidding v. How. Ibid*, 640; *Perry v. Truefitt, Ibid*, 644.

Sixth. A Court of Equity will not protect the exclusive use of a trade-mark, to enable a party to sell an ordinary article of commerce at a much higher price than the regular market rate of the same article, to a public so induced to pay such rate by the mistaken belief that the article is patented or has some *peculiarly and special* valuable qualities.

FENNER, J., delivered the opinion of the Court.

The evidence establishes that, prior to 1873, most of the illuminating oils produced from petroleum, then in the market, were of low fire-test, and consequently inflammable, and also generated vapors which, in certain combinations with atmospheric air liable to take place, become explosive and frequently caused destruction to life and property. Other oils, then in use, not inflammable or explosive, were deficient in illuminating or other qualities requisite to fit them for domestic use in ordinary lamps.

There existed an urgent public demand for an illuminating oil of this character, combining, with perfect safety, the other necessary qualifications for family use.

With the view of supplying this demand, plaintiff instituted negotiations with certain oil refiners in Cleveland, Ohio, for the

purpose of securing the production of an illuminating oil, having certain desiderated qualities as to color, specific quality, flashing point and fire-test.

Plaintiff succeeded, in 1873, in procuring an oil, manufactured for it, and under its orders, possessing the required qualities, which, after examination, secured the public approval and recommendation of the Board of Health of this State and of the insurance companies of New Orleans and of other cities. To this oil the plaintiff gave the name "Insurance Oil," and adopted that name as its "trade-mark," under which it sold this particular oil, to distinguish it, not only from other different oils, but also from all oils sold by others than itself. Application was made, under the Act of Congress, to the U. S. Patent Office for the registry of this trade-mark and, after due examination, the Commissioner made the registry and issued the certificate. Plaintiff had made, and used, a stencil-plate, containing the words: "Trade-Mark Insurance Oil, Pat. Jan. 5, 1875," cut in letters of peculiar form and character and accompanied with certain distinctive scroll-work, with which it branded the packages containing this oil, and sold by it.

Owing to the character of the oil and aided by active and expensive canvassing and advertising, plaintiff succeeded in establishing an extensive trade in this and contiguous States, profitable to itself and advantageous to the public—the evidence showing that no accident has ever occurred from the use of this "insurance oil."

The defendant, a rival dealer in oils in this city, after the reputation of plaintiff's oil had been thus established, commenced putting up and selling oils dealt in by him, as "Insurance Oil," and had made a stencil-plate, the *fac simile* of that used by plaintiff, with which he caused his own packages to be branded and put upon the market.

Plaintiff brought the present suit to restrain, by injunction, the infringement of its trade-mark and to recover damages.

The defences, interposed by exceptions and answer, are manifold, and will be considered in order.

1st. It was excepted that the plaintiff corporation did not, in its petition, appeal by its proper officer, as required by law.

1. The petition was in the name of the corporation without the designation of any officer. The exception was cumulated with the merits, and, on trial, it was proved that the action had been brought by the President, with the approval of the Board of Directors. This cures the defect.

2nd. The objection raised to the validity of plaintiff's Act of incorporation, was not properly presented by the pleadings, and was waived by the express admission found in the record, viz: "It is admitted that the company is legally incorporated, and its name is the Insurance Oil Tank Company."

The further objection that plaintiff is violating the law by carrying on a mercantile business, is not presented by the pleadings, nor was it considered in the lower Court. It does not properly arise in this case.

2. The sole question involved is plaintiff's right to protection in the exclusive use of its trade-mark. A corporation is entitled to have its trade-mark as well as a private individual, and may sue for its infringement.

3. Defendant cannot justify his wrongful act, by accusing the plaintiff of violating some general law of the State, not affecting plaintiff's right to have a trade-mark, but on a different subject. We express no opinion as to the legality of plaintiff's business, in support of which much might, however, be said. We simply overrule the objection, because, (1st,) not presented by the pleadings, (2d,) not relevant to the issues in this case, (3d,) as being a question which defendant is without interest to raise.

3rd. Defendant urges that the use of the abbreviation "Pat.," meaning *patented*, in the trade-mark, is a fraud on the public and a violation of law, which deprives plaintiff of the right to redress.

It is undoubtedly true that the affixing of the word "patent" to an unpatented article, "for the purpose of deceiving the public," is prohibited, under penalties, by the laws of the United States; *U. S. R. S.*, sec. 4901; and that a representation in a trade-mark that an unpatented article is protected by a patent "*prima facie* amounts to a misrepresentation of an important fact, which would disentitle the owner of the mark to relief in a Court

of Equity, as against a pirate." *Browne on Trade-Marks*, sec. 572; *Coddington's Dig. Tr.-M. Cases*, sec. 548; 39 Conn., 450.

4. But, to have such effect, the use of the word "patented" must be "with the purpose of deceiving the public," and if such fraudulent intention does not exist, and the use of the word may be explained in any reasonable sense consistent with truth and honesty, the party will not be prejudiced. *High on Injunctions*, sec. 674; *Coddington's Dig.*, sec. 570, 571.

The plaintiff avers that the use of the word "patented" in its label or brand was intended to refer, not to the article, Insurance Oil, but to the word *Trade-Mark* placed on the top of the label. Had the words "Registered in Patent Office" been used, no question could have arisen; but the use of the word *patented*, as applied to a trade-mark so registered, is so common, that we are referred to an example where so learned a jurist as Judge Cooley uses the language: "In the United States, trade-marks may be *patented*, etc." *Cooley on Torts*, 361, note. Under such circumstances, we consider the explanation of plaintiff as sufficient to maintain its honesty of intention.

5. 4th. Objection is made that the words "Insurance Oil" are not a legal trade-mark, because the word "insurance" merely denotes the *description* or *quality* of the article, without, in any manner, indicating origin or ownership.

The law on this subject is tersely expounded by Judge Cooley: "In general, a man may adopt for a trade-mark whatever he chooses; but when he asserts, and seeks to enforce, exclusive right therein, it becomes necessary to ascertain whether it is just to others that this be permitted. If the name, device or designation is purely arbitrary or fanciful, and has been first brought into use by him, his right to the exclusive use of it is unquestionable. But the mere designation of a quality, as 'nourishing,' applied to an article of drink, cannot be appropriated as a trade-mark; neither can any general description, by words in common use, of a kind of article, or of its nature or qualities." The defendant contends that the trade-mark is defective, first, because the word *insurance* as applied to an illuminating oil, merely denotes the quality of *safety*, and may, therefore, be used by a vendor of any *safe* oil;

second, that it indicates that the oil has been approved by insurance companies, and so may be employed as applicable to any oil having such approval. The learned Judge of the Court *a qua* sustained the defendant on these points and rejected plaintiff's demand.

We cannot agree with our brother of the District Court. While the word *insurance* may, by some process of association of ideas, suggest the notion of safety, it is not synonymous with *safe*, nor can it be said to describe any possible quality of oil. The word is a noun substantive, not grammatically applicable to the description of the qualities of things. The dictionary furnishes several examples of its use as part of compound words, such as insurance broker, insurance clerk, insurance company, insurance office, insurance policy—all of which have well-understood meanings; but insurance oil is, in itself, meaningless, conveying no rational idea, any more than would the words, insurance house, or insurance tree.

Equally untenable is the idea that these words signify that the oil has been recommended by insurance companies. That the selection of this name was suggested by the fact that it had received such approval, is admitted; but that the words express such a fact cannot be maintained.

We are strengthened in our conclusion by the decision of the Commissioner of Patents in admitting this trade-mark to registry. The authorities of the Patent Office, from long experience, are familiar with the law of trade-marks, and their decisions, though not conclusive, are entitled to great consideration by Courts in the determination of such questions.

5th. It is urged that the trade-mark is defective because not indicating the origin or ownership of the article.

There are authorities holding that it is essential to the validity of a trade-mark that it should indicate the name or address of the manufacturer or seller of the articles, in such manner as to distinguish them as the goods made or sold by the parties claiming the benefit thereof.

6. We consider, however, that the latest and best authorities establish that such particular designation is not essential; but that

when a particular form of words or device, otherwise valid as a trade-mark, has been first employed by a particular maker or seller, and has been used by him upon his goods, so long and so exclusively as to have acquired, by association, an understood reference to such maker or seller as the originator or seller of articles so marked—this will be a sufficient compliance with the law, and will entitle the party to protection.

Browne, Trade-Marks, sec. 150, 151; Charter Oak Case, 44 Mo., 173; 57 Barb., 526; 35 Conn., 402; 13 Wall., 322; 101 U. S., 620; 3 Keyes, 594.

The evidence brings the case of plaintiff within the principles of these authorities.

6th. The objection that the oil is not directly manufactured by plaintiff, but only manufactured by others under plaintiff's orders and directions, is of no force.

7. The authorities are clear that, in such case, the seller is as much entitled to protection in his trade-mark as if he were the manufacturer. The ground of relief is stated by the Supreme Court of the United States to be that "complainant has a valuable interest in the good-will of his trade or business, and having adopted a particular label, sign, or trade-mark indicating to his customers that the article bearing it is made or sold by him or by his authority, he is entitled to protection against one who attempts to deprive him of his trade or customers, by using such label, signs, or trade-mark without his knowledge or consent."

McLean v. Fleming, 6 Otto, 252, citing 2 Sandf. (N. Y.) Ch., 586; 2 Barbour (N. Y.) Ch., 101; Wolfe v. Barnett, 24 An., 97; Amoskeag v. Spear, 2 Sandf. Sup. Ct., 599; Colladay v. Baird, 4 Phila., 139; Browne on T.-M., sec. 35.

7th. Attack is made upon plaintiff's right to equitable protection upon the ground that it has debauched its own trade-mark by selling thereunder, as insurance oil, oils which were not such. The occasional instances of such sales established by the testimony, are not sufficient, under any authority to which we have been referred, to maintain such forfeiture.

It is true that, on a few occasions, when by detention of its shipments, plaintiff has run short of insurance oil, it has tempo-

rarily supplied the trade, with different oil under that name; but the instances are few and the amount so sold inconsiderable, and care has been taken that the substituted article should equal the genuine, in safety, if not in all other qualities. We think this conduct, though reprehensible, was not carried to such extent as to destroy the value of the trade-mark or to deprive plaintiff of his right to protection.

In conclusion, we consider that the interest of the public, which is an important motive for the protection of trade-marks, is peculiarly involved in a case of this character. If, as the record establishes, the plaintiff has so conducted its business as to inspire the public with confidence that the insurance oil manufactured for, and sold by it under its trade-mark, is not only useful and convenient, but also absolutely safe, for use for illuminating purposes, and, thereby, to secure a large and valuable trade based on such confidence—we think both the plaintiff and the public are entitled to protection in their mutual relations of confidence on the one hand and patronage on the other.

It may be, as contended by defendant, that the oil sold by him under plaintiff's trade-mark is equal, in all respects, to the oil of plaintiff. But, if defendant may use this mark, other less conscientious dealers may employ it for inferior and dangerous oils; and the public would thereby be deprived of the security now enjoyed in the purchase of oil so marked, and the business of plaintiff would be destroyed.

Defendant has no right, in justice or law, to trade upon the reputation and business sagacity and enterprise of plaintiff, which are represented by and embodied in its trade-mark.

We find in the record no sufficient proof upon which to base any estimate of damages.

It is, therefore, ordered, adjudged and decreed that the judgment appealed from be avoided and reversed; and it is now adjudged and decreed that the original injunction herein issued be reinstated and made perpetual, and that plaintiff's demand in damages be dismissed as in case of non-suit, defendant and appellee to pay costs in both Courts.

Rehearing refused.

80

IN THE UNITED STATES PATENT OFFICE.

EX PARTE STRASBURGER & CO.

DECIDED 28 MAY, 1881.

REPORTED 20 OFFICIAL GAZETTE, 155.

“Railway Time-Keeper” Case.

1. TRADE-MARK—EXAMINATION.—Under the Trade-Mark Act of March 3, 1881, and the rules now in force, examination will be made of the presumptive lawfulness of the trade-mark proposed for registration.
2. SAME—ONLY LAWFUL MARKS REGISTERED.—The present Act excludes from registration prospective trade-marks and those not used in foreign commerce or commerce with the Indian tribes; but there has been no such essential change in the law as to warrant the Office in registering as a trade-mark, matter which the Courts would not regard as such.
3. SAME—DESCRIPTION.—The words “time-keeper” are not the proper subject for a trade-mark for watches, their only office being to indicate the nature of the goods to which they are applied.
4. COMPOUND TRADE-MARKS.—Proposed trade-marks consisting in part of marks already registered by others, are objectionable when it appears that they would be liable to deceive the general purchaser.
5. OATH AS TO FOREIGN COMMERCE.—Under section 3, of the present Act, the applicant will be required to specify some particular foreign nation or Indian tribe with which he has commercial relations.

APPEAL from the Primary Examiner.

Watches.—Application filed April 23, 1881.

Mr. A. Pollok, for the appellant.

MARBLE, *Commissioner*:

The applicants seek to register as the essential elements of their mark the representation of a locomotive, together with the words "railway time-keeper."

The Examiner objects to the words "time-keeper" on account of their descriptive nature, and to the word "railway" as anticipated by a prior registration.

With reference to the words "time-keeper," the applicants take the position that the objection to the descriptiveness of the proposed trade-mark has no standing under the present trade-mark Act and rules adopted in conformity therewith. The argument, as I understand, is based upon certain changes which have been made in the phraseology of the present law.

The Act of July 8, 1870, provided that—

"The Commissioner of Patents shall not receive and record any proposed trade-mark which is not and cannot become a lawful trade-mark, or which is merely the name of a person, firm, or corporation unaccompanied by a mark sufficient to distinguish it from the same name when used by other persons." (Sec. 4939, R. S.).

Section 3, of the Act of March 3, 1881, provides that "no alleged trade-mark shall be registered unless the same appears to be lawfully used as such by the applicant in foreign commerce or commerce with Indian tribes, as above mentioned, or is within the provision of a treaty," &c. As is well known, the present law was drawn up to meet the views expressed by the Supreme Court in the cases of *United States v. Steffens*; *Same v. Witteman*; *Same v. Johnson, et al.*, (16 O. G., 999). In those cases the Court held that trade-mark legislation can only be had under what is known as the "commerce clause of the Constitution,"

and that only such trade-marks can be registered as are in actual use in foreign commerce.

2. Accordingly, the present law makes no provision for the registration of prospective trade-marks, if they may be so called, or of trade-marks not in use in foreign commerce; but in other respects, as I read it, the law is unchanged. I find in the passage quoted, two prerequisites named as essential to a valid registration; first, that it shall appear that the proposed trade-mark is lawfully used as such; and, second, that it shall appear that it is used in foreign commerce or in commerce with Indian tribes. It is clear that the oath of the applicant cannot establish the existence of the first of these conditions, where it appears, upon inspection, that a proposed trade-mark consists of words in general use, to which the applicant can have no exclusive right, or that the proposed trade-mark is not, in fact, a trade-mark in contemplation of law.

1. The trade-mark rules now in force and adopted in conformity with the present Act follow substantially the wording of the law upon the point under discussion, and have substantially the same effect. That the construction of the law here adopted is the true one, is borne out by examination of the other provisions of the law.

The law further provides that the applicant, in addition to filing *fac similes* of his proposed mark, shall submit a description of the trade-mark itself; that a trade-mark shall not consist of the mere name of the applicant; that a trade-mark shall not be registered which is identical with a registered or known trade-mark, and which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers; that the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade-mark; that he shall investigate the question of priority of right between rival claimants, and that the registering of a trade-mark shall be *prima facie* evidence of ownership.

The intent of the law in requiring that the applicant shall file a description of the trade-mark itself is not to be misunderstood. It was considered necessary that the applicant should point out the exact scope of his trade-mark, discriminating the essential

from the non-essential portions thereof, that the Commissioner may determine that the subject proposed for registration is in fact a trade-mark, that it does not clash with prior registrations, and that if such be found to be the case, the question of priority of right may be properly determined, and that the applicant may in the end issue from the Patent Office with a *prima facie* right.

It would be anomalous in an Act purporting to give color of title to confer upon the officer administering the law jurisdiction of other questions of title and not of the fundamental question, viz., whether or not the subject-matter fall within the purview of the law.

2. I should be reluctant to adopt this construction of the law were the language less clear than I find it. I am unable, therefore, to agree with the applicants that there has been such an essential change in the law as to warrant the office in registering as a trade-mark matter which the Courts would not hold to be such.

3. With reference to the descriptiveness of the words "time-keeper" in their proposed application, there can be little doubt. They are in common use as applied to watches, clocks, and other species of chronometers, and this I do not understand the applicants to deny. The words must, therefore, upon familiar doctrines, be erased from the recital of the essential portion of the mark.

4. The applicants contend that while the right to the separate use of the word "railway" has been secured to another, that it may yet form a part of their compound trade-mark. If the views above expressed as to the effect of the present law and rules are correct, the essentials of the applicant's mark can comprise no more than the representation of a locomotive with the single word "railway." While I am not prepared to say that a trade-mark registered to another, may not be under some circumstances fancifully and arbitrarily compounded with other words and symbols to form a valid trade-mark, I am of the opinion that the use of the word "railway," even when used in connection with the representation of a locomotive, would be confusing and deceptive to

the general purchaser, and interfere to that extent with the rights already secured to the prior registrant.

In the case of *I. Bush & Co.*, (10 O. G., 164), it was proposed to register the word "Centennial," which had already been registered by another as one of the essential elements of an otherwise lawful trade-mark. The Commissioner said:

4. "I do not, however, think it a safe practice to permit the registration of a compound trade-mark, one of whose distinguishing features has already been appropriated and registered by another, as applied to the same class of merchandise. The tendency would be to mislead purchasers as to the true origin of the article sold under such mark, and the policy of the law is to discountenance such a proceeding."

Coggin, Kidder & Co., (16 C. D., 342), was referred to and approved.

The applicants will be required before registration to erase from their specification and *fac similes* all reference to the word "railway."

5. I approve also the action of the Examiner in requiring the applicants to file a new oath, which shall designate the particular nation or Indian tribe in commerce with which their alleged trade-mark has been used.

The statute relating to trade-marks provides, section 3, "that it shall appear to be lawfully used as such by the applicant in foreign commerce or commerce with Indian tribes." It is clearly within the power of the Commissioner, therefore, to require applicants to specify some foreign nation or tribe with which the applicants have commercial relations, in order that it may be made to appear that such is the fact. (*Ex parte Keppler v. Schwarzmann*, C. D., May 2, 1881).

The action of the Examiner is affirmed.

81

CIRCUIT COURT UNITED STATES, DISTRICT
OF NEW JERSEY. IN EQUITY.

SAWYER

vs.

KELLOGG.

DECIDED 1 JUNE, 1881.

REPORTED 7 FEDERAL REP., 720.

“Sawyer’s Crystal Blue” Case.

TRADE-MARK—INJUNCTION.

A label which had been in use in substantially the same form for a dozen or more years prior to suit brought, consisted of a blue wrapper pasted around a small bottle holding bluing, and contained in separate compartments, various inscriptions in letters of silver bronze. The first compartment contained the general designation of the article, in the words “Sawyer’s Crystal Blue and Safety Box.” The other compartments contained, in finer print, commendations of the quality of the article, directions for its use, and the name of the party by whom it was prepared. HELD, under the special circumstances of the case,

That the use of a label of the same size, color and type, and of the same general appearance, with corresponding compartments, and similar, although not identical, designation, should be enjoined.—ED.

BILL FOR INJUNCTION.

Rowland Cox, for complainant.

George Putnam Smith, for defendant.

Before BRADLEY and NIXON, JJ.

BRADLEY, Circuit Justice :

This case, with its special circumstances, seems to us to be a very clear one. The complainant's label, which he alleges that the defendant has wrongfully imitated, had been in use substantially in the same form for a dozen or more years prior to the bringing of the suit. It consists of a blue wrapper, pasted around a small bottle holding the bluing, and containing, in separate compartments, various inscriptions in letters of silver bronze. The first compartment contains the general designation of the article, in the words, "Sawyer's Crystal Blue and Safety Box." The other compartments are in finer print, and contain commendations of the quality of the article, directions for use; and the name of the party by whom it was prepared.

The label complained of, and admitted to be prepared and used by the defendant, is of the same size, color, and type, and of the same general appearance, as that of the complainant, being divided into compartments corresponding with those in his label. The inscriptions although not identical, appear very like. The general designation is in these words; "Sawin Soluble Blue and Pepper Box." Placing the two labels side by side it is easy to distinguish them. But ordinary persons, in the habit of buying the complainant's bottles, would be very easily deceived into buying the defendant's for them, the general appearance being so similar in every respect. That the defendant's label is a designed imitation of the complainant's scarcely admits of a doubt. Such perfect similarity could hardly have been the result of chance. We do not mean to say that it would be a justification if it were accidental. But it is apparent that it was designed. Sawin is not the defendant's name; why, then, did he use Sawin's name and not his own? It was evidently done for the purpose of making a closer

imitation of Sawyer's label. The defendant, it is true, alleges that he does not put up the bluing for himself, but for a firm by the name of Barron & Co., who directed him to adopt the label in question. But this is no excuse for him unless Barron & Co. were entitled to use the label. The defendant attempts to show that they had such a title by having hired from Sawin the right to use his name. This pretext is too shallow. It is shown, indeed, that Sawin did manufacture bluing, and used a label of his own, but it was wholly unlike the label in question. The use of his name by Barron & Co., in the label complained of, was evidently obtained for the purpose of making it more closely resemble Sawyer's. Sawin's bluing had no such reputation in the community as to make it an object to hire his name. As the label stands it speaks a falsehood. The article covered by it is not "Sawin's Soluble Blue," and it is not "prepared by W. E. Sawin, Jr.," as stated at the foot of the label. It evidently speaks this falsehood for a purpose, and that purpose, we are satisfied, is to obtain a closer imitation of Sawyer's label. It is no excuse for the defendant that he does this work for other persons. He is just as guilty as if he did it for himself. All who are concerned in the commission of a tort are alike amenable to the party injured.

It is suggested, however, that the label complained of is the same in all respects which the defendant had used for several years prior to its adoption by Barron & Co., with the exception of the caption, in which Sawin's name has been introduced instead of his own. This only goes to show that the adoption of Sawin's name was regarded as important in carrying out the plan of Barron & Co. The question readily suggests itself, why did they prefer Sawin's name to Kellogg's in the caption of the label? No sufficient reason is shown except that it enabled them more closely to imitate the complainant's. No doubt Kellogg would have been perfectly willing, and glad, to have used his own name, and then the label would, at least, have told the truth. It is unnecessary to add that the argument assumes that Kellogg's label itself was free from objection as an imitation of that of the com-

plainant. Whether it was so or not may be a question, but one which it is not necessary now to determine.

It is further suggested that the complainant has lain by for several years, whilst the defendant has been publicly using his own label, and has thus acquiesced in its use. To this suggestion it may be proper to reply that the complainant had a patent for the article of bluing, which he was prosecuting and endeavoring to substantiate, but in which he finally failed. His failure to establish his patent (which would have covered all his rights) ought not to preclude him from falling back on his right to the trademark. No essential delay has occurred since the termination of the proceedings on the patent. But, at any rate, an acquiescence in Kellogg's use of his own label was no acquiescence in his use of the new and altered label having Sawin's name in the caption.

We think the case is with the complainant, and that a decree should be made in his favor. Let a decree be made accordingly.

NOTE.—See *Sawyer v. Horn*, 1 *Fed. Rep.*, 24.

82

SUPREME COURT OF WISCONSIN. IN EQUITY.

MARSHALL, AND ANOTHER

vs.

PINKHAM.

DECIDED 22 JUNE, 1881.

REPORTED 52 WIS., 572.

“Marshall's Rheumatic Liniment” Case.

- (1-6) *Infringement of trade-mark.* (7) *Injunctions in such cases.*
(8) *Acquisition of title to personalty under will.*

1. Words in common use, merely descriptive of the character, composition or quality of the article to which they are applied, cannot be exclusively appropriated and protected as a trade-mark.
2. The office of a trade-mark is to point out the true origin or ownership of the goods to which it is applied, or to designate the dealer's place of business.
3. The ground upon which actions for the infringement of a trade-mark are maintained is, that the law will not allow one person to sell his own goods as and for the goods of another.
4. The fact that an article, prepared according to a certain recipe, but not protected by a patent, has for some time been made and sold only by

a certain manufacturer, does not render it unlawful for any other person, acquainted with its composition, to manufacture and sell the same.

5. The proper name of the manufacturer of an article, cannot be made a trade-mark so as to prevent any other manufacturer of the same name from affixing such name to a similar article made and sold by him. where no unfair means are used to mislead purchasers into a belief that such article is manufactured by the person who first sold and continues to sell a like article under that name.
6. M. having a recipe (not discovered or invented by himself, or protected by a patent) for a liniment used for the cure of rheumatism and other diseases, communicated it to the various members of his numerous family, and permitted each of them, for his or her own benefit, to manufacture the article and sell it with a certain label attached, (furnished by M.) containing the words "Old Dr. M's Celebrated Liniment," and certain other words descriptive of the liniment, and a certain vignette, and with the address of the particular member of the family manufacturing the article, at the bottom of such label. Each member of the family engaged in such manufacture appears to have had, by their mutual agreement, some particular route or routes to which his sales were confined. After M's death, his widow continued for some years to manufacture the liniment, and to sell it (with said label attached) on the routes last occupied by M.; and she then sold the material and paraphernalia of her business to the plaintiff, one of the sons of M. HELD:

That plaintiff has no exclusive right as against the other children of M. or their assigns, (nor even as against the public generally), to manufacture said liniment or to the use of said label or the name "M." as descriptive of the article sold.

7. An injunction restraining the use of a trade-mark will not be granted upon the pleadings in a doubtful case, but the Court will wait until the proofs are heard.
8. Where there is a will, but no executor named therein, and no administration had, no title to personal property of the testator can be acquired under the will.

APPEAL from the Circuit Court for Fond du Lac County.

This was an action by Charles H. Marshall and Mary W., his wife, to restrain the defendant and his servants and agents from preparing, putting up or offering for sale a certain alleged imita-

tion of "Marshall's Rheumatic Liniment," or any compound bearing the name of Marshall's Liniment or any imitation of said name, or bearing certain labels described in the complaint, or any imitation of plaintiffs' label or trade-mark, and also to have defendant adjudged to account to plaintiffs for all profits realized by him upon previous sales of said compound sold by him with any imitation of plaintiffs' labels or trade-mark, etc. The case is thus stated by

Mr. JUSTICE CASSADAY:

"It is very difficult, if not impossible, to gather from the printed case, or bill of exceptions, or briefs of counsel, an accurate history of the several labels in question. It would seem, however, that about 1857 Samuel Marshall and his wife, Mary J. Marshall, the parents of the plaintiffs, Charles H., resided at Fond du Lac with seven children, and in rather straightened circumstances. Three of the children were boys—John W., Samuel A., and *Charles H.*; and four were daughters, all of whom were subsequently married, One, Sarah G., became Mrs. Warren, then Mrs. Benson; another, Mrs. Harris; another, Mrs. Hardee A. Robinson; and another, Mrs. Julia F. Smith. Mrs. Smith testified that she was the youngest of the family, and thirty-five years of age, and lived with her father until 1868, when she was married; from which we may infer that she was born in 1844 or 5, and left her father's when she was about twenty-three. *Charles H.* testified that he was born in 1842, and went into business with his father when he was twenty-one, which was not till 1863; from which we may infer that he was only fifteen years old in 1857, and that all his brothers and sisters, except Julia, and perhaps another, were older than himself. About 1857 the old gentleman, Samuel Marshall, seems to have had a secret recipe for a mixture or compound constituting a certain liniment, which he claimed would cure rheumatism and various other diseases, and which he occasionally made up and gave to such persons as were willing to try it. There is no evidence that he was the inventor or originator of the recipe, and the inference is that he was not. For a time, while in the employ of others, he sold it as he had opportunity, without any label, but

only a slip of paper attached with the word "Liniment" written upon it. Soon after, he commenced peddling it in a small basket; and on his second trip John W. went out with him, and subsequently alone. Also his sons-in-law, Warren, Harris and Robinson, and his son Samuel A., made and sold quantities of it, with his knowledge and consent. It appears, from some of the witnesses, that his first label was 'Marshall's Liniment; put up by Marshall & Son, 14, 15, and 16 Oak street, Fond du Lac.'

"It seems that plaintiff Charles H., before he became of age, worked with the others in putting up and peddling out this liniment. In 1863, and on, Charles H. becoming twenty-one years of age, he went into the business with or under his father, in what he terms the 'partnership' between his father, his brother John W., and himself, which lasted, according to his statement, until the latter part of 1868, or the forepart of 1869, when it was dissolved or broken up. It is a little difficult to understand just what Charles H. meant by 'partnership.' He testifies: 'We were interested in the labels, and we bought stuff together; that was as far as the partnership extended. Each one made and sold what he could, and pocketed the proceeds; but when we ordered a lot of labels, they were paid for together, and lots of other stock we bought together—we bought it together and divided. We all had an equal right to manufacture, sell and label it—my father and my brother and me.' He further testified that about the time they dissolved, in 1868-9, 'we began to have some orders, and he (father) had the letter box and took the orders and filled them, and that was the end of the partnership; he didn't give any share of the profits to us two. After we dissolved, for a little while, I was speculating around, at nothing in particular; that was only for a short time, from three to six months. Then I went back into the patent-medicine business with my wife: that is, I didn't go into it myself, but I went to selling it. After the dissolution, I think John W. sold for the old gentleman for a little while, and then he moved away—left the country.'

"Each of the children seems to have known the secret—the recipe or formula for making the liniment; but the labels seem to have been obtained mostly from the old gentleman, who permitted each and

all the children to make the liniment and sell the same from house to house. Charles H. testified that the old gentleman barred him out, and would not let anybody use his labels, after he stopped the partnership, because he wouldn't let anybody have any of the orders that came in, and that dissolved the firm. It appears from other testimony that each peddled and sold the liniment on different routes; that they ran into each other's custom, and took customers the one from the other, and then there arose a dispute and controversy between them; and that John W. and Charles H. then undertook to form a partnership with their father and mother, putting all their father's and mother's property into the firm, but that the mother refused to execute the paper and it fell through, and then they finally divided between themselves certain routes, each reserving customers not on their own regular routes, and subsequently traded some of their customers and exchanged a corresponding number of their labels; that the label used had been changed by the old gentlemen to 'Old Dr. S. Marshall's Celebrated Liniment,' with certain other words descriptive of the liniment, and a certain vignette of a horse's head; that, long prior to the making of her will, hereinafter mentioned, he gave to each of his children, and especially Mrs. Sarah G. Benson and Haidee Ann Robinson, under whom the defendant claims to act, the secret recipe or formula for making the liniment, and the right to manufacture and sell the same, with said label or labels upon it as a trade-mark, and that they had severally, with his knowledge and consent, from time to time made such sales with such labels or trade-marks thereon, and their own address at the bottom; but Charles H. testified that such change in the label was made shortly after such dissolution, and that the horse's head was never used while they were in partnership, and that he never used the horse's head label himself; that he used the label 'Marshall's Rheumatic Liniment,' about two or three years before his father death, but did not use the label 'Old Dr. S. Marshall's Celebrated Liniment' before his death. It also appears that Samuel Marshall died July 6, 1870; and that his widow, Mary J. Marshall, continued to manufacture said liniment and cause the same, with said label affixed, to be sold upon the routes last occupied by her husband,

until the Spring of 1872, when *Charles H.* bought out the material and paraphernalia belonging to his mother's business, and gave therefor his note for \$400.

"About 1877, the mother, Mary J. Marshall, died; and subsequently it was ascertained that her husband, Samuel Marshall, had, some time during the last two years of his life, executed a last will and testament, but which had been lost, and which was established as a lost will and admitted to probate, February 26, 1880, and in and by which he gave to his wife, in general terms, all his property, but named no executor or executrix, and there is nothing to show that his estate was ever settled, or that any administrator of his estate was ever appointed. It also appears that from 1869 to the time of suit the plaintiffs manufactured and sold such liniment, with a label affixed describing it as 'Marshall's Rheumatic Liniment,' and other descriptive words, and closing with 'All orders directed to M. W. Marshall, P. O. box 70, Fond du Lac, Wisconsin,' being Exhibit A. This suit is to restrain the defendant, claiming under a right or license from Mrs. Benson and Mrs. Robinson, from manufacturing said liniment, and selling the same, with a label affixed describing it as 'Old Dr. S. Marshall's Celebrated Liniment,' and with other descriptive words, and a certain vignette of a horse's head, and closing with 'Sterling Medicine Co., Proprietors, Fond du Lac, Wisconsin,' being Exhibit G.

"Upon the trial the Court found, in effect, that the plaintiffs had no exclusive right to the use of the label or trade-mark, and that the defendant was entitled to judgment dismissing the complaint."

From the judgment entered in accordance with such finding, the plaintiffs appealed.

For the appellants there was a brief by *Shepard & Shepard*, and oral argument by *T. W. Shepard* and *T. U. Pinney*.

Geo. E. Sutherland, for the respondent.

CASSODAY, J.:

1. A trade-mark performs a distinctive office. As such its use may be protected by the Courts. But this does not authorize a

monopoly upon fragments of the language, nor the exclusive appropriation of words in common use descriptive of common objects and qualities. It has often been decided that words which are merely descriptive of the kind, nature, style, character or quality of the goods or articles sold, cannot be exclusively appropriated and protected as a trade-mark.

In *Caswell v. Davis*, 58 *N. Y.*, 223, it was held that "words or phrases in common use, and which indicate the character, kind, quality and composition of an article of manufacture, cannot be appropriated by the manufacturer exclusively to his own use as a trade-mark." Accordingly, where the plaintiffs prepared a medicine, the principal ingredients of which were iron, phosphorus and elixir of calisaya bark, to which they gave the name of "Ferro-Phosphorated Elixir of Calisaya Bark," and so labeled the bottles containing it, the Court "held that this phrase could not be protected as a trade-mark." For the same reason it was held in *Taylor v. Gillies*, 59 *N. Y.*, 331, that as the words "gold medal" indicated quality, and that in some competitive exhibition a gold medal had been awarded to the article for its excellence, the use of them could not be appropriated as a trade-mark. So it was held that "Lackawanna Coal" was descriptive, and could not be appropriated as a trade-mark. *Canal Co. v. Clark*, 13 *Wall.*, 311. See also *Perry v. Truefitt*, 6 *Beavan*, 66; *Corwin v. Daly*, 7 *Bosworth*, 222; *Williams v. Johnson*, 2 *Bosworth*, 1; *Amoskeag Manuf'g Co. v. Spear*, 2 *Sandf.* (*S. C.*), 599; *Fetridge v. Wells*, 13 *How. Pr.*, 387-8; *Partridge v. Monck*, 2 *Barb. Ch.*, 101; *Popham v. Cole*, 66 *N. Y.*, 69. From these authorities it is evident that the words "Rheumatic Liniment," "Celebrated Liniment," and the other words in the label in question, descriptive of the liniment sold, could not be appropriated as a trade-mark.

2. It seems to be the office of a trade-mark to point out the true source, origin or ownership of the goods to which the mark is applied, or to point out and designate a dealer's place of business, distinguishing it from the business locality of other dealers. Such is substantially the rule laid down by many authorities. *Dunbar v. Glenn*, 42 *Wis.*, 118; *Gillott v. Esterbrook*, 48 *N. Y.*, 374; *Amoskeag Manuf'g Co. v. Spear*, 2 *Sandf.* (*S. C.*), 599;

Fetridge v. Wells, 13 *How. Pr.*, 385; *Barrows v. Knight*, 6 *R. I.*, 434; *Tilley v. Fassett*, 44 *Mo.*, 168; *Boardman v. Meriden Britannia Co.*, 35 *Conn.*, 402. There are many cases holding this doctrine, but these, and those above cited on the question of description, sufficiently indicate the rule. The words "Marshall's Liniment," "Marshall's Rheumatic Liniment," "Marshall's Celebrated Liniment," "Old Dr. S. Marshall's Celebrated Liniment," used in the various labels before us, could only, therefore, be protected as trade-marks in so far as they pointed out Marshall or old Dr. S. Marshall as the true originator or owner of the liniment to which they were attached. Of course, the address at the bottom of each label, by whomsoever used, indicated where and of whom the liniment could be obtained; and as it was sold almost wholly by being peddled out, no special mark or symbol was necessary or used to designate the dealer's place of business, distinguishing it from the business locality of other dealers, unless it was the vignette of the horse's head, which the plaintiffs never used and to which they make no claim. If the plaintiffs' label is entitled to the relief prayed for, it must be on the theory that they are entitled to the exclusive use of not only the word "Marshall's," but the words "Old Dr. Marshall's," as continuing to point out the true source, origin or ownership of the mixture, compound or liniment to which it was first applied by the father. True, old Samuel Marshall had a recipe of the mixture as early as 1827, but there is no pretence that he was the inventor, discoverer or originator of it. As stated, the father disclosed the secret to all his children, and each of them put it up, affixed the label in use, and sold or caused it to be sold for his or her own benefit, during the father's life-time, with his knowledge and in accordance with his often expressed wish. Upon his death it would seem that such sales were continued by the widow and some of the children as before.

Can this Court say, upon the facts of this case, that *Charles H.* had, prior to his father's death, by adoption and use acquired the exclusive right to the use of the word "Marshall's," or the words "Old Dr. S. Marshall's," as a trade-mark upon the mixture so put up and sold by him and his wife.

3. It must be remembered that the theory upon which actions for the infringement of a trade-mark are maintained, is that the law will not allow one person to sell his own goods as and for the goods of another. It is to prevent fraud and imposition upon the public, as well as the invasion of private rights. In *Singleton v. Bolton*, 3 *Douglass*, 293, the plaintiff's father sold a medicine called "Dr. Johnson's Yellow Ointment." After his death, his son, the plaintiff, continued to sell the same medicine, marked the same way. The defendant also sold the same medicine, with the same mark upon it, and so the plaintiff brought the action for infringement, but was non-suited. A rule for a new trial was discharged by Lord Mansfield, who said: "If the defendant had sold a medicine of his own under the plaintiff's name or mark, that would be a fraud for which an action would lie. But here both the plaintiff and defendant used the name of the original inventor, and no evidence was given of the defendant having sold it as if prepared by the plaintiff. The only other ground on which the action could be maintained, was that of property in the plaintiff, which was not pretended, there being no patent, nor any letters of administration."

In *Canham v. Jones*, 2 *Vesey & Beames*, 218, it appears that one Swainson was for thirty years the sole proprietor of the secret or recipe for preparing the medicine called "Velno's Vegetable Syrup," which he had purchased for £6,000, and by his will bequeathed the same to the plaintiff, who, after the testator's death, continued to make and sell the same preparation as specified by the recipe. The defendant had been employed in preparing the syrup for Swainson, but never knew the complete composition, as Swainson always added other essential ingredients; but after his death the defendant made at his residence and sold a medicine under the name of "Velno's Vegetable Syrup," and represented that it was precisely the same as that made and sold by the late Mr. Swainson. On demurrer it was held that the bill could not be maintained. Plumer, V. C., said: "The bill proceeds upon an erroneous notion of exclusive property now subsisting in this medicine, which Swainson, having purchased, had a right to dispose of by his will, and, as it is contended, to give the plaintiff

the exclusive right of sale. If this claim of monopoly can be maintained, without any limitation of time, it is a much better right than that of a patent." The Court then goes on to state that the case did not come within the class of cases "in which the Court had restrained a fraudulent attempt by one man to invade another's property," nor where one appropriates to himself the benefit of another's good-will, nor of one person falsely representing himself to be another, or his trade or production to be the same as another, thus combining imposition on the public with injury to the individual. The Vice-Chancellor, in closing, said: "The defendant does not hold himself out as the representative of Swainson, setting up a right in that character to the medicine purchased by him, but merely represents that he sells, not the plaintiff's medicine, but one of as good a quality. He is perfectly at liberty to do so. If any exclusive right in this medicine ever existed, it has long expired."

In *The Leather Cloth Co. v. The American Leather Cloth Co.*, 11 *Jurist, N. S.*, 513, Lord Cranworth, among other things, said: "Difficulties, however, may arise where the trade-mark consists merely of the name of the manufacturer. When he dies, those who succeed him (grandchildren, or married daughters, for instance), though they may not bear the same name, yet ordinarily continue to use the original name as a trade-mark; and they would be protected against any infringement of the exclusive right to that mark. They would be so protected, because, according to the ways of the trade, they would be understood as meaning no more by the use of their grandfather's or father's name, than that they were carrying on the manufacture formerly carried on by him. Nor would the case be necessarily different, if, instead of passing into other hands by devolution of law, the manufactory were sold and assigned to a purchaser. The question in every such case must be, whether the purchaser, in continuing the use of the original trade-mark, would, according to the ordinary usages of trade, be understood as saying more, than that he was carrying on the same business as had been formerly carried on by the person whose name constituted the trade-mark." *Page 516.*

The case before us differs from most cases in the fact that the name of the father had, for many years during his life, been attached to this mixture or liniment, whether put up and peddled out by his children or himself, and that it was the reputation of the liniment acquired by such peddling, instead of a particular place of trade, which gave it whatever value it had.

4. Upon the authorities cited it would seem to be very certain that *Charles H.* never acquired an exclusive right to the use of the word "Marshall's" or "Old Dr. S. Marshall's," upon the liniment put up by him, as against his father, mother, brothers or sisters. If the plaintiff, *Charles H.*, never acquired any such exclusive right as against them, it would seem quite doubtful whether he ever acquired it as against any one. By such diffusive use it may be that the word "Marshall's" had ceased to perform the office of a trade-mark, as above defined, if it ever in fact had that office. A trade-mark is to prevent fraud and imposition, not to inaugurate and perpetuate them. If old Samuel Marshall, surreptitiously or by favor of another, obtained the secret or recipe, and made up the mixture and sold it as "Marshall's Liniment," thus representing that he was the inventor or originator of the mixture when in fact it was discovered by another, it would seem to have been an imposition upon the public in its inception. Should such imposition be regarded as condoned by Samuel Marshall's long-continued use, and by his establishing for it a good reputation on account of its virtues and healing properties, yet it may be doubtful whether it would, as against the public, survive the appropriation and use by each member of his numerous family, and be protected as the trade-mark of each, a decade after his death. The question occurs, whom does the word "Marshall's" point out as the true source, origin or owner of the original genuine mixture, or what particular place of business or sale has it designated during these many years? If it never in fact, truly so pointed out or designated, or if by its distinctive use, or by the change from "Marshall's" to "Old Dr. S. Marshall's," it ceased to perform that function, then it can no longer be protected as a trade-mark.

In *Burgess v. Burgess*, 17 *Eng. L. & E.*, 257, John Burgess, the father of the plaintiff, had for some years manufactured and

sold, at No. 107 Strand, "a fish sauce," under the name of "Burgess's Essence of Anchovies." Then he took the plaintiff, his son William R., into partnership, and continued the business under the firm name of "John Burgess & Son," selling the same article under the same name. John died, and the plaintiff, William R., continued the business at the same place, in the name of the old firm, selling the same article under the same name, and employed the defendant, his son William H., on a salary in the business. Subsequently a difficulty arose between father and son, and the latter left the service of the former, and went into business for himself at another place, and commenced selling the same kind of fish sauce under the same name of "Burgess's Essence of Anchovies," at what he advertised as "Burgess's Fish Sauce Warehouse, late of 107, Strand," but at a lower price; and the bill charged that the sales were made as and for the article manufactured and sold by the plaintiff, and to deceive and defraud the plaintiff and the public. The Vice-Chancellor granted the injunction stopping the defendant, in so far as his advertisement indicated that he was the same man, and conducting the same business, as "late of 107 Strand," but refused to restrain him from manufacturing and selling "fish sauce," under the name of "Burgess's Essence of Anchovies;" and the appeal therefrom was dismissed. In giving the opinion of the Court, Knight Bruce, L. J., said: "All the queen's subjects have a right, if they will, to manufacture and sell pickles and sauces, and not the less that their fathers have done so before them. All the queen's subjects have a right to sell them in their own name, and not the less so that they bear the same name as their father; and nothing else has been done in that which is the question before us * * * * * He (the defendant) carries on business under his own name, and sells essence of anchovy as 'Burgess's Essence of Anchovy,' which it is * * * * * The only ground of complaint is the great celebrity which, during many years, has been possessed by the elder Mr. Burgess's essence of anchovy. That does not give him such exclusive right, such a monopoly, such a privilege, as to prevent any man from making essence of anchovy, and selling it under his own name." S. C., 17 *Jurist*, 292.

In *James v. James*, L. R., 13 Eq. Cas., 421, it was held, *per* Lord Romilly, M. R., that "any person who has, without the use of unfair means, become acquainted with the mode of compounding a secret, unpatented preparation, may, after the death of the original discoverer, make and sell the compound, describing it by the name of the discoverer, provided he does not lead the public to suppose that his preparation is the manufacture of the successors in business of the original discoverer; but he must not assert that his is the only genuine article, or suggest that the article manufactured by the successors of the original discoverer is spurious." S. C., 2 Eng., 365.

In *Massam v. Thorby's C. F. Co.*, 6 Ch. Div., 574, it was held, *per* Malins, V. C., that "any person who has become acquainted with the process of manufacturing an article which is in general secret, is entitled to manufacture it; and if the name of the first manufacturer has become attached to the article, any person afterwards manufacturing it is entitled to describe it by the name of such original manufacturer; and if he happens to be of the same name as the original manufacturer, he may use his name in describing his business, or allow it to be used by a company formed by him for the purpose of carrying on the business, notwithstanding that the representatives of the original manufacturer continue to carry on the old manufacture under the old name." S. C., 23 Eng., 175.

In *Meneely v. Meneely*, 62 N. Y., 427, it was held that "a person cannot make a trade-mark of his own name, and thus debar others having the same name from using it in their own business. Every man has the absolute right to use his own name in his own business, even though he may thereby interfere with and injure the business of another bearing the same name, provided he does not resort to any artifice or do any act calculated to mislead the public as to the identity of the establishments, and to produce injury to the other beyond that which results from the similarity of the names." To the same effect are *Gilman v. Hunnewell*, 122 Mass., 139; *Carmichael v. Latimer*, 11 R. I., 395.

In *Lea v. Deakin*, 18 A. L. R., 322, Judge Drummond refused to restrain the application of the word "Worcestershire," to sauce, on

the ground that the name had become generic, and that persons residing at a place of that name in England, and who there manufactured the sauce and sold it by that name, did not thereby acquire the exclusive use of the same as a trade-mark.

In *Cheavin v. Walker*, 5 Ch. Div., 850, (S. C., 22 Eng., 513), S. Cheavin and his son, G. Cheavin, manufactured and sold filters, which had been patented by the father, S. C., under the title and marked with the label as "S. Cheavin's Improved Patent Gold Medal Self-Cleaning Rapid Water Filters." After the father died, and the patent having expired, G. C. substituted his name in the place of his father's, and continued the manufacture and sale under the same name so modified, above which was a medallion containing the royal arms, surmounted by the words "By Her Majesty's Royal Letters Patent." The defendant left the employ of G. C., and began manufacturing and selling in the same town for himself filters similar in appearance to G. C's, and inscribed with "S. C's Patent Prize Medal Self-Cleaning Rapid Water Filters; Improved and Manufactured by Walker, Brightman & Co.;" and it was held by the Court of Appeals, reversing the Vice-Chancellor's decision:—"First, that the label used by the plaintiff was not a trade-mark, but only a description of the article as made according to S. C's patent, which was common to all the public; secondly, that there was nothing in the defendant's label calculated to mislead the public by a fraudulent imitation of the plaintiff's label, thirdly, that the plaintiff's label coupled with the medallion of the royal arms, constituted a false representation that the patent was still subsisting, and disentitled the plaintiff to relief by injunction."

In *Singer Manuf'g Co. v. Wilson*, 2 Ch. Div., 434, (S. C., 16 Eng., 827), it was held, in effect, on appeal, affirming the decree of the Master of the Rolls dismissing the bill, that "when a manufacturer, A. (Singer), has acquired a reputation in the market, so that the goods made by him are commonly known by his name, but is not possessed of any patent, a rival manufacturer, B. (Wilson), being entitled to imitate A's goods, is entitled also, provided that he does not place A's name on his own goods, to advertise his goods and offer them for sale by the name of A. (Singer),

if he takes care to state clearly at the same time that the goods which he sells are manufactured by himself." That case was subsequently reversed in the House of Lords, but without prejudice to any question in the case, in the event of further evidence being given, which was thereby authorized. 3 *Appeal Cas.*, 376; *S. C.*, 24 *Eng.*, 272. The syllabus of the case may seem to be in conflict with some of the cases cited, but it was really reversed on account of the irregularity of the proceedings, and because it was not essential for the plaintiffs to prove actual intent to deceive purchasers to make out a *prima facie* case; but that if the defendant's advertisements were calculated to mislead an unwary purchaser of the machines into the belief that he was purchasing those manufactured and sold by the plaintiffs, then they were *prima facie* entitled to an injunction; and all other questions were expressly reserved by the Lord Chancellor until further evidence should be adduced.

Applying the rules governing the authorities cited, to the case at bar, we are forced to conclude that any citizen had a perfect right to manufacture and sell the mixture or liniment formerly manufactured and sold by old Samuel Marshall.

5. It is equally clear that any of the Marshall children, or any other person by the name of Marshall, having acquired a knowledge of the compound, had a perfect right to manufacture and sell it, by himself or others, in his own name, even against the protest of old Samuel Marshall, provided he did not do it in such way as to be likely to mislead ordinary purchasers, proceeding with ordinary caution, into the belief that they were purchasing the liniment manufactured and sold by old Samuel Marshall himself. If this could be rightfully done, contrary to his wish and against his protest, it most certainly could be done by his children, as it was, with his expressed approbation. If such right to manufacture and sell existed as against old Samuel Marshall himself, then it most certainly did as against any one of his children. If none of his children could, in the case supposed, be restrained by the father during his life, it is equally certain that they could not be restrained by another, or even his representative, after his death. It would also seem to follow, from the cases cited, that

on the death of old Samuel Marshall (assuming that no one succeeded to the good-will of his business), any citizen would have the legal right to manufacture liniment composed of the same ingredients and made in the same way as he manufactured that sold by him, and also, in making sales, to describe it as such.

6. Upon that assumption the words "Old Dr. S. Marshall's Celebrated Liniment" were merely descriptive of the compound, and, if truthfully applied by the defendant in making sales, no one could rightfully complain, as no one had any patent upon it or exclusive right to the use of any words which aptly describe it. Upon his death, with no successor to the good-will of his business, those words would cease to indicate origin or ownership, and hence, cease to be a trade-mark.

There is no pretence that old Samuel Marshall ever, in the manufacture and sale of this liniment, perpetrated any actual or constructive fraud or deceit upon the business of *Charles H.* but on the contrary Exhibit B, which *Charles H.*, testified that he never used, and which it appears that the father, and other children under his authority, did use, closes with these words: "N. B., Dr. Marshall will hold himself responsible for the genuineness of no preparation which does not bear his own trade-mark of the horse's head." From this it would naturally be inferred that, in the opinion of the father, *Charles H.* was not selling the genuine mixture; but the fact that *Charles H.* knew the formula or recipe would seem to indicate that he did sell the same compound. That postscript or notice does not seem to have been used by the defendant or any of the children after the death of the father. There is nothing in the finding, and there seems to be no evidence, which would warrant us in holding that the defendant did anything in advertising and selling his mixture to lead the public to suppose that he was the successor of old Samuel Marshall, or that his was the only genuine article, or that the plaintiffs' mixture was spurious, or that he was selling the same as, and for the liniment manufactured by the plaintiffs; and without some of these things being done there would seem to be no ground for an injunction, within the doctrine of the above authorities.

Again, the long delay of *Charles H.* to assert an exclusive right to use the words "Old Dr. S. Marshall's Celebrated Liniment," would of itself, on a proper showing, seem to be an impediment to his protection in the exclusive use of them. *Beard v. Turner*, 13 *L. T. R.*, 746; *Flavell v. Harrison*, 19 *Eng. L. & Eq.*, 15; *Lea v. Deakin*, 18 *A. L. R.*, 322.

7. There is still another view of this case deserving notice. There is no claim that old Samuel Marshall, much less *Charles H.* actually discovered or invented the mixture or compound. There is no pretence that either had the exclusive right, during the life of the father, to manufacture and sell it under the name of "Marshall's Rheumatic Liniment," or "Old Dr. S. Marshall's Celebrated Liniment." These facts being admitted, it would seem to be at least extremely doubtful whether *Charles H.* ever acquired the exclusive right to their use as a trade-mark; and if such exclusive right was doubtful, it would seem to be contrary to the practice in equity to grant an injunction in the first instance.

In *Farina v. Silverlock*, 6 *De Gex, M. & G.*, 214, it was held, by Lord Chancellor Cranworth, that, "in a case where the mark consisted of a label in a certain form, and it was shown that in many instances labels the same as or similar to it might be sold for a legitimate purpose, the Court, in the absence of any proof of actual fraud, refused to restrain the printing and sale of such labels until the manufacturer, who alleged that they were used for a fraudulent purpose, had established his case by an action at law."

In *Spottiswoode v. Clark*, 10 *Jurist*, 1043, it was held by the Lord Chancellor, on a bill to restrain the defendant from selling a mark alleged to be a fraudulent imitation of the plaintiff's, "that, it not being perfectly clear that the plaintiff had a legal right, the injunction prayed for by the bill ought not to be granted." This is especially the rule where the plaintiff is himself seeking to deceive the public. *Pidding v. How*, 8 *Simons*, 477; *Motley v. Downman*, 3 *Mylne & Craig*, 1; *Clark v. Freeman*, 11 *Bevan*, 112; *Flavell v. Harrison*, 19 *Eng. L. & Eq.*, 15; *Perry v. Truefitt*, 6 *Beavan*, 66. Mr. Browne tersely states the true rule when he says: "The right to the use of the mark must be *exclusive* of all other persons. A trade-mark is an emblem

of a man just as much as his written signature, and is used to denote that an article of merchandise has been made by a certain person, or that it has been sold or offered for sale by him. If the same mark were to be used by different persons for the same species of goods, it would lead to inextricable confusion; and its true and only legitimate purpose would be overturned, for then it would lack the essential element of an indication of origin or ownership." Section 303. From this it would seem that *Charles H.* never had in himself any such exclusive right in the words in question as would authorize a Court of Equity to restrain others from using the same *bona fide* in the sale of their own goods, and without any tendency to deceive. The only remaining question is, whether the wife of *Charles H.* got such exclusive right by way of the alleged purchase from the mother, and the discovery after her death of the existence of a lost will left by the father, and the establishment of it as such, and the admitting of it to probate.

8. As suggested on the argument, neither the mother, *Mary J.*, nor the plaintiff, *Mary W.*, could get any title to the personal property, business, and good-will of the business of old Samuel Marshall, except through an administration upon his estate, and an order of distribution; and as no order of distribution was ever made, nor administrator or administratrix was ever appointed, it follows that the plaintiff, *Mary W.*, got nothing through the alleged purchase. *Murphy v. Hanrahan*, 50 Wis., 485. To the same effect is *Singleton v. Bolton*, *supra*. As no exclusive right of either of the plaintiffs was invaded, they were not entitled to an injunction by reason of any mere absence of such right on the part of the defendant.

BY THE COURT :

The judgment of the Circuit Court is affirmed.

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CIRCUIT COURT UNITED STATES, DISTRICT
OF KENTUCKY. IN EQUITY.

PEPPER

vs.

LABROT, AND ANOTHER.

DECIDED JULY, 1881.

REPORTED 8 FEDERAL REP., 29.

“Old Oscar Pepper Distillery” Case.

*Trade-Mark—“Old Oscar Pepper Distillery”—Descriptive, of
Place of Manufacture—Sale of Premises—Right of Purchaser
to Trade-Mark.*

The complainant, in 1874, was the owner by inheritance, of a tract of land on which his father, during his life-time, for many years had carried on a distillery, manufacturing whiskey, which, from the name of the distiller, became known as “Old Crow Whiskey,” and the distillery as Oscar Pepper’s Old Crow Distillery. The complainant erected a new distillery and manufactured whiskey, branding on the heads of the barrels “Old Oscar Pepper Distillery; Hand-Made Sour Mash; James E. Pepper, Proprietor, Woodford County, Ky.,” and used the same as a trade-mark in circulars, bill-heads, letter-heads, etc. Subsequently the complainant became bankrupt, and his distillery premises,

buildings, machinery, etc., were sold by his assignee under the name of the "Old Oscar Pepper Distillery," and became the property of the defendants, who operated the same by the manufacture of whiskey, using the trade-mark adopted by the complainant, substituting their own names as proprietors. A bill was filed by complainant to enjoin the use of the trade-mark, the defendants filing a cross-bill asking to be protected in their claim to its exclusive use. **HELD:**

1. That the trade-mark was a description of the place of manufacture, and did not designate, either expressly or by association, the personal origin of the product.
2. That the complainant, having ceased to be the owner of the distillery and proposing to use the name on whiskey to be manufactured elsewhere, had no right to the exclusive use of the trade-mark as against the defendants, who could use it as a truthful description of their own production.
3. That the complainant had no right to use it at all, because to do so would be to deceive and mislead the public by a false representation in respect to the place of the manufacture of his goods.
4. That the defendants, by virtue of their ownership of the Old Oscar Pepper Distillery, succeeded to the exclusive right to use that name for their premises and place of manufacture, and to brand it on the packages of their merchandise for the purpose of truly indicating it as a product of a distillery well known by that name.

TRADE-MARK.—Bill for injunction and account, and cross-bill for injunction. Final hearing upon pleadings and proofs.

Barrett & Brown and John Marshall, for complainant.

1. Complainant's trade-mark embodied his family name, and was therefore peculiarly appropriate. See *Ainsworth v. Walmsley*, 44 *L. J.*, 252. The right to use the name passed from father to son as a *personal* right, not as a chattel real. See *Dixon Crucible Co. v. Guggenheim*, *Cox's Trade-Mark Cas.*, 577.

2. Did the trade-mark pass to the assignee in bankruptcy and from him to defendants by their purchase? A general assignment under State laws does not carry a trade-mark. *Bradley v. Norton*, 33 *Conn.*, 157. Vendee in bankruptcy acquires no right as against bankrupt to a trade-mark which he used to designate his own preparations. *Hembold v. Hembold Co.*, 53 *How. Pr.*, 453.

3. Conveying the distillery as the "Old Oscar Pepper Distillery" did not give defendants a right to use the term as descriptive of their whiskey. *Dixon Crucible Co. v. Guggenheim, Cox's Trade-Mark Cas.*, 577; *Howe v. Searing, Id.*, 244; *McArdle v. Peck, Id.*, 312; *Woodward v. Lazar, Id.*, 300. By purchasing the realty, the vendee does not acquire the right to trade-marks used upon it, and one may use his trade-mark in a new place, though it was local in its original significance. *Wotherspoon v. Currie*, 23 *L. T. Rep.*, 443; 5 *E. & I. App.*, 508.

W. Lindsay, for defendants, cited.—

Leather Cloth Co. v. Am. Leather Cloth Co., Cox's Am. Trade-Mark Cas., 704; *Congress Spring Co. v. High Rock Congress Spring Co., Id.*, 630; *Kidd v. Johnson*, 100 *U. S.*, 620; *G. & H. Manuf'g Co. v. Hall*, 61 *N. Y.*, 229; *Carmichael v. Latimer*, 11 *R. I.*, 407; *Hall v. Barrows*, 4 *De Gex*, *Jones & Smith*, 151; *Booth v. Jarrett*, 52 *How. Pr.*, 169; *Canal v. Clark*, 13 *Wall.*, 325, referred to in Mr. Justice Matthews' opinion; and also *Llewellen v. Ruth-erford*, 49 *Barb.*, 588; *Newman v. Alford*, 49 *Barb.*, 588.

Before Mr. Justice MATTHEWS and BARR, D. J.

MATTHEWS, Circuit Justice:

This is a bill in equity filed October 23, 1880, the complainant being a citizen of the State of New York, and the defendants citizens of Kentucky.

It is alleged that both parties are, and have been, engaged in the manufacture and sale of whiskey. The complainant claims to be the originator, inventor, and owner of a certain trade-mark and brand for whiskey made by him, consisting of the words "Old Oscar Pepper," and also of an abbreviation thereof, consisting of the letters "O. O. P." He alleges that the said words and letters were and are a fanciful and arbitrary title and trade-mark and brand intended to designate and identify whiskey of his manufacture, the use of which he began in 1874, continued since by branding and marking the words on each barrel, and using the letters as an abbreviation in correspondence and contracts con-

cerning the article; the whiskey so designated having acquired that name, and being well and favorably known thereby. He says that the said words and trade-mark were made up in fact of the family name of the complainant, and embodied the name of his father, and had never before been so used. He avers that the whiskey made by him, and so branded, marked, and known, was very carefully manufactured, and of excellent quality, and of great reputation in the market, commanding a ready sale at profitable prices, and was identified by said trade-mark as of the complainant's make, whereby the said trade-mark has become of great value to him. He alleges that the trade-mark, "Old Oscar Pepper," was used by him by burning the same upon and into the heads of barrels containing whiskey made by him, in a form set out as an exhibit to the bill. A copy is here set out as follows:



The same device on a smaller scale was printed upon the letter heads and bill-heads and business cards used by him in corresponding, and other business, concerning his whiskey; and was also attached to and pasted upon all small packages and samples of the whiskey made by him, and was used to identify, and was universally recognized as identifying, the whiskey made by him.

On November 13, 1877, the complainant procured a certificate of the registration of said trade-mark under the laws of the United States.

The bill charges that the defendants have sought to appropriate the complainant's trade-mark to their own use, and are using, upon barrels of whiskey made by them, a similar device, a copy of which is exhibited. It is as follows:



It is alleged that this is done by the defendants with the wrongful and fraudulent design to procure the custom and trade of persons who are or have been in the habit of buying, vending, or using the genuine whiskey made by the complainant, and of illegally and fraudulently promoting the introduction and sale of the defendants' own whiskey, under the cover and reputation of the complainant's trade-mark, and of inducing unsuspected persons to purchase the whiskeys of defendants as and for the genuine "Old Oscar Pepper" whiskey, manufactured by the complainant. It is charged, also, that with like intent the defendants are using the same device and trade-mark upon their letter-heads, and business cards, and other papers and advertisements, and upon packages containing their whiskey. It is also charged that this conduct of the defendants is injurious to the complainant in the sale of his whiskey, and in the profits thereof, and that, by reason of the inferior quality of the whiskey sold by defendants under such trade-mark, the reputation of the complainant's whiskey is greatly prejudiced and injured in the markets of the country, and a fraud and deception practiced upon the public, many of whom are in-

duced to purchase the defendants' whiskey, believing it to be the manufacture of the complainant.

The bill accordingly prays for an injunction and an account.

The defendants filed an answer in which they admit that they have been and are engaged in manufacturing and selling whiskey, their distillery being in Woodford County, Kentucky, and long known and designated as the "Old Oscar Pepper Distillery." They deny that the complainant is the originator or owner of the trade-mark or brand for whiskey made by him, as claimed, and deny that the words "Old Oscar Pepper," or the abbreviation of them, by letters "O. O. P.," have ever been used as an arbitrary or fanciful title or trade-mark for whiskey, or that they were ever so used by the complainant, and allege that they were never used by him except in connection with the word "distillery," and then only for the purpose of showing that the whiskey in reference to which they were so used, was manufactured at and was the product of the Old Oscar Pepper Distillery. The defendants claim that the use of the same by the complainants as a brand for their whiskey, manufactured elsewhere, would be a fraud on the public, as well as on the defendants. They say that several years since the complainant became the owner of 33 acres of land in Woodford County, Kentucky, known as the land used by Oscar Pepper for distillery purposes, upon which there was a distillery, and machinery, warehouse, and other improvements; that said distillery, during the life-time of Oscar Pepper, the father of the complainant, became famous because of the superior quality of the whiskey there produced, which was attributed, by dealers in whiskey, to the peculiar character and properties of the water used in the process of distillation; that in 1874, the complainant, in company with one E. J. Taylor, Jr., with whom he was associated in business, operated said distillery, and formally named it the "Old Oscar Pepper Distillery," and procured a large number of iron signs to be made and distributed throughout the country, containing a correct drawing of the distillery and warehouse building, and an accurate view of the old Oscar Pepper homestead or dwelling, which drawing and view they surrounded with the words, in a circular form, above the same, "Old Oscar Pepper's Distillery,"

and below, in a straight line, "Woodford Co., Kentucky," and thus, as is claimed, fixed and determined the name of said distillery. They also procured an iron brand to be made, and with it burnt into the head of each barrel of whiskey manufactured in said distillery, the words—



for the purpose, as is alleged, of identifying it as the product of the Old Oscar Pepper Distillery. It is also alleged that the complainant advertised his business in a circular, as follows:

"Having put in the most thorough running order, the old distillery premises of my father, the late Oscar Pepper, (now owned by me), I offer to the first-class trade of this country, a hand-made sour mash, pure copper whiskey of perfect excellence. The celebrity attained by the whiskey made by my father was ascribable to the excellent water used, (a very superior spring), and the grain grown on the farm adjoining by himself, and to the process observed by James Crow, after his death, by William F. Mitchell, his distillers. I am now running the distillery with the same distiller, the same water, the same formulas, and grain grown upon the same farm."

He also circulated a similar certificate from his distiller, Mitchell, who said:

"I am employed by James E. Pepper as distiller, and the whiskey I now make is from the same formula as the celebrated

Crow whiskey manufactured by James Crow and myself for his father, (the late Oscar Pepper), at the same place, and is of the same excellence, being identical in quality. I use the same water, the same grain, the same still."

It is also alleged that the complainant, in March, 1877, was declared a bankrupt, and that among other assets the tract of land and the distillery thereon, with all the appurtenances and fixtures, were sold by the assignee, and by mesne conveyances became vested in the defendants, who have since operated the same for the manufacture of whiskey; and that the complainant in the meantime has been, and is now, operating a distillery in Fayette County, Kentucky, as the sole place of the manufacture of his whiskey, and that consequently he cannot use the brand formerly used by him while operating the "Old Oscar Pepper Distillery," without making a false and fraudulent representation as to the place of manufacture.

The defendants admit that since they have owned and operated the Old Oscar Pepper Distillery, they have used the brand set out in the pleadings, but merely for the purpose of identifying their whiskey as the product of that distillery, as follows:



They claim the right so to do by virtue of their ownership of the distillery, of which they say that is the proper name.

On November 23, 1880, the defendants also filed their cross-bill, setting up in substance the same facts, and claiming that they are entitled to the exclusive use as a trade-mark of the brand described in the pleadings as used by them, and praying to be protected therein by a perpetual injunction.

To this cross-bill the complainant filed his answer, insisting upon his claims to the injunction and right to the exclusive use of the trade-mark, "Old Oscar Pepper," and the abbreviation of "O. O. P.," as applied to whiskey. He alleges that his father, during his life-time, Oscar Pepper, operated a distillery on the premises mentioned, and manufactured an article which became well and favorably known to the trade as "Crow" or "Old Crow" whiskey, from the name of the distiller, and that in consequence the distillery became known as the "Old Crow Distillery;" that after his father's death, the distillery tract having come into his possession, he leased it to W. A. Gaines & Co., who continued the manufacture of whiskey under the same trade-name and mark of "Crow," or "Old Crow," but that afterwards the complainant, having gone into the business himself, built on the same site an entirely new distillery, and manufactured whiskey which he called by the name of "Old Oscar Pepper," and so marked and branded the packages, and thereby originated and adopted it as his trade-mark to identify and distinguish the whiskey made by him, and it became well and favorably known as such. He says that in the manufacture of his whiskey, he used neither the same distillery building at which the "Crow" whiskey was manufactured, nor the identical spring of water which had been used in connection with it, but another spring in the same vicinity of the same quality; all springs of water in the same geological formation throughout the Counties of Woodford, Fayette, Bourbon, Harrison, and the blue-grass section of Kentucky being substantially alike in quality, and the whiskey made from one indistinguishable from that made, with equal care and skill and by the same process, at any other.

And the complainant insists that the name "Old Oscar Pepper" was never applied to the distillery premises until after he had adopted it as the name of whiskey made by him, and then only

as indicating the place where he made his "Old Oscar Pepper" whiskey; and that it was not the name of the distillery which was applied to designate the whiskey made there, but the name of the whiskey which was applied to designate the distillery at which it was made, so far as it was ever so known or called. He charges that the use by the defendants of the words "Old Oscar Pepper Distillery," as descriptive of the locality, is a subterfuge and evasion, their real intent being to use the words as describing their make of whiskey, and thereby wrongfully to use complainant's trademark and pirate his trade.

General replications perfect issue arising both on the original and cross-bills, and the cause has been submitted on final hearing upon the pleadings and proofs.

It is manifest that the controversy between the parties, in the first instance, is one of fact.

The construction of the complainant is, that the words "Old Oscar Pepper" and the abbreviation of them, "O. O. P.," constitute a brand or mark originally adopted by him to designate whiskey as made by him, without reference to the place of manufacture; and that by use and recognition it has become associated in the minds of dealers and the public with the article manufactured by him, so as to constitute its name in the trade, whereby to distinguish it from a similar article made by any and all others.

On the other hand, the defendants claim that the words in question were originally used, and their use subsequently continued, merely to designate the fact that the whiskey contained in the packages so marked or spoken of in advertisements, circulars, signs, etc., on which the mark was burned or printed, was made at the distillery so designated; and that that was done because the distillery, or its predecessor on the same site, had acquired a reputation in connection with the manufacture of whiskey which was sufficient to recommend any article made at the same place.

Undoubtedly the interference, from the plain meaning of the words themselves, supports strongly the claim on the part of the defendants.

The complainant's brand or mark, as claimed and used by him, is "Old Oscar Pepper Distillery, Woodford Co., Ky.," James E.

Pepper, proprietor; the words "hand-made sour mash" describe the quality of the whiskey; and as to the rest, the plain and unequivocal meaning is that it is the product of the "Old Oscar Pepper Distillery," of which James E. Pepper is proprietor.

The complainant in his testimony endeavors to explain his use of the word "distillery" in this connection, so as to make its use consistent with his claim that the words "Old Oscar Pepper" were intended to designate the whiskey and not the distillery. He says: "In branding the ends of my barrels, I put the word 'distillery' to show that the 'Old Oscar Pepper' whiskey was a straight whiskey made by me, and at my own distillery, and not a compounded whiskey; and the use of the word 'distillery,' on the heads of the barrels following the trade-mark, indicated a straight whiskey as distinguished from a compounded whiskey."

But the explanation does not seem sufficient. The use of the word "distillery" does, indeed, seem to advertise the fact that the whiskey is distilled, and not rectified, but it does so by designating the spirits contained in the package as the product, not merely of a distillery, but of the particular distillery known as the "Old Oscar Pepper Distillery," of which James E. Pepper is proprietor.

It is true that Beecher, one of the firm of Ives, Beecher & Co., the merchants who sold the complainant's whiskey in New York, testifies that the whiskey acquired its reputation under the name of "Old Oscar Pepper" or "O. O. P." whiskey, and known by that name, and inquired after and bought and sold by that designation. He says my firm buy whiskey under the name of "Old Oscar Pepper." But he immediately explains that "we buy as 'Old Oscar Pepper,' whiskey to be made at the distillery where James E. Pepper first made the whiskey known to the trade by that name." (Answer to the twenty-third interrogatory). And in answer to the seventh cross-interrogatory he says:

"At the time my firm commenced dealing in 'Old Oscar Pepper' whiskey, that name added to the reputation and salability of the whiskey, for the reason that that was the name of James E. Pepper's father, and his father had made good whiskey at that

very distillery for several years previous to the making of any by James E. Pepper."

It is beyond dispute that Ives, Beecher & Co. introduced the complainant's manufacture of whiskey to the trade under the name of Old Oscar Pepper whiskey, upon the credit of the old distillery of Oscar Pepper, and recommended them as of superior excellence because they were the product of that distillery. This was done by advertisements in circulars, containing certificates and affidavits, one from James E. Pepper himself, that he had put in the most thorough running order "the old distillery of my father, the late Oscar Pepper, now owned by me;" that "the celebrity attained by the whiskey made by my father was ascribable to the excellent water used (a very superior spring) and the grain grown on the farm adjoining by himself, and to the process observed by James Crow, after his death by W. F. Mitchell, his distillers;" that "I am now running the distillery with the same distiller, the same water, the same formula, and grain grown upon the same farm, consequently my product being of the same quality and excellence." Another certificate and affidavit so published was from his mother, in which she stated that her son, James E. Pepper, is the owner of the old distillery property, situated in the County of Woodford, State of Kentucky, formerly owned by her deceased husband, Oscar Pepper, and known as the "Old Crow Distillery."

"The buildings have been thoroughly improved. Mr. W. F. Mitchell, who distilled for the late Oscar Pepper, succeeding James Crow, is employed by my son, and the product is of the highest excellence, and recognized as fully up to the standard of the celebrated old product from the same stills."

And the distiller, Mitchell, also certifies: "I use the same water, the same grain, and the same STILL."

It does not avail the complainant now to repudiate these representations, or to insist that they are altogether immaterial. It may be true, as he now says, that in point of fact his distillery was altogether distinct as a building and machinery from that so long operated by his father, and that he did not use the same spring of water and the same stills; and it may be equally true that, so far as the intrinsic quality of the whiskey is concerned, the circum-

stances referred to were altogether unimportant, for the reason that the product of equally good materials, made in the same geological region, in the best manner known to those engaged then in the manufacture, could not be distinguished from the favorite article known by the name of any particular distillery. Nevertheless, it remains quite certain, from the proofs in this case, that the complainant succeeded in establishing a market for his manufacture, upon the special belief of the public that it must be like that made by his father, because made at the same locality and with all the advantages it was thought to confer. In other words, he sought and obtained for his own manufacture, by the use of the name of his father's distillery, the reputation established by Oscar Pepper for his own.

Oscar Pepper manufactured at his distillery for many years previous to his death in 1865, probably as early as 1838, and the distillery was known in the neighborhood, as some witnesses testify, as Oscar Pepper's distillery. This, indeed, would be most natural. Afterwards, the whiskey distilled there under the management of James Crow became extensively and favorably known as "Old Crow" whiskey, and the distillery acquired the name of the Old Crow Distillery; and that name was used after the death of Oscar Pepper, by successive lessees of the establishment, as a trade-mark to designate its production; but during that period the name of Oscar Pepper, as formerly connected with it, appeared in the brands and marks used by Gaines, Berry & Co. while they were carrying it on. They styled themselves on business cards "Lessees of Oscar Pepper's 'Old Crow' Distillery." In 1874 the trade-mark of "Old Crow" having previously, by Gaines, been transferred to the product of another distillery owned or operated by him or his firm, the complainant came into possession of his own distillery, and it became known as the "Old Oscar Pepper Distillery." The deed directly to the complainant of the distillery premises, made by a commissioner in pursuance of a decree for partition, refers to an accompanying plat in which the "Old Crow Distillery" is designated; but early in 1875 an agreement was made by the complainant with one E. H. Taylor, Jr., reciting that the former was owner of the premises upon which is situate the old

distillery, which was operated and run by the said Oscar Pepper in his life-time, and providing means for a thorough reparation of said old distillery, and of operating the same for the purpose of manufacturing copper whiskey of the grade, character, and description of that which was made by the said Oscar Pepper in his life-time, when James Crow and W. F. Mitchell were his distillers. The complainant having, upon his own petition, been declared a bankrupt, filed the required schedule of his assets and liabilities, in which he described the tract of land inherited from his brother as including the "Old Oscar Pepper Distillery;" and as such it was known at the time the title became vested in the defendants:

The clear result of the whole evidence seems, in our opinion, to be that the complainant adopted the name of "Old Oscar Pepper Distillery" as the name of his distillery, in order that the whiskey manufactured by him there might have the reputation and whatever other advantages were to result from that association.

That distillery having now become the property of the defendants by purchase from the complainants, can they be denied the right of using the name by which it was previously known in the prosecution of the business of operating it, and of describing the whiskey made by them as its product?

Can the complainant be permitted to use the brand or mark formerly employed by him, to represent whiskey made by him elsewhere as the actual product of this distillery?

Both these questions, in our opinion, must be answered in the negative.

The most recent statement of the law applicable to this subject by the Supreme Court of the United States is found in the case of *The Amoskeag Manuf'g Co. v. Trainer*, 101 U. S., 51. In that case Mr. Justice Field said:

"The general doctrines of the law as to trade-marks, the symbols or signs which may be used to designate products of a particular manufacture, and the protection which the Courts will afford to those who originally appropriated them, are not controverted. Every one is at liberty to affix to a product of his own manufacture any symbol or device not previously appropriated, which will distinguish it from articles of the same general nature manufactured

or sold by others, and thus secure to himself the benefit of increased sales by reason of any peculiar excellence he may have given to it. The symbol or device thus becomes a sign to the public of the origin of the goods to which it is attached, and an assurance that they are the genuine article of the original producer. In this way it often proves to be of great value to the manufacturer in preventing the substitution and sale of an inferior and different article for his products. It becomes his trade-mark, and the Courts will protect him in its exclusive use, either by the imposition of damages for its wrongful appropriation, or by restraining others from applying it to their goods, and compelling them to account for profits made on a sale of goods marked with it. The limitations upon the use of devices as trade-marks are well defined. The object of the trade-mark is to indicate, *either by its own meaning or by association*, the origin or ownership of the article to which it is applied. If it did not, it would serve no useful purpose either to the manufacturer or to the public. It would afford no protection to either against the sale of a spurious in place of the genuine article. This object of the trade-mark, and the consequent limitations upon its use, are stated with great clearness in the case of *Canal Co. v. Clark*, 13 Wall., 1. There the Court said, speaking through Mr. Justice Strong, that no one can claim protection for the exclusive use of a trade-mark or trade-name which would practically give him a monopoly in the sale of any goods *other than those produced or made by himself*. If he could, the public would be injured rather than protected, for competition would be destroyed. Nor can a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, be employed as a trade-mark. and the exclusive use of it be entitled to legal protection."

In the case of *Canal Co. v. Clark*, 13 Wall., 322, it is stated that the—

"Office of a trade-mark is to point out distinctively the origin or ownership of the article to which it is affixed; or, in other words, *to give notice who was the producer*."

And that there are some limits to the right of selection will be manifest. It is further said, in that case :

“When it is considered that in all cases where rights to the exclusive use of a trade-mark are invaded, it is invariably held that the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another; and that it is only when this false representation is directly or indirectly made that the party who appeals to a Court of equity can have relief. This is the doctrine of all the authorities.”

“And it is obvious that the same reasons,” continues the opinion in that case, “which forbid the exclusive appropriation of generic names, or of those merely descriptive of the article manufactured, *and which can be employed with truth by other manufacturers*, apply with equal force to the appropriation of geographical names designating districts of country. Their nature is such *that they cannot point to the origin (personal origin)* or ownership of the article of trade to which they may be applied. They point *only at the place of production, not to the producer*, and could they be appropriated exclusively—the appropriation would result in mischievous monopolies.”

In the same opinion, Mr. Justice Strong quoted, with approval an extract from the opinion in the case of the *Amoskeag Manuf. Co. v. Spear*, 2 *Sandford, Sup. Ct.*, 509, as follows :

“The owner of an original trade-mark has an undoubted right to be protected in the exclusive use of all the marks, forms, or symbols that were appropriated as designating the time, origin, or ownership of the article or fabric to which they are affixed ; but he has no right to the exclusive use of any words, letters, figures, or symbols which have no relation to the origin or ownership of the goods, but are only meant to indicate their names or quality. *He has no right to appropriate a sign or symbol, which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose.*”

Following and applying the principle expressed in the last sentence of this extract, Mr. Justice Strong, in the opinion from which we are still quoting, says :

“It is only when the adoption or imitation of what is claimed to be a trade-mark amounts to a false representation, express or

implied, designed or incidental, that there is any title to relief against it. True, it may be that the use by a second producer, in describing truthfully his product, of a name or a combination of words already in use by another, may have the effect of causing the public to mistake as to the origin or ownership of the product ; but if it is just as true in its application to his goods as it is to those of another who first applied it, and who, therefore, claims an exclusive right to use it, there is no legal or moral wrong done. Purchasers may be mistaken, but they are not deceived, by false representations, and equity will not enjoin against telling the truth."

Tried by these principles, it would seem that the trade-mark claimed by the complainant cannot be sustained as a designation of whiskey manufactured by him without reference to the place of its production, and that it is not, therefore, a lawful trade-mark at all, in the proper sense of that term. It is rather the trade-name of the distillery itself, of which he was at one time the proprietor, but which now is the property of the defendants. Neither by its own meaning, nor by association, does it indicate the personal origin or ownership of the article to which it is affixed. It does not seem to give notice who was the producer. It could be applied by him, with truth, to his goods only while he was owner of the distillery named, and then only, not to all whiskey of his manufacture, but only to that actually produced at that distillery. It can now be used without practicing a deception upon the public only by the defendants. It points only at the place of production, not to the producer. If a trade-mark at all, in any lawful sense, it is only in its use in connection with the article which it truthfully describes ; that is, whiskey which is actually manufactured at the Old Oscar Pepper Distillery, in Woodford County.

In the case of *Hall v. Barrows*, 4 *De Gex, Jones & Smith*, 157, there was a trade-mark altogether distinct from the name of the works, being the initials of the names of two of the original firms which owned the works, stamped upon the iron produced at the works. The question was whether, in a sale of the works and business to a surviving partner, the trade-marks should be val-

ued as passing in the sale. The Lord Chancellor, Westbury, said :

“ There is nothing in the answer or evidence to show that the iron marked with these initials has, or ever had, a reputation in the market because it was believed to be the actual manufacture of one of the two original firms. Now, if I adopted the distinction drawn by the Master of the Rolls between local and personal trade-marks, I should be more inclined to treat this mark as incident to the possession of the Bloomfield Iron Works, for it has been used by the successive owners of such works, and seems to have been used by the last partnership in no other right. In this respect the case resembles that of *Motley v. Dowman*, 3 *Myl. & Cr.* 1.

“ But it is unnecessary to pursue this further, for I am of opinion that these initial letters, surmounted by a crown, have become, and are, a trade-mark, properly so-called—that is, a brand which has reputation and currency in the market; as a well-known sign or quality; and that as such the trade-mark is a valuable property of the partnership, as an addition to the Bloomfield Works, and may be properly sold with the works, and therefore properly included as a distinct subject of value in the valuation to the surviving partners.

“ It must be recollected that the question before me is simply whether the right to use the trade-mark can be sold along with the business and iron works, so as to deprive the surviving partner of any right to use the mark in case he should set up a similar business. Nothing that I have said is intended to lead to the conclusion that the business and iron works might be put up for sale by the Court in one lot, and that the right to use the trade-mark might be put up as a separate lot, and that one lot might be sold and transferred to one person, and the other lot sold and transferred to another; the case requiring only that I should decide that the exclusive right to this trade-mark belongs to the partnership as part of its property, and might be sold with the business and work and as a valuable right, and if it might be so sold, it must be included in the valuation to the surviving partner.”

It will be observed with what pains the Lord Chancellor guards against the conclusion that, even in such a case, the title to the

trade-mark could be separated from that of the establishment upon the product of which it had always been used, even when the trade-mark was not the mere name of the place of manufacture, but a trade-mark proper, denoting the personal origin of the manufactured article.

The case of *Kidd v. Johnson*, 100 U. S., 617, is to the like effect. The trade-mark in that case—"S. N. Pike's Magnolia Whiskey, Cincinnati, Ohio"—was a trade-mark proper; that is, indicated the personal origin of the manufacture, and was not the mere name of the place of manufacture. Pike sold his establishment to be carried on for the same business by his successors, and with it, the right to use his brands. The Court said, in deciding the case, (p. 620):

"As to the right of Pike to dispose of his trade-mark in connection with the establishment where the liquor was manufactured, we do not think there can be any reasonable doubt.

"It is true, the primary object of a trade-mark is to indicate by its meaning or association the origin of the article to which it is affixed. As distinct property, separate from the article created by the original producer or manufacturer, it may not be the subject of sale. But when the trade-mark is affixed to articles manufactured at a particular establishment, and acquires a special reputation in connection with the place of manufacture, and that establishment is transferred either by contract or operation of law to others, the right to the use of the trade-mark may be lawfully transferred with it.

"Its subsequent use by the person to whom the establishment is transferred, is considered as only indicating that the goods to which it is affixed are manufactured at the same place, and are of the same character as those to which the mark was attached by its original designer. Such is the purport of the language of Lord Cranworth in the case of *Leather Cloth Co. v. American Leather Leather Cloth Co.*, reported in 11 Jur. (N. S.), 513. See, also, *Ainsworth v. Walmesley*, 54 L. J., 355, and *Hall v. Burrows*, 10 Jur. (N. S.), 55."

The observations of Lord Cranworth in the *Leather Cloth Cases*, referred to in this citation, are as follows :

“But I further think that the right to a trade-mark may, in general, treating it as property, or as an accessory of property, be sold and transferred upon a sale and transfer of the manufactory of the goods on which the mark has been used to be affixed, and may be lawfully used by the purchaser. Difficulties, however, may arise where the trade-mark consists merely of the name of the manufacturer. When he dies those who succeed him (grandchildren or married daughters, for instance), though they may not bear the same name, yet ordinarily continue to use the original name as a trade-mark, and they would be protected against any infringement of the exclusive right to that mark. They would be so protected, because, according to the usages of trade, they would be understood as meaning no more by the use of their grandfather's or father's name than that they were carrying on the manufacture formerly carried on by him. Nor would the case be necessarily different if, instead of passing into other hands by a devolution of law, the manufactory was sold and assigned to a purchaser.

“The question in every such case must be, whether the purchaser, in continuing the use of the original trade-mark, would, according to the ordinary usages of trade, be understood as saying more than that he was carrying on the same business as had been formerly carried on by the person whose name constituted the trade-mark. In such a case I see nothing to make it improper for the purchaser to use the old trade-mark, as the mark would, in such a case, indicate only that the goods so marked were made at the manufactory which he had purchased.”

In the foregoing cases, the trade-mark consisted either in some arbitrary and fanciful name given to the product, or in the name or initials of the original producer, and it was held, even in respect to them, that the exclusive right to continue their use might pass to a purchaser of the place of production, carrying on the business of producing the same article.

It is a fair inference from these authorities that when, as in the present case, the trade-mark consists merely in the name of the establishment itself where the manufacture is carried on, and becomes attached to the manufactured article only as the product of

that particular establishment, a sale of the establishment will carry with it to the purchaser the exclusive right to use the name it had previously acquired, in connection with his own manufacture at the same place of a similar article, by operation of law. For that proposition, the case of the *Congress Spring, Cox's American Trade-Mark Cases*, 599, is a direct authority. The Court of Appeal, per FOLGER, J., (630), said :

“The plaintiff purchased of the former proprietors the spring. They took the whole property in it. They thus obtained that which was the prime value of it, the exclusive right to preserve its water in bottles, as an article of merchandise, and the exclusive right to sell it when bottled. Thus they acquired the business of their predecessors, for the plaintiff, owning the spring, no one else could carry on the business. And, under the rules above stated, they acquired by assignment, or operation of law, the right to the trade-mark, before that time in use, to designate the article upon which this business was carried on.”

It is true, as observed by counsel in argument, that in that case the article of merchandise was a natural, and not, as in the present, an artificial production. That circumstance was observed upon, in the argument of that case, as a reason for refusing the protection claimed for the trade-mark by the purchaser. The Court said in reply, (p. 625):

“It is true that, in most of the cases which have been the occasion of the rules laid down on this subject, the article in question has been artificial. But it will be difficult to show a reason for any of those rules which does not apply to the proprietorship of an unique product of nature, as well as to that of an unique product of art.”

The following cases are cited without comment as sustaining the same proposition; *G. & H. Manuf'g Co. v. Hall*, 61 N. Y., 229; *Carmichael v. Lattimer*, 11 R. I., 407; and *Booth v. Jarrett*, 52 How. Pr., 169.

The cases cited and relied upon by counsel for complainant do not seem to us to affect the question in the view which we have taken of the facts. The only one upon which we think it important to submit a comment is that of *Wotherspoon v. Currie*, L. R.,

5 *Eng. & Ir. Ap.*, 521, and that, only because it seems to be urged as inconsistent with the view we have been compelled to adopt. In that case the controversy turned upon the exclusive right to the word "Glenfield," as applied to starch originally made at a village of that name, the manufacture of which was subsequently removed to another place, as against the defendant subsequently manufacturing at the original place—Glenfield—and claiming on that account the right to use the name in connection with the starch made by him. Lord Westbury stated the point on which the final decision in favor of the complainant was rested, with clearness. He said:

"I take it to be clear from the evidence that long antecedently to the operations of the respondent the word 'Glenfield' had acquired a secondary signification or meaning in connection with a particular manufacture; in short, it had become the trade denomination of the starch made by the appellant. It was wholly taken out of its ordinary meaning, and in connection with starch had acquired that peculiar secondary signification to which I have referred. The word 'Glenfield,' therefore, as a denomination of starch, had become the property of the appellants. It was their right and title in connection with the starch."

We do not find in the present case any state of facts corresponding with this. The words "Old Oscar Pepper Distillery" never lost their primary signification, and never acquired any secondary meaning; and, as applied to the whiskey made by the complainant, the words "Old Oscar Pepper," and their abbreviation "O. O. P." never came to mean more than whiskey that had been made at that particular distillery. They did not become a denomination of whiskey as the manufacture of the complainant or of any person, but characterized it only as entitled to public favor by reason of the reputation of the particular distillery at which it purported to have been made.

For these reasons we are of opinion that the equity of the case, both upon the original and cross-bills, is with the defendants. A decree may be entered accordingly.

BARR, D. J., concurred.

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IN THE UNITED STATES PATENT OFFICE.

EX PARTE FAIRCHILD.

DECIDED 10 AUGUST, 1881.

REPORTED 21 O. G., 789.

“Fairchild” Case.

TRADE-MARK—PROPER NAME OF APPLICANT.

1. The Act of March 3, 1881, does not define what shall constitute a legal trade-mark, but it does declare what shall be registered as such, among its prohibitions is “merely the name of an applicant.”
2. “Merely the name of an applicant,” held to mean the name of the applicant, separate and alone.
3. The mere name of a person does not form a proper subject for a trade-mark registration, although it appears that such name, by long association with certain line of goods, has come to be applied as a name or title to such goods.
4. HELD, that the prohibition of the statute was intended to prevent any person from using his name in any trade as a trade-mark, to the exclusion of other persons of the same name in the same or other avenues of trade.

APPEAL from the Examiner of Trade-Marks.

Messrs. Dodge & Son, for Fairchild.

MARBLE, *Commissioner*:

Appeal is taken in this case from the decision of the Examiner of Trade-Marks, who refused to register the word "Fairchild" as a trade-mark because it was "merely the name of the applicant."

Applicant alleges that the Examiner erred in refusing to register his alleged trade-mark, first, because the word "Fairchild" has been used as a trade-mark in connection with his manufacture and sale of pens and pencils for twenty years and upward, and is well-known to the commercial world as the trade-mark of the applicant; second, because said word was registered as a trade-mark in this office under the Act of July 8, 1870, which Act contained similar prohibitions to the Act of March 3, 1881.

It appears by the records and files of the office that Mr. Fairchild did register his name as a trade-mark in this office in July, 1879. The proofs at that time submitted showed that the word "Fairchild" had been used by applicant as a trade-mark long prior to the passage of the Act of June, 1870. While the Act of 1870 in terms prohibited the Commissioner of Patents from registering as a trade-mark merely the name of a person generally, it also contained the following clause, as an exception to the general provisions of the statute:

"But this section shall not prevent the registry of any lawful trade-mark rightfully in use on the 8th day of July, 1870."

Under this exception to the general provision of the statute the word "Fairchild," on the proofs presented, was registered as a trade-mark. The Act of 1870, and all acts and things done under it, have been swept away by the decision of the Supreme Court declaring the law unconstitutional, and therefore void.

The application as now presented therefore comes before this office the same as if no application had ever been made for the registration of the word "Fairchild," excepting that, having registered it under the Act of 1870 and paid the fees then required by law to be paid for the registration of trade-marks, the applicant is now entitled to re-register without payment of additional fees, providing he has a legal trade-mark.

The Act of March 3, 1881, provides:—

“That owners of trade-marks used in commerce with foreign nations or with the Indian tribes, provided such owners shall be domiciled in the United States or located in any foreign country or tribe which, by treaty, convention, or law, affords similar privileges to citizens of the United States, may obtain registration of such trade-marks by complying with the following requirements.”

Then follow the necessary steps to be taken in order to secure registration.

By the third section it is provided that:—

“But no alleged trade-mark shall be registered unless the same appear to be lawfully used as such by the applicant in foreign commerce or commerce with the Indian tribes, as above mentioned, or is within the provision of a treaty, convention, or declaration with a foreign power, *nor which is merely the name of the applicant.*”

1. There is no saving clause in the Act excepting from its prohibitions any particular class of cases, as there was in the Act of 1870. The Act does not define what shall constitute a legal trade-mark, but it does declare what shall not be registered as such. Among the prohibitions is “merely the name of the applicant.” It is argued that the word “Fairchild,” by reason of its long use on the goods of the applicant to distinguish them from others of like character, is not now applicant’s name merely, but the name of a particular kind of goods. It is undoubtedly true that the goods manufactured by applicant, and upon which his name is stamped, are known as the “Fairchild” pens or pencils, as the case may be. The name as presented for registration, however, is not the name of a pen or pencil, but merely the name of the applicant, unconnected with any sign, mark, or illustration of any kind whatever.

2. “Merely the name of the applicant” means, as I understand it, the name of the applicant separate and alone. The name of one person may be better known in the commercial world than another by reason of its use and identity with a certain line of business, trade, or class of goods, but that fact does not make it registrable as a trade-mark. It is, after all, the name

of the person merely, and not the name of the business, trade, or kind of goods.

3. While it may be true that the name of the applicant in his trade is of great value, it cannot receive registration in this office as such in violation of the prohibition of the statute.

4. The prohibition of the statute was intended to prevent any person from using his name in any trade as a trade-mark to the exclusion of other persons of the same name in the same or any other avenue of trade. This intention of Congress would not be carried out if registration was permitted of the name of any person as a trade-mark, however long it may have been used.

The decision of the Examiner of Trade-Marks is affirmed.

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SUPREME COURT, STATE OF NEW YORK.
SPECIAL TERM. IN EQUITY.

LOUIS FLEISCHMANN*vs.*FREDERICK SCHUCKMANN.

DECIDED AUGUST, 1881.

REPORTED 62 HOW'S PR. R., 92.

“Vienna Model Bakery” Case.

The plaintiff, who first applied the word “Vienna” to baked bread and other articles, having been engaged in the manufacture, in the City of New York, of an article known as “Vienna Bread,” and which he has for many years past sold with a label thereon containing the words “Vienna Model Bakery,” can maintain an action restraining the use by other parties, of a label in imitation of his own, and in particular, from applying the word “Vienna” to baked articles.

ACTION for a perpetual injunction restraining the use by defendant of a trade-mark.

Fraser & Minor, for plaintiff.

C. Spiro, for defendant.

VAN VORST, J.:

This is an action brought by the plaintiff to restrain the use of his trade-mark by the defendant. The plaintiff is a manufacturer in the City of New York of an article known as "Vienna bread," and which he has for many years past sold with a label thereon containing these words: "Fleischmann, Vienna Model Bakery, Broadway and Tenth Street, New York. Patent applied for." Since the plaintiff introduced his article, and after it had gone into general use, the defendant commenced to manufacture and has continued to sell bread in loaves of a form similar to those of plaintiff, with a label thereon containing the words: "Schuckmann's Genuine Vienna Bakery, 154 East Fifty-fourth Street, New York."

It is the use of this label by defendant which the plaintiff seeks to enjoin. The rights of the parties respectively will be best disposed of by a consideration, first, of the facts as they are disclosed by the evidence, and when they are ascertained, there will be but little difficulty in applying the principles, legal and equitable, which the facts call for.

At the Centennial Exhibition, in 1876, Gaff, Fleischmann & Co., under the management of the plaintiff, first applied the word "Vienna" to baked bread and other articles. Upon the termination of that exhibition, plaintiff, who is by birth an Austrian, having purchased from the manufacturer, Fleischmann, the exclusive right to use the word "Vienna," in connection with baked articles, commenced on his own account a manufactory of bread on the corner of Broadway and Tenth Street. To bring his bread and other articles manufactured by him from flour into notice, he expended a considerable sum of money. He brought bakers from Vienna, and procured his flour from the best mills. He advertised his products and employed agents. The defendant was himself at one time an agent of the plaintiff.

In 1878, he employed a lithographer to design an appropriate label to be attached to each loaf of bread, and the label upon which the words first above given are printed was produced. This label the plaintiff has ever since used, and his bread is known in the market by the label. Bread made in Vienna is favorably

known, but it is not sold there under a distinctive name as such, nor is the form of loaf adopted by plaintiff in use there.

Plaintiff also manufactures an article called by him "American bread." Both kinds are, however, made from the same quality of flour, but the way in which the flour is turned into dough and afterward into bread differs.

The "Vienna bread" differs from other kinds manufactured by plaintiff, and purchasers know it by its external form and its label, and upon eating it they know its distinctive quality.

The plaintiff's label was intended by the lithographer, and was produced by him, as an original design. The impression on the paper is panel-shaped, corners curved inwardly, forming a part of a black line border, having continued perforations beyond the border, to indicate the edge, so as to be readily separated for use. The label is an inch and one-quarter in length, and one-half inch wide. The paper used is white, and the impression is in black ink.

The label adopted by the defendant is in size, form, color of paper and the impression thereon, with border and perforations, in all respects similar to the plaintiff's. The character or family of letters in which the printing is done is exactly like plaintiff's. The designer of the plaintiff's label testified that it was a duplicate of the one originally prepared for the plaintiff's use, and that the imitation of the plaintiff's label was exact.

The difference in the words printed on the two labels appears above.

The intention of the defendant to imitate the plaintiff's label, and the success of his effort is apparent. Purchasers desiring Vienna bread of the plaintiff's manufacture, and not careful closely to examine the words on the defendant's label, could readily be deceived, as the defendant has adopted a form of loaf similar to the plaintiff's. In purchasing articles of so common use as bread, labels are not expected to be critically examined, and persons who cannot read, as well as those who do, are obliged to buy. The deception is thus readily accomplished.

Courts of Equity have uniformly condemned the imitation of labels and other distinctive marks by which a manufacturer has

chosen to distinguish his goods, when it is done for the purpose of deceiving the public and advancing his own fortune, by one who would appropriate to himself the advantage secured through the successful enterprise and diligence of another. It is needless to cite authorities in support of a principle so consonant with reason and natural justice.

It does not at all take away from the force of this principle, which is applicable to the case now under consideration, that no complaint is made of the quality of the "defendant's bread." If the bread sold by the defendant was bad, it would add to the injury. But he is enabled by his imitation to sell his bread as the plaintiff's and that diminishes the plaintiff's business, and the gains to which he is justly entitled by priority in the introduction here of bread called by him Vienna bread, and in the use of a label first designed by him with appropriate marks and words to designate his article. These conclusions condemn the general practice of the defendant in so far as his label is an imitation of plaintiff's. It requires no argument to show the defendant's intention. His design is self-evident. Men are supposed to intend the consequences of their actions. It is, however, suggested by defendant's counsel that the plaintiff can have no exclusive right to the use of the word "Vienna," the name of the capital of Austria, as a trade-mark. That suggestion, under the facts of the case, I cannot adopt.

1. The plaintiff and his assignor were the first to use it here or elsewhere to distinguish a manufacture of bread. As a mark for bread it is purely arbitrary, and it is in no manner descriptive, either of the ingredients or quality of the article.

The plaintiff, an Austrian, from Vienna, residing and manufacturing bread in this country, has clearly a right to call it, by way of distinction, "Vienna bread." By the use of the word "Vienna" in that connection, no deception is practiced, because the place of its manufacture is given, and it is known that bread cannot be imported from abroad for use here. The plaintiff has the same right to do that as the makers of shirt collars had to call their article "Bismarck collars." (*Messerole v. Tynburg*, 4 Abb., [N. S.], 410). I presume that a baker in Paris or Vienna

could manufacture bread there and introduce it under the name of "New York bread," and use it arbitrarily, and be protected under the laws of their country, if he was first to apply "New York" in such connection.

I do not think it important to refer in detail to the cases cited by the counsel on the bearing of the case.

That the plaintiff is entitled to protection in the use of his label, and to the exclusive use of the word "Vienna" in connection with the manufacture and sale of baked articles, appears to me so clear that a denial thereof would be contrary to justice. (*McAndrew v. Bassett*, 10 *Jurist*, [*N. S.*], 550; *Newman v. Alvord*, 51 *N. Y.*, 189).

It is objected that the plaintiff's label contains a misstatement with respect to a patent being "applied for." I find no evidence of any untruthfulness in this regard. He did apply for a patent, but was unsuccessful, the word "Vienna" having already been secured by letters to his predecessor. Some of the old labels were used afterwards, but in the later labels, these words have been dropped.

There should be judgment for the plaintiff restraining the defendant from using his label in imitation of the plaintiff's, and in particular from applying the word "Vienna" to baked articles.

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SUPREME COURT, STATE OF NEW YORK.
IN EQUITY.

AMERICAN GROCER PUBLISHING CO., APPELLANTS,*vs.*THE GROCER PUBLISHING COMPANY.

DECIDED OCTOBER, 1881.

REPORTED 25 HUN, N. Y., 398.

“*American Grocer*” Case.RESPONDENTS—TRADE-MARK—PROPRIETARY RIGHT IN
A NAME.

1. When it is unnecessary to show guilty knowledge or fraudulent intent on the part of the wrong-doer.
2. Upon the question of the intent there are perhaps strong circumstances tending to establish the fact that the original design was to encroach upon the plaintiffs' business. These circumstances are the adoption of the name of “The Grocer” for his paper, and the location of its offices in the immediate vicinity of those occupied by the plaintiffs, and it must be assumed from the position he occupied, that he had abundant intelligence to understand that some trouble might arise in the receipt of the correspondence of the plaintiffs' paper, which as he knew very often came addressed simply to The Grocer.

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3. It is not necessary, under the rules of law as they now prevail in this State in regard to trade-marks, to determine whether there was an intent to do wrong or not; it is sufficient that the proprietary right of the complainant and its actual infringement is shown.
4. The authorities with the enlarged doctrine as announced by the Court of Appeals, leave no doubt of the right of the plaintiffs to the interposition of this Court to protect it from the publication of the Grocer, or the American Grocer, the plaintiffs' publication being well known by either or both of these names.

The plaintiff has for many years published in the City of New York, a paper called American Grocer. In 1875, one Price, who had theretofore edited the plaintiffs' paper, left it and started for the defendant a new paper called The Grocer. Both papers were issued in pamphlet form, were of about the same superficial size, and were addressed to similar objects. The plaintiffs' paper had previous to 1875, been known as and called The Grocer, Price himself having so called it in his editorials, and a large portion of its correspondence being so addressed. The defendant located its office in the same block and on the same side of the street as that in which the plaintiff had its office, and the plaintiff having subsequently removed to another place, the defendant did likewise. Price, on leaving the plaintiff, announced his withdrawal to its subscribers and his intention of starting a new paper.

HELD:

That even if the evidence failed to show an intention on the part of Price to encroach upon the plaintiff's business, yet the plaintiff was entitled to an injunction restraining the defendant from the publication of any paper called The Grocer or the American Grocer, as it had acquired a proprietary right in that name.

In such a case neither guilty knowledge nor fraudulent intent on the part of the wrong-doer need be shown.

APPEAL from a judgment entered upon a trial at Special Term, dismissing the complaint upon the merits.

The action was brought to restrain the defendants from using the word "Grocer," either separately or in conjunction with any other word, as a name for a trade newspaper published by them.

The plaintiffs are a corporation and for many years prior to the publication of the first number of the defendant's paper published a paper in the City of New York called the American Grocer, which was known as and commonly called the Grocer. Mr. W.

H. C. Price was its editor until 1875, when he ceased to act in that capacity and began the initiation of a new paper, the first number of which was issued on the 11th of December, 1875, and which was called "The Grocer." Both papers were in pamphlet form and of about the same superficial size, and were addressed to similar objects. It appears, in addition to this, that prior to December, 1875, the American Grocer was known as and called "The Grocer," and was so designated by its subscribers. Mr. Price, during his editorship, himself frequently so called it in his editorials, and a large portion of its correspondence was so addressed. The circulation of the plaintiff's paper is by mail chiefly over the United States and Canada. The defendant's paper was started on the same block in this city, and on the same side of the street as the plaintiff's; that is to say, the defendants selected as the location of their office the same block and side of the street as that adopted by the plaintiffs. It further appears that the plaintiffs having removed their office of publication to West Broadway, between Reade and Duane streets, the defendants did likewise.

"The Grocer," as appears also from the testimony in the case, was started at the price of two dollars per annum for the avowed reason that the sum charged for the plaintiff's paper, three dollars, was too high. This is apparent, because in his prospectus Mr. Price said: "I shall put the subscription price at the very moderate rate of two dollars a year, having for some time been convinced that the price of the American Grocer was too high." It was further proved on the trial that no correspondence addressed to "The Grocer" came after that time to the plaintiff, and, further, that there was no other paper published in the City of New York with a name that would lead to its being called "The Grocer."

Mr. Price testified upon the trial that the only reason the name Grocer was selected was because no other title could be thought of, that would indicate the purpose and character of the paper. But he admitted that he had heard of the Grocer's Price Current, and also the Grocer and Produce Review, neither of which was ever called the Grocer. And in reference to the location of its office of publication on the same block in Chambers Street as the plaintiff, he said that it was at a time of the year when it was very

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difficult to make a choice; that they had found a vacant lot at No. 163 that would suit their purpose, and that they had moved to West Broadway because it was thought to be one of the best places in the city to have an office, and, further, that they had had their eyes on that location for some time.

It appears, also, that when Mr. Price ceased to be the editor of the plaintiff's paper he addressed numerous of its subscribers, announcing his withdrawal from that publication and expressing his intention to establish a newspaper. And it also appears by the evidence offered on behalf of the defendant that several dealers in the city knew of both papers, and likewise the difference between them. But there is some evidence in the case given on behalf of the plaintiff, showing that some confusion exists in consequence of the similarity of the names of the papers, a part of the plaintiff's patrons having mistaken the defendant's paper for that of the former.

E. More, for the appellant,

Hugh Porter, for the respondent.

BRADY, J.:

The learned Justice who presided at the Special Term disposed of this case in a very brief opinion, declaring that the views enunciated by Justice Lawrence upon the decision of the motion for an injunction seemed to him to cover the case as then presented. And the latter Justice was evidently influenced by the fact that the whole equity of the complaint was denied and that the papers, after a careful inspection, did not present such a resemblance as would justify him, on such a motion as that which he was considering, in determining that the defendant's paper was intended to be passed off upon the public or that it would be likely to be purchased by the customers as and for the plaintiff's paper. He thought the case presented to him was within the rule laid down in *Snowden v. Noah*, (*Hopkins' Ch. R.*, 347), which is reviewed and commented upon.

The respondent relies upon the case, which was referred to by Justice Lawrence, and also upon the case of *Bell v. Locke*, (8 Paige,

75), in which the Chancellor refused to enjoin the publication of the defendant's paper; but that decision would seem to rest upon the ground that he did not regard the defendant's paper as such a simulation of the plaintiff's publication as to injure the circulation of the latter by deceiving the public and inducing the belief that it was in reality the same paper. This doctrine of resemblances seems to have been the controlling element in the consideration of both of those cases, and sustains the conclusion in regard to them which was adopted by Justice Lawrence in his consideration of the question involved.

1. Upon the question of the intent of Mr. Price there are, perhaps, strong circumstances tending to establish the fact that the original design was to encroach upon the plaintiff's business. These circumstances are the adoption of the name of "The Grocer" for his paper and the location of its offices in the immediate vicinity of those occupied by the plaintiff. It is quite apparent that many designations other than that of "The Grocer" simply, might have been employed for his paper, the adoption of which would not have resulted in any confusion. He knew that the plaintiff's paper was frequently designated "The Grocer" merely, and that he so called it himself whilst he was its editor; and it must be assumed from the position that he occupied that he had abundant intelligence to understand that some trouble might arise in the receipt of the correspondence of the plaintiff's paper, which as he knew very often came addressed simply to "The Grocer;" and being so directed after the establishment of the new paper by him, it would go to the office of the latter paper, unless it was specifically addressed to the premises occupied by the plaintiff. This conduct may be entirely compatible with fair rivalry in journalism, but it must be admitted that it does not create that impression.

The plaintiff's paper had been well established, doubtless through the effective management of Mr. Price, and its reputation would therefore ensure its patronage, and it was entitled to protection from him as a citizen, unwilling to be engaged in any effort to destroy its value or interfere with its advantages.

2. But it is not necessary under the rules of law, as they now prevail in this State, in regard to trade-marks, to determine

whether there was an intent to do wrong or not. The recent determinations of the Court of Appeals seem to place the right to protection upon the infringement of the proprietary right acquired by the use of a symbol or figure, or letter, or other form of device or name. It was distinctly said, for instance, in *Coleman v. Crump*, (70 N. Y., 578), "neither is it necessary to establish guilty knowledge or fraudulent intent on the part of the wrongdoer. It is sufficient that the proprietary right of the party and its actual infringement is shown."

And in the more recent case of *Hier v. Abrahams*, (82 N. Y., 504), the Court said: "But where the trade-mark consists of a word, it may be used by the manufacturer who has appropriated it in any style of print, or on any form of label, and its use by another in any form is unlawful, * * * and this accords with the authorities. The goods became known by the name or word by which they have been designated, and not merely by the manner or fashion in which the word is written or printed, or the accessories surrounding it, and the unlawful use of the name or word in any form may be restrained."

And the doctrine is declared in that case also, that an actual intent to defraud can hardly be deemed necessary to entitle the plaintiffs to restrain the defendants from continuing the unlawful use of a trade-mark, whereby the plaintiffs are sustaining damage; and it is said that the violation of such a right is, in legal contemplation, a fraud. If in this case, for example, it can be shown that any confusion is occasioned by the use of the name by the defendants in their business, it is a damage. It would involve investigation, and it would, no doubt, lead to labor or create an element which would not necessarily enter into the business of the plaintiff and require consideration if the defendant's paper were not published.

The case of *Howard v. Henriques*, (3 Sandford, 725), sustains the proposition that the use by the defendants of an imitation of the name of the plaintiff's paper should be restrained. In that case it appears that the plaintiff's hotel was called the "Irving House," but it soon became generally known as the "Irving House" and "Irving Hotel" indiscriminately. The defendants named their house the "Irving Hotel." There was no question

of resemblance between the two hotels or the two signs. It was the name that was protected, not the name which plaintiff took, but one of the names by which his hotel was known.

In *Clement v. Maddick*, (5 *Jur.*, [*N. S.*], 592), the proprietor of Bell's Life in London and Sporting Chronicle obtained an injunction restraining the proprietors of The Penny Bell's Life and Sporting News from using any title which included Bell's Life, by which name the complainant's paper was known familiarly.

In *Ingram v. Stiff*, (5 *Jur.*, [*N. S.*], 947), the London Journal, a weekly paper, restrained the defendant from publishing a daily London Journal. And Mr. Brown in his treatise upon trade-marks, sections 415 to 418, presents a very interesting synopsis of some French cases.

In one of the plaintiff's journals, the *Moniteur Universal* had become known as the *Moniteur*. The defendant's paper adopted the title *Moniteur Official of the French Empire*. It was held that the title of a journal is property, and the use of the word *Moniteur*, either singly or with the qualification *Official* was enjoined, for the reason that it incontestibly appeared that the *Moniteur Universal*, whether as a daily, political or literary sheet, or as an historical collection, had always been known by the simple title *Moniteur*. In another case in which the publication was *The Press*; the *Free Press* was enjoined, although the papers belonged to different parties and addressed themselves to different classes of readers.

In another, the defendants having adopted the title *Petit Journal*, which was the title of the paper published by the plaintiffs, added the words *de la Somme*, which were printed in smaller characters. The judgment declares that the title of a journal is the exclusive property of its founder, and to give to a new journal the title already belonging to another would be usurpation of property, and consequently an act of unlawful competition. An injunction was therefore granted forbidding the further use by the defendants of the words *Petit Journal*.

The French cases are in harmony with the decision made in *Howard v. Henriques*, (*supra*).

In the *Dixon Crucible Company v. Guggenheim*, (2 *Brew.*, 321), it was said: "The name of a newspaper is a trade-mark, as much

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so as a label stamped upon a bale of muslin. Can it be supposed that if some one were to commence the publication in this city of a 'Public Ledger' of the same size, price and style as the one published by George W. Childs, that a Court of Equity would not promptly arrest the career of such a piratical craft by an injunction!" And in *Stevens v. De Conto*, (7 Robt., 343), Judge Monnell said: "And I have no doubt that the name so long appropriated and used of the New York Herald, or the Sun, would be protected as trade-marks."

3. The authorities, with the enlarged doctrine as announced by the Court of Appeals in the cases to which reference have been made, have no doubt of the right of the plaintiffs to the interposition of this Court to protect it from the publication of any paper called the Grocer, or the American Grocer, the plaintiff's publication being well known by either or both of these names.

And the result of this review must therefore be to reverse the judgment of the Special Term, and to order a new trial, with costs to abide the event.

Judgment reversed, and new trial ordered, with costs to abide the event.

DAVIS, P. J., and DANIELS, J., concurred.

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IN THE UNITED STATES PATENT OFFICE.

EX PARTE FRIEBERG & WORKHAM.

DECIDED 5 OCTOBER, 1881.

REPORTED 20 O. G., 1164.

“A. J. Bowen” Case.

TRADE-MARK.

1. A trade-mark is an arbitrary character or characters without special meaning, adopted by persons, firms or corporations, for the purpose of identifying the goods manufactured by them or of which they have the sale. Persons have the right to adopt any device or form of words possessing these characteristics as their trade-marks, so long as public property is not violated.
2. The long use of the name of a particular person with a particular class of goods manufactured by that person, or in his name, serves to identify those goods as particularly as any other characters, device or collection of words.
3. The name of a person in connection with other marks, may form proper subject matter for trade-mark registration by the business successors of such person.

APPEAL from the Examiner of Trade-Marks.

Trade-Mark.—Application filed August 22, 1881.

Messrs. Abraham & Mayer, attorneys for the applicants.

MARBLE, *Commissioner*:

Appeal is taken from the decision of the Examiner of Trade-Marks in refusing to register as a trade-mark subject-matter described as follows:

The words "J. A. Bowen" and the arbitrary symbols of a shield on which is emblazoned the arms of the United States. These have generally been arranged as shown in the accompanying *fac simile*, the words "J. A. Bowen," in a curved line, forming the upper part of a circle and the word "Bourbon," in an inverted curved line, forming the lower part of a circle. Between these words is the representation of a fancy shield upon which appears the Stars and Stripes, that form the conventional armorial bearings of the United States of America; but the word "Bourbon" may be omitted without materially altering the character of our trade-mark, the essential features of which are the words "J. A. Bowen" in connection with the shield having emblazoned thereon the Stars and Stripes, that form the conventional armorial bearings of the United States of America, the whole surrounded by a plain circular border.

It is stated in the application that this alleged trade-mark has been continuously used in the business of the applicants as a trade-mark on whiskey since the year 1857. The application was rejected by the Examiner because applicants refused to erase therefrom the words "J. A. Bowen," the attorneys of applicants having admitted that he was the person whom the applicants succeeded in business. The Examiner's objection to the registration of said trade-mark is stated as follows:

Their use of this name is evidently intended to inform the public of the fact that they are the successors in business of J. A. Bowen, and are now engaged in the distillation of liquors formerly sold under his name. It would seem to the Examiner that this is simply a transfer of a "good-will" and nothing more.

1. A trade-mark is an arbitrary character or characters without special meaning, adopted by persons, firms, or corporations for the purpose of identifying the goods manufactured by them or of

which they have the sale. Persons have the right to adopt any device or form of words possessing these characteristics as their trade-marks so long as public propriety is not violated. It may be true in this case, as it is in many cases, that the name of a person associated with a particular trade or business carries with it the good-will of the establishment with which he was connected. If it is the good-will simply that is sought, then it should not be registered as a trade-mark; but if the name of a person possessing the characteristics of a trade-mark in itself, not an applicant, is adopted by any person, firm, or corporation to identify their particular goods, I see no good reason why it may not be used as a trade-mark and be registered as such. On the contrary, there are many reasons why it may be so used.

2. The long use of the name of a particular person with a particular class of goods manufactured by that person, or in his name, serves to identify those goods as particularly as any other character, device, or collection of words. This is all that is required to make it a legal trade-mark. Whether persons other than the person whose name is used have the right to use such name is another question. In this case it is claimed that the applicants have used this name with the device mentioned as their trade-mark upon their goods since the year 1857.

3. This is sufficient *prima facie* evidence of their legal right to use it.

The decision of the Examiner is overruled, and the certificate of registration will issue in due course.

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SUPREME COURT, STATE OF NEW YORK,
IN EQUITY.

NATHANIEL SMITH, APPELLANT,

vs.

BENJAMIN SIXBURY, RESPONDENT.

DECIDED OCTOBER, 1881.

REPORTED 25 HUN, N. Y., 232.

“Magnetic Balm” Case.

TRADE-MARK—WHAT WORDS MAY BE USED AS.

1. Any words selected arbitrarily, not expressive of the quality or character of the article, and not previously appropriated by any other person to designate a similar commodity, may be used as a trade-mark for such article.
2. The plaintiff had been engaged during the last twenty-five or thirty years, in compounding, manufacturing and selling a liquid medicine which he called “Barker & Smith’s Magnetic Balm.” Prior to that time, one Barker, a physician, had been engaged in manufacturing and selling a medicine which he called “Magnetic Balm.” The plaintiff had purchased from him his interest in and the recipe for the said medicine. The medicine contained no magnetism or electricity. **Held:**

That the plaintiff was entitled to be protected in the use of the words "Magnetic Balm," as against any person subsequently attempting to use the same.

APPEAL from a judgment, entered upon the report of a referee, dismissing the complaint, with costs.

Butterfield & Phillips, for the appellant.

Lansing & Rogers, for the respondent.

SMITH, J.:

The plaintiff has been engaged during the last twenty-five or thirty years in compounding and manufacturing at the City of Syracuse and selling in certain counties in the northern part of this State, and in other parts of the United States, a liquid medicine which he has designated by the name of Barker & Smith's Magnetic Balm. One William Barker, a practicing physician, was engaged some thirty years ago in manufacturing and selling at Syracuse a medicine which he called "Magnetic Balm," and his recipe and interest in the medicine were purchased by the plaintiff. The plaintiff claims to have adopted the words "Magnetic Balm" as a trade-mark to be placed on the glass bottles in which the medicine manufactured by him is usually put up for sale. He has also been accustomed for several years to inclose each bottle of medicine in a paper wrapper on which is printed a label headed with the words "Barker & Smith's Magnetic Balm," containing a description of the properties of the medicine and directions for its use, and having on the side inclosed in brackets the words "Trade-mark, Magnetic Balm." The plaintiff alleges that the defendant, who is engaged in manufacturing and selling a like medicine at the City of Watertown, has wrongfully used the plaintiff's said alleged trade-mark and imitated his label, and is still doing the same. This action is brought to restrain the defendant from using said trade-mark and imitating said label, and to recover damages.

The referee found substantially among other things, the facts above stated; but he found also, as matter of law, that the words

"Magnetic Balm," as used by the plaintiff, do not constitute a trade-mark, and on that ground, as is to be inferred from his report, he ordered the complaint to be dismissed.

In this we think the referee erred. He had found, as a fact, that the medicine compounded by the plaintiff contained no magnetism or electricity. That being the case, the word "magnetic," as applied to the compound, was an arbitrary word not descriptive of the article, and one which the plaintiff could lawfully appropriate as a trade-mark. The view which the referee probably took of the matter suggested by the finding of fact contained in his report, that "the word magnetic, when not used in its strict scientific signification, denotes something wonderful, quick, or attractive."

2. We are at loss to discover upon what evidence that finding is based. There is none warranting it in the printed case, which purports to contain all the evidence. And we know of no authority in lexicography for holding that the word "magnetic," as applied to a liquid compound, such as the plaintiff's medicine is shown to be, has any such meaning as is given to it by the referee, or is descriptive of any quality of such compound.

1. The rule is, that any word; selected arbitrarily, not expressive of the quality or character of the article, and not previously appropriated by any other person to designate a similar commodity, may be used as a trade-mark for such article. (*Gillott v. Esterbrook*, 48 N. Y., 374; *Newman v. Alword*, 51 Id., 189; *Hier v. Abrahams*, 82 N. Y., 519.)

There is no evidence that any other person had adopted the words "Magnetic Balm" to designate a similar article before they were used by the plaintiff and his assignor, Barker.

There are several other questions in the case upon which it is unnecessary to comment.

For the error above pointed out the judgment should be reversed, and a new trial ordered before another referee, costs to abide the event.

Ordered accordingly.

TALCOTT, P. J., and HARDIN, J., concurred.

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SUPREME COURT OF GEORGIA. IN EQUITY.

LARRABEE & CO.*vs.*LEWIS.

DECIDED 18 NOVEMBER, 1881.

REPORTED 67 GA., 562.

“*Snowflake*” Case.

1. A trade-mark, to be protected from infringement, must designate the origin or ownership of the article to which it is applied. A mere general description by words in common use of a kind of article, or its nature and qualities, cannot of itself become a trade-mark.
 - (a). “*Snowflake*,” as applied to bread or crackers, is a mere description of whiteness, lightness and purity.
 - (b). An arbitrary word, not descriptive of the character or quality of the article to be sold, may be used to designate particular goods, and become a trade-mark.
2. In Georgia, to have a word or words claimed as a trade-mark, protected by injunction from use by another, it should appear the defendant’s use of them was with intent to deceive or mislead the public.

Trade-Mark.—Before Judge HILLYER, Fulton County, at Chambers.

Lanier & Anderson, Harrison & Peebles, for plaintiffs in error.
Mynatt & Howell, for defendant.

CRAWFORD, *Justice*.

Larrabee & Company, manufacturers of crackers and biscuits, and using the word "Snowflake" as their trade-mark, filed a bill to enjoin T. S. Lewis from the use of the same in his business, upon the ground that the said complainants had been engaged for more than two years in their said manufacture, and had used, and still claimed the right to use exclusively, their said trade-mark as against all other persons whomsoever. And yet, notwithstanding their said right, the said defendant being also a manufacturer of crackers and biscuits, has unlawfully, and without their consent, used in the sale thereof their said trade-mark of "Snowflake."

To this bill the defendant filed a demurrer upon the grounds:

(1st.) That the complainant had no right to appropriate the word "Snowflake" as a trade-mark.

(2nd.) That it was not alleged that the defendant had used the word "Snowflake" "with intent to deceive or mislead the public."

This demurrer was sustained by the Chancellor, and that judgment is complained of as error.

1st. The first question made is whether the word "Snowflake" can be used and appropriated as a trade-mark.

1. A trade-mark is defined to be the name, symbol, figure, letter, form, device used by a manufacturer or merchant to designate the goods he manufactures or sells, to distinguish them from those manufactured or sold by another, to the end that they may be known in the market as his, and to secure such profits as result from a reputation for superior skill, industry or enterprise. *Upton's Law of Trade-Marks*, 99. The trade-mark must designate and distinguish the owner's production from the general manufacture of the same article, and cannot consist of a word belonging to the general public describing truly a known product. 53 *How*, (*N. Y.*) *Pr.*, 453; *S. C.*, 6 *Am. L. T.*, 20.

A mere general description by words in common use of a kind of article, or its nature and qualities, cannot of itself be the subject of a trade-mark. 122 *Mass.*, 139, 148.

1. A trade-mark which designates the true origin or ownership of the article manufactured or sold, will be protected, but words which have no other relation to the origin or ownership of the goods than merely to indicate the name or quality, will not be protected. Nor will words be protected which all persons may use with equal truth as to the nature of a fact which they are used to signify, because all alike have the right to employ them for the same purpose. And so, too, a name merely descriptive of an article of trade, of its qualities, ingredients or characteristics, cannot be employed as a trade-mark, and the exclusive use of it entitled to legal protection. 2 *Sand.*, (*N. Y.*), 599; 7 *N. Y. Leg. Obs.*, 301; 7 *Phil. (Penn.)*, 253; 35 *Conn.*, 402; 13 *Wall.*, 311; 1 *Holmes*, 185; *S. C.*, 6 *Am. L. T.*, 20; 58 *N. Y. (Sick.)*, 223.

That one may use an arbitrary word, when not descriptive of the character or quality of the article to be sold, seems to be settled by the rulings of a various Courts; noted instances of which are "Pride" as the trade-mark for cigars, "Charter Oak," for stoves, "Lone Jack" for tobacco. These words not being in anywise descriptive of the character or quality of cigars, stoves or tobacco, they have been protected. (82 *N. Y. Sick.*, 522; 44 *Mo.*, 168; *Cox's Manual of Trade-Mark Cases*, No. 669).

1. (a). With these rules of law governing the question made by this record, can the word "Snowflake" be classed as one not descriptive of the character or quality of the articles under which they are to be sold? In its common and ordinary sense it is understood to be descriptive of whiteness, lightness and purity, words which of necessity belong to the public—common alike to all. When applied, therefore, to crackers and biscuits, it affirms unquestionably that they are white, light and pure. Whether used to describe the quality or style of this sort of merchandise or not, it does signify those facts which others by its use may express with equal truth, and therefore have an equal right to its use for that purpose. *The Collins Co. v. Cowen*, 3 *Kay & Johnson*, 428.

It is to be remembered that this word has no device or symbol whatsoever in connection with it:—"Larrabee's Snowflake Biscuit," the defendant's label being "Lewis's Snowflake Biscuit." If we are right therefore, in our construction of the ordinary use

and meaning of the word, then any one may make a label, and sell "Snowflake" biscuit, that is, such as are white, light and pure.

2. 2d. The second ground of the demurrer was that there was no allegation in the bill that the defendant had used the word snowflake "with the intent to deceive or mislead the public."

Without reference to what may have been ruled in other States on this subject, our statute makes the intention to deceive and mislead the public by the use of similar trade-marks, names or devices to encroach upon the business of another, a fraud for which equity will grant relief.

When one comes, therefore, asking the relief provided, he should come according to the rule prescribed. It is insisted, however, that the complainants could not look into the mind of the defendant and discover his intent. If this were necessary, intention could never be proved. Words, acts and conduct prove intent, and are the usual and ordinary means adopted by Courts of justice to establish it, and we see no more difficulty in this than in other cases.

It was further urged on the argument that under our statute, not only trade-marks, but names are forbidden to be used as well, and this being a name, that although the plaintiffs could not bring themselves within the technical meaning of trade-mark, still they would be entitled to protection against the use of a similar name. There occurs to us no reason why, if the word used cannot be protected as a trade-mark, it should be as a name, if obnoxious to the same objections. That names can and will be protected, we have already seen, and to such names we apprehend the statute refers.

Judgment affirmed.

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CIRCUIT COURT UNITED STATES, DISTRICT
OF NEW JERSEY. IN EQUITY.

SAWYER

vs.

KELLOGG.

DECIDED 19 NOVEMBER, 1881.

REPORTED 9 FEDERAL REP., 601.

"Sawyer's Crystal Blue" Case.

1. TRADE-MARKS—ACCOUNTING.—K., who was engaged largely in the business of packing blues, on his own account and for others in the trade, put up the blues covered by the infringing trade-mark for the firm of B. & Co., who sold them, paying K. for the work and labor of packing them. K. was adjudged an infringer, an injunction issued against him, and the decree directed an accounting. On motion to strike from the decree the clauses directing an accounting, HELD:
That the complainant was entitled to an accounting to enable him to ascertain what profits were made by K. by his work and labor, and what damages resulted therefrom.
2. LACHES IN BRINGING SUIT.—In England the rule is stringent in trade-mark cases, that lack of diligence in suing, deprives complainant in equity, of the right to an injunction or an account. Our Courts are

more liberal in this respect. A long lapse of time will not deprive the owner of a trade-mark of an injunction against an infringer, but a reasonable diligence is required of a complainant in asserting his rights, if he would hold a wrong-doer to an account for profits and damages. This rule, however, applies only to those cases where there has been an acquiescence after a knowledge of the infringement is brought home to the complainant.

3. COSTS.—In trade-mark cases, the ordinary rule is that a decree for an infringement and an injunction carries costs; and this rule applies, though no demand was made before suit, that the defendant should cease to use the infringing trade-mark.

ON MOTION TO AMEND DECREE.

George Putnam Smith, for the motion.

Rowland Cox, *contra*.

NIXON, D., J..

This is a motion to strike from the decree entered in the above case the clauses which direct an accounting and the payment of costs.

1. *As to the accounting.* The counsel for the defendant rests his application to strike out on two grounds: *First*, because the proofs show that the defendant is not the person liable to account to the complainant. The evidence is that the defendant was largely engaged in packing blues on his own account and for others in the trade; that all the blues covered by the infringing trade-mark were put up by him for the firm of James S. Barron & Co., dealers in wooden ware, rope, and cordage in New York, who placed the same upon the market; that he made no sales to any one of the articles thus packed, but received pay from his employers solely for the work and labor of packing. The bill of complainant prays for an injunction, and for profits and damages. Having been adjudged an infringer of the trade-mark of the complainant, an injunction has been issued against him. Under the above state of facts, should he be compelled to account for profits and damages? We have no doubt about the propriety of the reference or of the liability of the defendant, if it can be shown on the accounting that profits were made by his work and labor, or

that damages resulted to the complainant therefrom. If he did not sell, the profits on the sales are not chargeable to him; but if any profits came to him for preparing the article for those who did sell, they belong to the complainant, and the object of the accounting is to ascertain that fact. And if the defendant has damaged the complainant by the unlawful use of his trade-mark, the nature and extent of the damage is a proper subject of inquiry. *Second*, because the complainant has forfeited his right to an account by laches in bringing his suit.

2. In England the rule is stringent in trade-mark cases that lack of diligence in suing deprives the complainant in equity of the right either to an injunction or an account. Our Courts are more liberal in this respect. A long lapse of time will not deprive the owner of a trade-mark of an injunction against an infringer, but a reasonable diligence is required of a complainant in asserting his rights, if he would hold a wrong-doer to an account for profits and damages. This rule, however, applies only to those cases where there has been an acquiescence after a knowledge of the infringement is brought home to the complainant. Such is not the present case. Although the defendant began the packing of bluing in the packages complained of early in the year 1878, there is no evidence that the complainant knew it until a short time before the suit was brought.

3. *As to the matter of costs.* We find nothing in this case to take it out of the ordinary rule that a decree for an infringement and an injunction carries costs. The only reason suggested by the counsel for the defendant was that no demand was made before suit that the defendant should cease to use the label. We have never understood that in such cases a demand was necessary, nor that an infringer, who stoutly contests the suit to the end, should be relieved from the payment of the costs which have been incurred in consequence of his wrong-doing and his litigation.

The motion to strike out is overruled, but, under the circumstances, without costs, on the motion, to the complainants.

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SUPREME COURT OF INDIANA. IN EQUITY.

JULIAN*vs.*THE HOOSIER DRILL COMPANY, ET AL.

DECIDED NOVEMBER, 1881.

REPORTED 78 IND., 498.

“Hoosier Drill” Case.

1. TRADE-MARK—DAMAGES—INJUNCTION.—Property in the use of a word as a trade-mark, to designate manufactured goods, such as the word “Hoosier,” to distinguish a grain drill, may be acquired by adoption and exclusive use, and when acquired, the unauthorized use by another of the mark, to designate similar goods, is a wrong which may be compensated by damages and prevented by injunction.
2. SAME.—A trade-mark used to designate goods manufactured under letters-patent, is assignable with the letters-patent, and the right to damages accrued for infringement is also assignable.
3. SAME—NON-USER—ABANDONMENT—LICENSE.—Property in a trade-mark may be abandoned and thereby lost, but a complaint for infringement, which shows non-user for a year, does not disclose an intention to abandon; and without such intention there is no abandonment by mere non-user. Such non-user might possibly imply a gratuitous

license to others to use the mark for the time being, and thereby preclude the recovery of damages for the time; but this license is revocable, and does not preclude the remedy by injunction for the future.

APPEAL from the Wayne Circuit Court.

T. J. Study, J. B. Julian, and J. F. Julian, for appellant.

Wood, Boyd, and H. C. Fox, for appellees.

MORRIS, C.:

The appellant brought this suit against The Hoosier Drill Company, to recover damages for an alleged infringement of her rights to the use of the word "Hoosier," as a trade-mark. John Ingels, as the administrator of Joseph Ingels, who refused to join with the appellant as plaintiff, was made a defendant to answer as to the interest of his intestate in the suit.

The first paragraph of the complaint states, that the appellant's assignor, Joseph Ingels, prior to the 20th day of March, 1876, invented and discovered certain new and useful inventions and improvements in grain drills, and that the same were secured to him by various letters patent, issued by and out of the United States Patent Office at divers times, the first on the 6th day of January, 1863, and the last on the 4th day of October, 1870; that on or about the 6th of January, 1863, the said Joseph Ingels commenced the manufacture and sale of said grain drills in the town of Milton, Wayne County, Indiana, and continued the manufacture and sale of said drills down to the 20th day of January, 1876, during which time he manufactured 20,000 of said drills under said letters patent; that, at the time said Ingels commenced the manufacture of said drills, he devised and adopted, as his trade-mark to be used, and which he used on said drills, to designate the grain drills which he was manufacturing and selling, the word "Hoosier" as the name of said drills, and that he affixed and inscribed the same to and upon all such drills by him manufactured and sold, and sold the same throughout this and the adjoining States of the Union, in which there was a great demand for them, as they were well-known, and the "Hoosier

Drill," so manufactured by him, was regarded as superior to any grain drill manufactured, by farmers, dealers in agricultural implements and those using the same; that neither at, nor prior to, the time said Joseph Ingels devised and adopted said word, symbol, or term "Hoosier," as his trade-mark, was the same, nor had it been, used by any other person as a trade-mark upon any grain drill or drills; that said Ingels continued to own said trade-mark and letters patent, and the right to manufacture grain drills under said letters patent, and the exclusive right to use said trade-mark on grain drills, until the 27th of February, 1877; that from the 20th of March, 1876, to the 27th day of February, 1877, the Hoosier Drill Company was engaged in the manufacture of drills similar to those invented by said Joseph Ingels, and, without license so to do, unlawfully and wrongfully used and affixed to the drills manufactured by the appellee, during said period, said trade-mark, "Hoosier," and sold them with such trade-mark inscribed thereon, and that such trade-mark, so inscribed on said drills, enhanced the value of each drill upon which it was so inscribed, in the sum of two dollars, and that altogether said Joseph was damaged \$5,000; that the said Hoosier Drill Company owed said sum to said Ingels, and that, on the 27th of February, 1877, he sold and transferred, for a valuable consideration, said claim to the appellant.

The second paragraph of the complaint is like the first, except that it alleges that Joseph Ingels devised and adopted the word "Hoosier" as a trade-mark in the year 1857, and that he was then engaged in the manufacture and sale of grain drills, and then, and continuously thereafter, until the 27th day of January, 1877; that he used on said drills by him manufactured and sold, as a trade-mark and name to designate the particular drill by him made and sold, the word "Hoosier." That on the 27th day of February, 1877, the said Ingels transferred and assigned to the appellant all of said letters patent, by an instrument in writing, duly executed by him, and also all the right to and property in said trade-mark which he then had or owned, and the exclusive right to use said trade-mark upon grain drills.

It is then averred, that, from the time the appellant purchased said letters patent and said trade-mark, she had the right to manufacture and sell grain drills with said trade-mark affixed thereto and inscribed thereon, and the exclusive right to use the same; that, ever since she became the owner of said trade-mark, the said Hoosier Drill Company has been engaged in the manufacture and sale of grain drills manufactured and sold by said Ingels, and has, during all said time, manufactured and sold 10,000 of said drills with the trade-mark of the appellant affixed thereto and inscribed thereon, unlawfully, wrongfully and without leave or license so to do; that said trade-mark, so affixed by said company to said drills, enhanced the value of each drill two dollars; that, since she became the owner of said letters patent and said trade-mark, it has been her intention to engage in and continue the manufacture and sale of grain drills under said letters patent, and to use said trade-mark thereon, as soon as she could make arrangements so to do; that said trade-mark was and is of great value in the sale of grain drills, and particularly in the sale of the drills manufactured by said Hoosier Drill Company; that said company had realized \$5,000 from the use of said trade-mark since her purchase of the same, for which she demands judgment. She also asks that the appellee be enjoined, etc.

The appellee, The Hoosier Drill Company, appeared and demurred to the complaint, on the following grounds:

1st. There is a misjoinder of causes of action in each of said paragraphs.

2nd. The plaintiff has no capacity to sue.

3rd. There is a defect of parties plaintiffs.

4th. There is a defect of parties defendants.

5th. The said paragraphs do not, either of them, state facts sufficient to constitute a cause of action against defendant.

The Court sustained the demurrer, and, the appellant declining to amend, judgment was rendered for the appellee.

The sustaining of the demurrer is assigned as error.

1. It seems to be agreed by the counsel for the parties, that the word "Hoosier" may be adopted, used and applied as a trade-mark. The case of *Congress & Empire Spring Company v. High*

Rock Congress Spring Company, 45 N. Y., 291, and other cases that might be referred to, fully justify this conclusion. *Coddington on Trade-Marks*, sec. 680, et seq.

It is not seriously questioned that Joseph Ingels used the word "Hoosier" as a trade-mark, and that, by affixing it to and inscribing it upon grain drills manufactured by him and sold in this and adjoining States, as alleged in the complaint, he adopted it as his trade-mark, so as to secure the exclusive right to it as a trade-mark, to designate the kind of grain drills by him manufactured and sold.

It seems also to be agreed, that a party may have a property in a trade-mark, and that his right to and property in it may be transferred and assigned. But the parties are not agreed as to the manner in which, nor as to the circumstances under which, such assignment may be made.

It is insisted by the appellees that, upon the facts stated in the first paragraph of the complaint, no cause of action exists in favor of the appellant.

First. Because it appears that, during the time the appellee used the trade-mark, the said Ingels, the appellant's assignor, was not engaged in manufacturing grain drills; that he had abandoned the business of manufacturing and selling drills from the 20th day of March, 1876, until and after the 27th day of February, 1877, the period, as stated in said paragraph, during which the appellee used the same, and that he thereby relinquished and abandoned the use of said trade-mark to the public, so that any one had a right to use and adopt it.

Second. Because the claim of the said Joseph Ingels to damages for the infringement of his right to said trade-mark was not assignable.

It is also insisted by the appellee that, upon the facts stated in the second paragraph of said complaint, there was no valid assignment to the appellant of said trade-mark; that, if there was a valid assignment, no damages are shown to have accrued to the appellant.

Assuming that Joseph Ingels had adequately appropriated the word "Hoosier" as a trade-mark, which, as before remarked, is

hardly questioned by the appellees, that he had, as stated in the first paragraph of the complaint, ceased from the 20th of March, 1876; until the 27th of February, 1877, to manufacture and sell the grain drills to which he had been for years accustomed to affix the words as a trade-mark, can it be fairly and legally inferred that he had, by such temporary suspension of the business, abandoned to the public his right to and property in the trade-mark? We think not. The question of abandonment is one of intention, and the burden of establishing it lies upon the party who affirms it. Unless, therefore, it clearly and affirmatively appears from the facts stated in the complaint, it must be brought forward as a defence by answer. From the facts stated in the complaint, it appears that Joseph Ingels had secured to him by letters patent, the exclusive right as the original inventor to useful and valuable improvements in grain drills, which right under such letters, had some years to run after the 27th of February, 1877. He had been, as the complaint avers, engaged for several years in the profitable manufacture and sale of his improved drill, and had at all times affixed to, and inscribed upon such drills, the word "Hoosier" as his trade-mark. In view of these facts, it cannot be inferred, from less than a year's suspension of the business by Ingels, that he intended to abandon either his business or his right to said trade-mark.

3. The suspension must be, presumptively at least; attributed to indisposition or inability, rather than to an intention to abandon valuable rights. *Browne* says that the question of abandonment is one of intention, and that "A person may temporarily lay aside his mark, and resume it without having in the meantime lost his property in the right of user. Abandonment, being in the nature of a forfeiture, must be strictly proven." It is incumbent upon those alleging the defence of abandonment, to show that the right had been relinquished to the public by clear and unmistakable evidence. *Browne on the Law of Trade-Marks*, sec. 681; *Dental Vulcanite Co. v. Wetherbee*, 3 *Fish Pat. Cas.*, 87; *American Hide, etc., Co. v. American Tool, etc., Co.*, 4 *Fish Pat. Cas.*, 284, 305.

In the latter case, Shepley, J., in instructing the jury, says: "Abandonment means a general abandonment to the public, and must be shown affirmatively and positively as affecting the interest of the party." True, this was said as to the rights of a patentee, but the principal is the same whether applied to a patent or a trade-mark.

It is also insisted that as it is not alleged in the complaint that Joseph Ingels, did not, at the time, know that the appellee was using said trade-mark, he must be presumed to have known it, and that it was his duty to object promptly to the appellee's usurpation of his rights, and that, if he did not, he must be held to have acquiesced, and thus estopped himself to complain. The facts stated in the complaint do not show acquiescence on the part of Joseph Ingels in the alleged invasion of his rights by the Hoosier Drill Company. Did it affirmatively appear in the first paragraph of the complaint, that, with knowledge of the facts, Joseph Ingels had stood by and seen the appellee use his trade-mark without objection, though it would not establish abandonment, it would be a sufficient answer to the claim for the damages set forth in the first paragraph of the complaint. But such acquiescence is not alleged in the first paragraph of the complaint. If there was acquiescence on the part of Joseph Ingels, it must be shown by answer. *Browne on the Law of Trade-Marks*, secs. 684 and 685; *Taylor v. Carpenter*, 3 Story, 458; *Taylor v. Carpenter*, 2 Woodb. & M., 1; *Amoskeag Manuf. Co. v. Spear*, 2 Sandf., 599.

We do not think it can be assumed from the facts stated in the complaint, that the alleged infringements of the rights of Joseph Ingels by the appellee resulted, at most, in but nominal damages to him. True, it must appear, in order to maintain the action to secure substantial relief, that substantial loss must have been sustained by him in consequence of the mal-appropriation of his trade-mark, but the ground of the action, the wrong, is the affixing of the trade-mark to drills which the public purchase, thereby erroneously supposing them to have been the product of Ingels. *Browne on Trade-Marks*, secs. 499, 500. It is said that no certain and fixed rule for damages can be established in cases like this. *Taylor v. Carpenter*, 11 Paige, 292. *Browne* says, sec.

503: "The criterion is indemnity, and in estimating the actual damage, the rule is to give the value of the use of the thing during the illegal user, or, in other words, the amount of profits. * * * The proper measure of damages, in case of violation of a trade-mark, is generally the profit realized upon the sale of goods to which the spurious marks were attached."

1. We think we cannot say, as matter of law, that, upon the facts stated in the first paragraph of the complaint, Ingels was not entitled to damages.

2. We also think it was competent for Ingels to sell and transfer, by assignment, his claim for damages to the appellant.

By section 783 of the Code, the cause of action set forth in said paragraph would survive. Such a claim is assignable. *Pomeroy on Remedies and Remedial Rights*, sec. 147, and cases there cited.

We conclude that the Court erred in sustaining the demurrer to the first paragraph of the complaint.

The objections to the second paragraph, urged by the appellee, are, that the facts stated do not show a valid assignment of the trade-mark to the appellant by Joseph Ingels, or that, if there was a valid assignment, she had, by non-user, abandoned her right.

2. It is alleged in the second, as well as the first paragraph of the complaint, that Joseph Ingels, by letters patent, had secured the exclusive right to manufacture and sell the grain drills to which the trade-mark in question had been affixed for years; that, under those patents, he had been engaged in manufacturing the grain drills patented from 1863, to March, 1876, using the word "Hoosier," by affixing to his drills, as his trade-mark; that on the 17th day of January, 1877, Ingels transferred and assigned all of said letters patent to the appellant, by an instrument in writing, duly executed by him, and also all the right to and property in said trade-mark, which said Ingels then had or owned, and the exclusive right to use said trade-mark upon grain drills.

This assignment and transfer carried with it to the assignee the exclusive right to manufacture and sell the grain drill specified in the letters patent, and to carry on the business of making and selling the same. It was a transfer to appellant of the *right* to

carry on the business in which Joseph Ingels had been engaged, and in connection with which he had used said trade-mark. As incident to the right thus transferred to the appellant, Joseph Ingels might, as he is averred to have done, assign to her his right to and property in said trade-mark. The assignment, and the right to make it, did not, in any way, depend upon the time at which the appellant might engage in business. Nor was it necessary to the validity of the transfer of the trade-mark, that the place of business or drills actually manufactured should be transferred. It was enough if the right to engage in the business was assigned; as incident to the assignment of this right, it was quite competent to assign the right to the trade-mark. In the case of *The Dixon Crucible Co. v. Guggenheim, 2 Brewster, 321*, it was held that the property in a trade-mark will pass by an assignment, by operation of law, to any one who takes, at the same time, the right to manufacture or sell the particular merchandise to which the trade-mark has attached. *Edleston v. Vick, 23 Eng. L. & Eq., 51*, is not unlike this case, and fully sustains the assignment. *Marsh v. Billings, 7 Cush., 322; Croft v. Day, 7 Beavan, 84; Coddington, Trade-Marks, sec. 122.*

It appears from the complaint that the appellant purchased the right in question in February, 1877, and that this suit was commenced in February, 1880. It is alleged in the complaint that she had always intended to engage in the business as soon as she could, and that she still intends to do so.

Did she only seek to recover damages, it may be that the delay would preclude her, but she asks in this paragraph, that the appellee shall be enjoined from further use of the trade-mark. We think the delay, under the circumstances, will not preclude her from this relief. She did not intend to abandon, and therefore has not abandoned, her right, as to the future, to the exclusive use of her property in the trade-mark.

2. Inability may prevent the use of the mark, but it will not confer upon others the right to use it, or constitute an abandonment. *Browne, Trade-Marks, secs. 684, 685, and cases there cited.*

In the case of *Amoskeag Manf. Co. v. Spear, supra*, Judge Duer says: "The consent of a manufacturer to the use or imitation of his trade-mark by another may, perhaps, be justly inferred from his knowledge and silence; but such a consent, whether expressed or implied, when purely gratuitous, may certainly be withdrawn, and when implied, it lasts no longer than the silence from which it springs; it is in reality no more than a revocable license."

We think the demurrer to the second paragraph should have been overruled.

It may be proper to add, that the first, second, third and fourth grounds of demurrer are not discussed by counsel, and, as we think, they could not be sustained, they have not been particularly considered.

PER CURIAM.—It is therefore ordered, upon the foregoing opinion, that the judgment below be in all things reversed, at the costs of the appellee.

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IN THE UNITED STATES PATENT OFFICE.

EX PARTE ADRIANCE, PLATT & CO.

DECIDED 29 NOVEMBER, 1881.

REPORTED 20 OFF. GAZ., 1820.

“Adriance, Platt & Co.” Case.

1. TRADE-MARK—NAME OF APPLICANT.—It is the opinion of the ablest jurists, that a person's name cannot be an essential element of his trade-mark, and such is the settled practice of the Patent Office.
2. SAME—SAME—ESSENTIAL AND NON-ESSENTIAL.—It is deducible both from the Act of 1870, and from the present law, that others may use with impunity the name of the registrant, either by itself or in connection with other arbitrary symbols than those secured by the registration, but that the symbol itself cannot be used by others in any connection. This distinction may be expressed by the words “material” and “immaterial,” or “essential” and “non-essential,” according to the phraseology preferred.
3. The name of the person, firm or corporation, does not acquire an arbitrary significance by association with an otherwise valid trade-mark, and cannot therefore be included as an essential feature of such trade-mark.

APPEAL from the Primary Examiner.

Trade-Mark.—Reaping and Mowing Machine. Application filed March 30, 1881.

Messrs. A. M. Smith & Co., for the applicants.

MARBLE, *Commissioner*:

Applicants seek to register as a trade-mark in this case the word "Adriance," which is the surname of one of the members of the firm, together with the symbolical representation of the upper half of a cog-wheel.

Appeal is taken from the action of the Primary Examiner in refusing to permit the applicants to include the proper name "Adriance" as an essential portion of the mark.

Prior to the trade-mark Act of July 8, 1870, there was some uncertainty in the decisions of the Courts as to a trader's right to the exclusive use of his name as a trade-mark upon his goods. It has been held however, as a general rule, that every one is entitled to the *bona fide* use of his own name in connection with his business. (*Burgess v. Burgess*, 17 Furr., 292; *Clark v. Clark*, 25 Bar.; 76; *Faber v. Faber*, 49 Bar., 357).

In many instances traders have been enjoined from using a rival's name to the prejudice of his trade. (*Brooklyn White Lead Company v. Masury*, 25 Bar., 416). In some instances persons have been enjoined from using their own names, under circumstances showing an intention to defraud others of the fruits of their skill and reputation. (*Dixon Crucible Company v. Guggenheim*, 2 Brewster, 321; *Croft v. Day*, 7 Beav., 84; *Sykes v. Sykes*, 3 B. & C., 541). The statute referred to, however, while leaving the question of what constitutes a lawful trade-mark precisely where it was at common law, expressly declares that for the purposes of registration in the Patent Office, it shall not consist of a mere name of a person, firm, or corporation unaccompanied by a mark sufficient to distinguish it from the same name when used by others. Under this statute no mere name was registrable as a trade-mark, with the exception of those in use, as such, prior to the passage of the Act. (*India Rubber Comb Company*, 8 O. G., 905; *Rubber Clothing Company*, 10 O. G., 1011). In the prac-

tice under this statute, the office called upon the applicant for registration to discriminate between the essential and the non-essential features of his trade-mark, basing this requirement upon the provision of the law requiring an applicant for registration of a trade-mark to file a description thereof. (*Volta Belt Company*, 8 O. G., 144). Under the law and practice as thus understood, it has been customary, I believe, to exclude applicants' names from the recital of the essential portions of the mark. Commissioner Leggett early announced that while names of persons, firms, or corporations may be used in trade-marks, provided they are accompanied by original devices to which others have not an equal right, in such case the original devices really become the trade-marks. (*Dawes v. Fanning*, 2 O. G., 27).

1. It is the opinion of the ablest jurists that a person's name cannot be an essential element of his trade-mark, and such is the settled practice of the Patent Office. (*Browne on Trade-Marks*, paragraphs 197-206).

2. The name of a corporation cannot be regarded or registered as an essential part of the mark. (*Ex parte Alcide F. Poirrier*, manuscript decision, July 24, 1879).

1. Reference is made by the appellant to the peculiar phraseology of the Act of 1870, as support for the position that when the name of a person or firm is accompanied by a mark sufficient to distinguish it from the same name when used by others, the name itself may become an essential portion of the mark. I am unable to see the force of this position. The law clearly makes a distinction between the name and the mark (trade-mark) which accompanies it, and it is therefore clearly evasive of the law to place both name and mark upon the same footing, and to regard each as equally essential. (*Ex parte Pace, Talbott & Co.*, 16 O. G., 909). The effect of the law, as it seems to me, was to announce what is clearly deducible from the decisions of the Courts, that the applicant's name is matter of description which, in the absence of proof that it has become a lawful trade-mark, others who have an equal right may use. The full text of the law would have been that no mere descriptive or general term, or mere name of the person, firm, &c., unaccompanied by a mark, shall be

registered; but while the principles relating to the use of descriptive terms generally, are well established and therefore not referred to specifically in the Act, there was supposed to be some uncertainty at common law as to the *status* of a manufacturer's name. The very emphasis of the law, therefore, in specially prohibiting such names from registration is laid hold of as an argument to avoid it. The law has clearly made that distinction between proper names which others may have equal right to use and trade-marks, which has always been recognized by the Courts as existing between descriptive matter in general and arbitrary symbols, and which in the Patent Office is expressed by the terms "essential" and "non-essential." It is deducible both from the Act of 1870 and from the present law, that others may use with impunity the name of the registrant, either by itself or in connection with other arbitrary symbols, than those secured by the registration, but that the symbol itself cannot be used by others in any connection. This distinction may be expressed by the words "material" and "immaterial," or "essential" and "non-essential," according to the phraseology preferred.

3. In the case of *Ex parte Farnum & Co.*, (18 O. G., 412), I had occasion to hold that a geographical term acquired no arbitrary significance from association with an arbitrary symbol; and in the present case I feel constrained to hold, by parity of reasoning, that the name of the person, firm, or corporation does not acquire an arbitrary signification by association with an otherwise valid trade-mark, and cannot therefore be included as an essential feature of such trade-mark. This conclusion, I think, will be found to be in harmony with the decisions of the Courts so far as they are applicable to the subject. An examination of the authorities will show that in those cases where the manufacturer's name has been associated in use with an arbitrary symbol, the Courts have uniformly refused to enjoin others who had an equal right from using the name alone, and have disregarded as immaterial, changes in alterations, or omissions of the name, where the use of the symbol has been retained; and in short, have treated the use of the symbol as the test of infringement, and the symbol itself as the vital portion of the mark. (*Ambskeag Manufactur-*

ing Company v. Spear, 2 *Sand.*, 605; *Boardman v. Meriden Print Company*, 35 *Conn.*, 402; *Walton v. Crowlet*, 3 *Blatchf.*, 440; *Millington v. Fox*, *Cox's Trade-Mark Cases*, 338; *Burnett v. Phalon*, 9 *Beav.*, 192; *Fitridge v. Merchant*, 4 *Abb. Pr.*, 158; *Davis v. Kendall*, 2 *R. I.*, 569; *Upton on Trade-Marks*; *Knott v. Morgan*, 2 *Keen*, 213).

I am unable to see any force in the point raised by counsel that the word "Adriance" is not the full name of the firm, but only of one member of the firm. This fact does not establish for the name an arbitrary character, nor confer upon the firm an exclusive right to use it as against other persons of that name.

The Examiner is affirmed.

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SUPREME COURT OF THE DISTRICT OF
COLUMBIA. IN EQUITY.

THE UNITED STATES, EX REL. THE WILCOX & GIBBS
SEWING MACHINE CO.

vs.

E. M. MARBLE.

DECIDED 30 NOVEMBER, 1881.

REPORTED 22 OFF. GAZ., 1366.

“Wilcox & Gibbs” Label Case.

1. *That which constitutes a trade-mark may be registered in the United States Patent Office as a Label—Proprietor may elect.*
2. *Supreme Court of the District of Columbia will Issue Mandamus to Register—When.*
1. The several Acts of Congress regarding the registration of prints, designed to be used as labels, do not exclude from registration a label containing matter which might be registered as a trade-mark; nor does the fact that a label bears such distinguishing marks as entitle it to registration as a trade-mark, exclude it from registration as a label, if the owner desires it to be registered as such. Whether the Commis-

sioner of Patents is to regard it as the one or other wholly depends upon the will of its proprietor.

2. The owner of a label entitled to registration under the law made application to the Commissioner of Patents for its registration. Applicant had complied with all the requirements of the law; but the examiner in charge of that department of the Patent Office rejected the application on the ground that the label was not of the class entitled to registration, whereupon applicant, instead of appealing to the Commissioner of Patents, as he might have done, petitioned this Court for a *mandamus* to compel the Commissioner to register the label. The Commissioner in his answer to the rule to show cause, recited the facts of the failure of the applicant to appeal to the Commissioner from the examiner's decision, but at the same time approved of and indorsed the reasons of the examiner for refusing to register the label.

HELD:

That a peremptory *mandamus* to register the label should issue, and so ordered.

STATEMENT OF CASE.

This was an application for *mandamus* against the Commissioner of Patents, which was ordered to be heard in the General Term in the first instance.

The petition set forth that the relator, a corporation under the laws of the State of New York, had, on or about the 3rd day of May, 1881, made application under the Act of Congress approved June 18, 1874, entitled "An act to amend the laws relating to patents, trade-marks and copyrights," to the Commissioner of Patents for the registration of a label designed to be used for hosiery or other knit goods made in accordance with certain improvements for which it had obtained letters patent of the United States, and had paid to the said Commissioner the sum of six dollars, the fee required by law in such cases, and that thereupon it became the duty of said Commissioner, under the said Act of Congress, to cause said label to be registered; yet the said Commissioner had refused to register said label or cause the same to be registered, to the great injury of relator, &c. The petition concluded with a prayer that an alternative writ of *mandamus* be issued directed to said Commissioner, commanding him to cause said

label to be registered or show cause for his refusal so to do. The writ having issued, the answer of respondent was as follows:

The respondent, E. M. Marble, Commissioner of Patents, makes return to the order of the honorable the Supreme Court of the District of Columbia, in the above entitled matter, to show cause why a writ of *mandamus* should not issue against him as prayed by the relator, as follows:

It appears by the records and files of this office that on May 3, 1881, the relator filed an application for the registration of what is alleged to be a label, paying the fee of six dollars, the amount required by law for the registration of labels; that on the 6th of the same month applicant was notified by the examiner having charge of the registration of labels, that the monogram formed of the letters W and G, forming part of the alleged label, could not be registered because it amounted to a trade-mark; that subsequently, and on the 10th of the same month, Mr. Pollok, the attorney of said corporation, having filed his power of attorney, requested to be advised on what ground the label was rejected, stating that the same was a label and not a trade-mark; and that on the 14th of the same month the said examiner again informed applicant, through its attorney, that the application could not be allowed for the reasons given in his former letter. It will thus be seen that all action taken in the office upon the application of the relator was by the examiner having charge of applications for the registration of labels.

While it is true—that the Commissioner of Patents is charged with the transaction of all business done in the Patent Office, it is also true that he cannot and does not know of the pendency of individual applications, except such as are brought to his attention on appeal or by inquiry for instruction by examiners. The first actual knowledge that the respondent had of the pendency of the application in question was the service upon him of the order to show cause why the writ of *Mandamus* should not issue compelling him to register applicant's alleged label. The practice of the office allows parties whose applications are rejected by examiners to have the decisions of the examiners rejecting such applications reviewed on appeal by the Commissioner. No appeal of this

kind was taken by applicant, although its attorney, at least, must have known and did know what the practice of the office in such cases is. It is respectfully submitted, therefore, that the application for a writ was premature, for the reason that the respondent should not be called upon to show cause why such writ should not issue until the cause or matter which the relator complains of has been brought to his personal attention. It cannot be said that applicant's petition has been denied by the Commissioner of Patents, in view of the practice of the office, until the Commissioner has some personal knowledge of his application, and while applicant has a remedy in the office for the correction of what he believes to be erroneous action, he has no ground to ask for the intervention of this Court by writ of *mandamus* to compel an officer to do what upon application to that officer might have been done.

For further answer I respectfully submit that the Commissioner of Patents must determine what is and what is not proper subject-matter for registration as a label.

The statute says: "There shall be paid for recording the title of any print or label, not a trade-mark, six dollars, which shall cover the expense of furnishing a copy of the record under the seal of the Commissioner of Patents to the party entering the same."

The Statute also prescribes that a fee of twenty-five dollars shall be paid for the registration of a trade-mark. It becomes necessary, therefore, in each and every case for the officer whose duty it is to receive and register labels and trade-marks to determine upon the receipt of such applications whether they belong to one or the other class, and upon such determination to require the payment of the fee which the law prescribes. Such has been the practice of this office since the passage of the laws providing for the registration of trade-marks and of labels.

A trade-mark is defined by Webster to be: "A distinguishing mark or device used by a manufacturer on his goods or labels, the legal right in which is recognized by law."

A label is defined to be: "First, a tassel; second, a narrow slip of silk, paper, parchment, &c., affixed to anything denoting its contents, ownership and the like, as the label of a bottle or a package; third, a ribbon or silk, a slip of paper, parchment, &c.,

attached to a diploma or legal document to hold the appended seal; fourth, any paper annexed to a will by way of addition, as a codicil."

It must be presumed that Congress in passing the laws providing for the registration of trade-marks and labels intended that certain fees should be paid for the registration of what was then known and recognized as labels and as trade-marks. It is not competent for a party to state that this or that is a label, and this or that is a trade-mark, and thus determine its character. Whether it is a label or whether it is a trade-mark must be determined by the definition which has been given and accepted every where as clearly and fully covering the meaning of those words.

The action taken by the examiner in this case was in accordance with the well-settled rulings and decisions of the office. He refused to allow applicant to register as a label subject-matter clearly and undeniably included within the definition of a trade-mark, as he would have denied the registration of any application for a trade-mark or subject-matter properly registrable as a label.

I submit that the writ should be denied for the following reasons: First, because the registration of the alleged label has never been denied by the respondent; second, because the alleged label contains subject-matter clearly registrable as a trade-mark, and therefore not registrable under the statute as a label.

E. M. MARBLE,

Commissioner of Patents.

A report of the Examiner having charge of the registration of labels, addressed to the Commissioner, giving his reasons for refusing to register the label, accompanied the foregoing answer, and was as follows:

Sir: In the matter of the application of the Willcox & Gibbs Sewing Machine Company for registration of a label, wherein, on petition of A. Pollok, Esq., a rule to show cause why registration has been refused by the office has been issued by the Supreme Court of the District of Columbia, and referred to me by yourself for report as to the examiner's action on the case, I have the honor to report:

On the 3rd of May, 1881, the above named company duly filed an application for the registration of a label for hosiery, paying the fee of six dollars required by law. On the 6th of May a letter was written to applicants (not at that time represented by attorney) in which they were informed that the monogram formed of the letters W and G, forming part of the alleged label, could not be registered for the reason that it amounted to a trade-mark.

On the 10th of May, Mr. Pollok, now appearing as attorney for the applicant, filed an argument in which he questioned the right of the office to determine that matter presented as a label could be rejected for the reason given, and advised the office that the label was not a trade-mark. The examiner's second letter merely repeated the former action, citing a decision of the Commissioner in support thereof.

The case, having been twice rejected, was now in condition for appeal to the Commissioner in person, the usual and recognized recourse in label cases when registration has been refused by the examiner, but the record shows no such step taken in that direction.

As regards the merits of the case, the examiner is guided in his practice by former decisions based upon the Act of June 18, 1874, by which the office is necessarily governed.

This Act distinctly excludes trade-marks from the protection it was designed to afford. In the case of *Simpson & Sons*, (10 O. G., 333), the Acting Commissioner sustained the examiner in his refusal to register a label in which the arbitrary word "Eddystone" was included. He says: "Applicant will be permitted to register the name of his firm, their place of business, description of the nature, quality and quantity of his parcels as a label; but he cannot be allowed to claim the arbitrary words and fanciful figures mentioned as part of the label. These should be registered as trade-mark."

In the case of *Ex parte Thaddeus Davids & Co.*, (26 O. G., 94), cited in examiner's second letter, the Commissioner held that "the presence in a label of matter registrable as a trade-mark excludes the whole from registration."

There appears never to have been any question in the office that a monogram, such as that shown in applicant's *fac simile*, constituted a registrable trade-mark.

The fact that from time immemorial monograms have been regarded as trade-marks, is set forth in *Browne on Trade-Marks*, paragraphs 15 and 262, and the Office practice has been in accordance with this doctrine.

The examiner cannot find that it has ever been disputed; but it is clearly laid down in the Commissioner's manuscript decision in the case of *Ex parte The Dr. Harter Medicine Company*, July 29, 1879. This was an appeal from the examiner's refusal to register a trade-mark in which certain descriptive matter was shown in connection with a monogram, and the Acting Commissioner said: "Applicant may amend his application and restrict the trade-mark to the monogram and shield. The balance of the label should be registered as a label."

With the doctrine and practice so clearly established, as these rulings indicate, there has never been any room for question as to the propriety of the examiner's action. If applicant deemed it erroneous it was so because the decisions on which it was based were erroneous, and this the applicant has an opportunity to show whenever he chooses to avail himself of the rehearing by the Commissioner in person, to which he is entitled.

Respectfully submitted,

F. A. SEELY,
Examiner of Trade-Marks.

M. A. Pollok, for the relator.

MR. JUSTICE JAMES delivered the opinion of the Court:

The relator claims the right to have its label registered in the Patent Office, as a label designed to be used on an article of manufacture, under the Act of June 18, 1874. In order to ascertain the intent of that Act it will be necessary to refer to the statutory provisions relating to the same matter existing at the time of its passage.

Section 4937 of the Revised Statutes provided as follows: "Any person domiciled in the United States * * * who intends to adopt and use any trade-mark for exclusive use within the United States, may obtain protection for such lawful trade-mark by complying with the following requirements: *First.* By causing to be recorded in the Patent Office a statement specifying the names of the parties * * * who desire the protection of the trade-mark; the class of merchandise, and the particular description of goods comprised in such class by which the trade-mark has been or is intended to be appropriated; a description of the trade-mark itself, with *fac similes* thereof, showing the manner in which it has been or is intended to be applied or used, and the length of time, if any, during which the trade-mark has been in use. *Second.* By making payment of a fee of twenty-five dollars," etc.

Section 4939 excluded from the class of registrable trade-marks any mark which was merely the name of a person unaccompanied by a mark sufficient to distinguish it from the same name when used by other persons.

These sections applied to trade-marks which were in the form of labels bearing distinguishing marks.

It was at the same time provided by section 4952 that—

"Any citizen of the United States, or resident therein, who shall be the author, * * * designer, or proprietor of any * * * engraving, cut, print, &c., shall, upon complying with the provisions of this chapter, have the sole liberty of printing, * * * publishing, * * * and vending the same."

Sections 4956 and 4957 contain the provisions referred to—namely, for the deposit of copies and the recording of a description of such engraving, cut, or print in the office of the Librarian of Congress. As the application of these sections did not depend upon the importance of the print, they of course included prints which were to be used merely as labels.

It is plain that these contemporaneous provisions relating to trade-marks and prints authorized any person who owned a label bearing distinguishing marks to have it recorded in the Patent Office as a trade-mark; or, if he preferred to do so, to have it registered in the office of the Librarian of Congress as a mere

print. It must bear such distinguishing marks in order to be admitted to record as a trade-mark; but the fact of bearing them did not exclude it from registry as a print.

1. The Librarian of Congress had no discretion to refuse to recognize it as a print because it could be recognized by the Commissioner of Patents as a trade-mark. Whether it should be treated as the one or the other depended wholly on the will of its proprietor. It was for him to determine whether he would adopt it as his trade-mark, and whether he would make the declarations necessary to that end. When the registering of such prints as were designed to be used as labels on manufactures was transferred from the office of the Librarian of Congress to the Patent Office, by the Act of the 18th of June, 1874, was this choice of the owner of the label as to the character which it should have and the purposes which it should serve taken away? The first section of that Act provides that no person shall maintain an action for the infringement of his copyright of any book, "print, cut, engraving, &c., unless he shall give notice thereof by inscribing upon some visible portion of such books, prints, engravings," certain words. The third section provides—

That in the construction of this Act the words "engraving," "cut," and "print," shall be applied only to pictorial illustrations or works connected with the fine arts, and no prints or labels designed to be used for any other article of manufacture shall be entered under the copyright law, but may be registered in the Patent Office. And the Commissioner of Patents is hereby charged with the supervision and control of the entry or registry of such prints or labels in conformity with the regulations provided by law as to copyright of prints, except that there shall be paid for recording the title of any print or label, not a trade-mark, six dollars, which shall cover the expense of furnishing a copy of the record, under the seal of the Commissioner of Patents, to the party entering the same.

After the passage of this Act the Commissioner of Patents was charged with two distinct duties relating to labels. If any person intending to adopt a particular label as his trade-mark desired to obtain protection for it, the Commissioner was bound,

provided it bore the necessary distinguishing marks, to cause to be recorded the statement of the owner specifying the facts prescribed by the statute. He was now required to register also labels which were not trade-marks; but was he clothed with power to control the entry of labels so far as to determine that a label which by reason of its distinguishing marks, might have been entered as a trade-mark should not be admitted to registry as "a label, not a trade-mark?" The only reference to any control to be exercised by him, is found in the clause which provides that he shall have "control of the entry or registry of such prints or labels in conformity with the regulations provided by law as to copyright prints;" but this is merely the same control which has been exercised over the registering of labels as copyright prints by the Librarian of Congress by authority of section 4948 of the Revised Statutes, and in conformity with the regulations found in sections 4956 and 4957, and such control did not, as we have already said, include authority to exclude from the registry any particular print on the ground that it should more properly be entered at the Patent Office as a trade-mark. Of course, then, when this control over the registry of the same prints now called "labels which are not trade-marks" was transferred to the Commissioner of Patents, it had only the same limited application, and did not include any discretion to determine whether a particular label should be classed as a trade-mark or as only a label. If Congress had intended to take away from the owner of a label his former right to determine what use he should make of it and how he would have it entered, that intention would have been plainly expressed. The actual intention was merely to change the place of registry. When an applicant for registry complies with all the requirements of the law and the lawful regulations, as the relator appears to have done, the function of the Commissioner is merely ministerial.

2. The peremptory writ will issue accordingly.

The CHIEF JUSTICE, and Justices WYLIE and JAMES sat in this case.

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COURT OF COMMON PLEAS, PHILADELPHIA.
IN EQUITY.

TETLOW

vs.

SAVOURNIN.

DECIDED ———, 1882.

REPORTED 15 PHIL., 170.

“Trade Secret” Case.

A defendant to a bill to enjoin the use of a trade-mark, cannot by alleging injurious qualities in the plaintiff's goods, compel him to disclose the ingredients of which they are composed.

RULE FOR AN ATTACHMENT.

Allen H. Gangewer, Esq., for the rule.*Furman Sheppard, Esq.*, contra.

THE plaintiff, manufacturer of cosmetics, filed a bill against the defendant, charging him with imitating his labels and trade-mark, and praying an injunction. The answer denied that the plaintiff had any standing to complain, and alleged that his product was

injurious. The case being before an examiner, the plaintiff was asked by his adversary of what ingredients his goods were composed, which he, under instruction of counsel, declined to disclose, whereupon this rule was taken.

Counsel for the rule claimed the right to show what substances were contained in the cosmetic made by the plaintiff, in order that the Court might judge whether it was such a preparation as ought to be protected. No one can give the information better than the man who makes it.

Counsel against the rule replied that the whole commercial value of such proprietary manufactures depends upon secrecy as to their composition, and protested against depriving a man of his property by such a proceeding as this. If these questions must be answered, every manufacturer will be at the mercy of any one who desires to extort from him an account of his processes, for an attempt to restrain an infringer would result in the disclosure of all that makes the invention valuable. The unreported case of *Brooks v. Schofield*, C. P., No. 4, Dec. T., 1877, was referred to as in favor of the objection. In 21 *How, P. R. (N. Y.)*, 100, a similar question was allowed, but only on the ground that the plaintiff, in his examination-in-chief, had opened the subject, and had thus made the question relevant on cross-examination.

Rule discharged.

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SUPREME COURT OF LOUISIANA. IN EQUITY.

LUDWIG FUNKE, JR.*vs.*

JOSEPH DREYFUS & CO.

SAME*vs.*

JACOB GOTTSCHALK.

DECIDED JANUARY, 1882.

REPORTED 34 LA. ANN. R., 80.

“*Boker's Bitter's*” Case.

1. The evidence establishes the proprietary interest of plaintiff in his trade-mark; also, the medicinal properties of his bitters, and that he is not guilty of fraud in using the word “imported” on his labels.
2. The unauthorized use by other parties of plaintiff's trade-mark, is no justification of defendant's acts of infringement; but, on the contrary, such circumstance is, under the authorities, one of aggravation.

APPEAL from the Fifth District Court for the Parish of Orleans.
ROGERS, J.

Levy & Kruttschnitt, for plaintiff and appellee.

I. The manufacturer or merchant who has produced or brought into market an article of *use or consumption* that has found favor with the public, who, by fixing to it some name, device or symbol, or his autograph or *fac simile* of autograph, which serves to distinguish it as his, shall receive the reward of his skill or enterprise, and shall not be prejudiced by infringement or imitation of his trade-mark by others. Courts will restrain the wrong-doer. *Wolfe v. Barnett*, 24 An., 97; *Insurance Oil Co. v. Scott*, 33 An., 948; 13 Wall., 322; 6 Otto, 245; 100 U. S. S. C., 617; 1 *Cooley on Torts*, 359; *Upton on Trade-Marks*, 97; *Coddington's Digest*, sec. 589, et seq.; *Browne on Trade-Marks*, sec. 207; *Cox's Manual*, 73.

II. Owners of trade-marks will not be deprived of remedy against piracy of their marks because of any alleged misrepresentations, by them, unintentionally made, especially when, in a reasonable sense, the statements are substantially true. Equitable remedy is refused only where there is a fraudulent design in a material matter. Thus, the use of the word "patent," where goods were originally patented; or the word "imported," where they were originally imported, or where the main ingredients are imported, will not vitiate a trade-mark or prevent infringement, especially where the wrong-doer himself uses the same words. *Ins. Oil Co. v. Scott*, 33 An., 948; *High on Injunctions*, 674. See also, the cases reported in *Cox's Manual of Trade-Mark Cases*, 58, 67, 81, 102, 108, 118, 152, 215, 273, 288; *Conrad v. Brewing Co.*, *St. Louis Court of Appeals*, *October Term*, 1879; *Coddington's Digest Trade-Mark Cases*, secs. 561, 565, 570, 571; *American Trade-Mark Cases*, 282, 589; 39 Conn., 450; 35 Conn., 402.

III. Long, unlawful use, by others, of the trade-mark of plaintiff, can vest no right in them or others, to such use. Knowledge and acquiescence of the owner must be *proved*. It is never presumed. 24 An., 97; *Cox's Manual Trade-Mark Cases*, Nos. 638, 642, 228; *Coddington's Digest Trade-Mark Cases*, secs. 57, 58,

62, 64; *American Trade-Mark Cases*, pp. 101, 536, and *Browne on Trade-Marks*, sec. 685.

IV. While punitive or exemplary damages are not given in trade-mark cases, enough is allowed to cover all losses caused by the wrongful acts of the defendant—loss by injury to the reputation of the article imitated, caused by sale of inferior goods; loss from depreciation in price, caused by competition; and defendant is compelled to account for all profits realized from the illicit trade. Even where no specific damages are proved, plaintiff may recover. He is entitled to all the profits made by defendant, and his remedy is not limited to the profits. *Browne on Trade-Marks*, secs. 503, 505; 4 *McLean*, 529; 7 *Cushing*, 322; *Coddington's Digest Trade-Mark Cases*, secs. 246 and 1051-2; *Cox's Manual Trade-Mark Cases*, Nos. 111, 347, 354.

V. The prescription of one year is not applicable to claim for profits against an infringer of trade-marks; the prescription is ten years. Such infringer is, by the *lex mercatoria*, a trustee—a *negotiorum gestor*.

1. By both the commercial law and civil law, he who uses the name and trade-mark of another, is an agent or a *negotiorum gestor*, and, as such, is bound to account for the profits. *Browne on Trade-Marks*, sec. 187; *Kerr on Injunction*, sec. 381; *Amer. Law Review*, N. S., June, 1880; 6 *Wait's Action*, 36; *Coddington Dig. (French Decisions)*, sec. 1052; *Cox's Manual T.-M. Cases*, No. 347; *C. C.*, 2301, 2311; *C. N.*, 1376; *Bouvier's Dict.*, "Negotiorum Gestor," and authorities there cited. For English decisions see 2 *Daniel's Chancery Practice*, sec. 1649 (note); 3 *Beavan*, 578; 34 *Beavan*, 595; 11 *Jurist*, N. S., 408; 14 *Weekly Reporter*, 166.

2. The uniform commercial law of other States is the law of Louisiana, unless positive injunctions of La. Statutes forbid. *Hennen's Digest*, 795; 2 *M.*, 304; 7 *M.*, 460; 12 *M.*, 498; 5 *La.*, 403; 2 *R. R.*, 124; 4 *An.*, 210; 6 *An.*, 781.

3. Prescription for a term less than ten years cannot be pleaded by a trustee, agent or *negotiorum gestor*. *Longue's Digest*, 571; 15 *An.*, 143; 19 *An.*, 142; 12 *An.*, 632; 17 *An.*, 246; 20 *An.*, 381; 21 *An.*, 406; 22 *An.*, 151; 27 *An.*, 132.

Chas. S. Rice, for defendants and appellants.

1. Under the pleadings, plaintiff was bound to establish his title to the alleged trade-mark; to prove the *medicinal* and *valuable*—intrinsic—qualities of his “preparation;” and to show the truthfulness of the representations in his alleged trade-mark and the advertisements accompanying it.

2. There is no legal evidence of title in the record.

3. There is no evidence in the record of any medicinal or intrinsically valuable qualities in plaintiff’s “preparation.”

The traverse in the answer of the allegation in the petition of its possession of these qualities, and the failure of plaintiff to make such proof, supported by the refusal of plaintiff to disclose the materials of which and the manner in which his “preparation” is compounded, are conclusive of the truth of the traverse. 14 *An.*, 81.

4. The plaintiff’s “preparation” is a quack “preparation” and is not entitled to protection. *Am. Trade-Mark Cases*, 180, 68, 471, 644, 226, *et seq.*, 154, 311; *Coddington’s Digest*, secs. 567, 661 to 663, 664.

5. By the use of the word “Imported” as part of the alleged trade-mark, as well as the representation of a *crown* thereon; and the advertisement accompanying each package, representing plaintiff as “sole agent for the proprietors,” the plaintiff was and is guilty of misrepresentation and fraud on the public; the “preparation” being compounded in the United States, and not in a foreign country; and plaintiff is not entitled to the protection of a Court of Equity. *Am. Trade-Mark Cases*, 290, 527, 640; *Browne on Trade-Marks*, sec. 491; and cases referred to in body of brief, recently decided in San Francisco, 36 *Law Journal*, ch. 328.

6. The open and notorious use of the alleged trade-mark for, at least, twenty years last past, and the *inferences and proofs* that such use *was* and *must* have been known to the plaintiff, and his acquiescence in such use, estop him from relief by injunction, and, at all events, from any recovery of damages. *Browne on Trade-Marks*, secs. 497, 510–512; *Coddington’s Dig.*, “*Acquiescence*,” page 17, *et seq.*

7. By whatever rule the plaintiff is entitled to measure any recovery, the amount of his recovery is damages—his claim for which is prescribed by lapse of one year. *C. C.*, 2315; *Browne on Trade-Marks*, secs. 502, 503 and 504; *Coddington's Dig.*, *Damages*, sec. 235, et seq.; *Upton on Trade-Marks*, pp. 244 to 246; *Graham v. State*, 40 *Col.*, 593; *S. C.*, *Sedgwick's Leading Cases on the Measure of Damages*, 716; *Sedgwick on the Measure of Damages*, 5th Ed., 675, note.

LEVY, J., delivered the opinion of the Court:

Similar judgments, based on the same evidence in both these cases, have been rendered, and they are consolidated for trial before this Court. The defendants are the appellants.

Plaintiff alleges infringements of his trade-mark of a preparation known as "Boker's Bitters," by defendants, and in his suits prayed for and obtained injunctions, and sought damages on account of said infringements. There were judgments in the lower Court, perpetuating the injunctions and awarding to plaintiff, in each of the suits, damages to the extent of five hundred dollars.

In his petition, plaintiff alleges that, since February, 1860, he has manufactured a medicinal preparation, or bitters, of great value, which has been successfully used as a specific in certain diseases; that this preparation has always been made of the best Cologne or French spirits, mixed with other ingredients of good quality and valuable curative properties, and to this preparation the name of "Boker's Stomach Bitters" was given many years since, and is the peculiar name by which it has always been known in the markets of this and other countries; that it has been officially recognized by the United States Commissioner of Internal Revenue, who has decided it to be a medicinal preparation which, if properly stamped, may be sold by druggists and apothecaries, without rendering them liable to pay a special tax as liquor dealers; that these "Bitters" were first manufactured in 1828, by John G. Boker; from 1828 to January, 1853, their manufacture and sale was conducted by said John G. Boker, in conjunction with his brother, E. Boker, in the name of John G. and E. Boker; E. Boker died in 1853, and the business was then conducted under

the style of John G. and his son, J. Boker, the former continuing as sole owner of the trade-marks, and receipts and manufacture. On the 29th of February, 1860, John G. Boker sold the business, the good-will, the trade-marks, receipts, and everything pertaining to the manufacture and sale of the "Bitters" to plaintiff, who was the son-in-law of said John G. Boker; that since said sale, plaintiff has been the sole and undisputed owner of said business, receipts and trade-marks, labels, and rights to use the same, and signatures of the old firms, and has had the exclusive right to manufacture and sell said Bitters, and has manufactured and sold them in large quantities, made of the best and finest materials; that, in 1853, the manufacturers adopted as a name and trade-mark, the words: "Boker's Stomach Bitters;" that from that date, they branded on the boxes or packages containing this preparation these words, and on the top of the boxes: "J. G. & J. B. Boker," and since, after notice to that effect, there has been an additional label with a *fac simile* of the signature of said firm; that at the same time and ever since, the manufacturers, for the further purpose of distinguishing the said Bitters, have affixed to every bottle thereof, a red label with the words: "Stomach Bitters, imported by J. G. & J. B. Boker, New York," printed thereon, and elaborated ornamentally, which they made part of their trade-mark for labels, and to avoid counterfeiting they put up their bitters in bottles of peculiar shape, easily distinguished from bottles generally used for other bitters; that his assignor invented the name "Boker's Stomach Bitters," and he was first to use the same, and the symbols, bottles and insignia described as trade-mark; that his said business has involved great expenditure .. of money and labor; that said trade-mark has become very valuable to him, etc.; that the defendants have for several years illegally manufactured and sold, and are still manufacturing and selling an inferior quality of bitters, which they represent to be the bitters manufactured and sold by plaintiff, and with the intention to deceive the public, and fraudulently derive advantage thereby, they have used the same form of bottles, adopted by plaintiff, and have affixed thereto a notice similar to plaintiff's, and a counterfeit of the signatures of John G. and J. Boker, and

a counterfeit and close imitation of the red label of plaintiff and the words thereon, and the symbols and insignia surrounding said words, and with same intent, have imitated and counterfeited on the boxes used by them the *labels* and words selected and used by plaintiff and his assignor, as set forth above. He also alleges that the sale of inferior bitters by the defendants, as the genuine "Boker's Stomach Bitters" has greatly injured the reputation of plaintiff's preparation, and this has materially injured plaintiff in his business.

Defendant filed an exception of no cause of action and also answered, denying that the words used by plaintiff constitute a trade-mark, and alleging that, even if they do, plaintiff has no right or ownership therein entitling him to the exclusive use and appropriation of the same; that for more than twenty-five years the pretended trade-mark has been and is now in common public use, and this has not been objected to, but has been acquiesced in by plaintiff and his assignor, and that no exclusive right to the same can be maintained. Further, they aver that the representation on the labels that the said compound is imported, is false and fraudulent, and intended as a fraud upon the public, and, therefore, plaintiff is not entitled to the exclusive use or the protection demanded by him. He avers also that plaintiff holds out to the public, not that he is the owner, but that he is the agent of the proprietors, whose names are not discovered; that, if he is agent, he is without right to stand in judgment; that if such representation is not true, then he is guilty of fraud and deceit upon the public, which estops him from demanding the interposition of this Court. They also deny that the preparation is possessed of medical and curative qualities, and aver that such representations are a fraud and estop plaintiff's demand.

The defences set up in the answer may be thus summarized, and will be considered in their order:

1st. That plaintiff has not proved by legal evidence his proprietary interest in the trade-marks and labels.

The testimony of many witnesses in the record proves satisfactorily that plaintiff and his vendors for a great number of years

have been in the ownership of the trade-mark and labels, and this testimony was not objected to.

1. The objection to the admissibility of the copy of the Act of sale to plaintiff, as evidence, was not ruled upon, and no bill of exception was taken to its admission. We think the ownership is fully proved. 1 *Dillon's U. S. C. C. R.*, 329; 9 *La.*, 424.

2nd. That plaintiff has failed to prove that these bitters have medicinal properties.

The testimony, and, indeed, the universal opinion on the subject makes it clear to our mind, that bitters are regarded as tonics and are useful in the correction of many disorders of the stomach; that these particular bitters have been in general use, as such, for a very long time; that they are pure and made of good materials; that the United States Internal Revenue Department recognized them as valuable and exempted them from the special liquor tax, which exemption is only made in cases of liquors which are regarded as forming part of medicinal preparations. 100 *U. S. R.*, 617; 6 *Wait's Actions*, 27, 24a, 97.

3rd. That plaintiff is guilty of fraud in representing on his labels that the bitter is "imported," and is thus disentitled to to equitable remedy.

The evidence satisfies us that the use of this word on the label was not made for the purpose of deceiving the public or with fraudulent intent.

In the case of *Wolfe v. Barrett & Lion*, 24 *A.*, 97, this Court held: "but if the trade-mark consists of something else, as the plaintiff's own name combined with a sonorous appellation, well calculated to express origin and ownership, as well as to attract the attention and impress the memory of buyers, it is only necessary that he should manufacture, without exclusive right, or represent a manufacturer." And we think the true rule, as applicable to this case, is correctly stated in the following passage, (from *Up-ton on Trade-Marks*, 97), to be this:

"That the honest, skillful and industrious manufacturer or enterprising merchant, who has produced or brought into the market an article of use or consumption that has found favor with the public, and who, by affixing to it some name, mark, device or

symbol, which serves to distinguish it *as* his, and to distinguish it from all others, has furnished his individual guaranty and assurance of the quality and integrity of the manufacturer, shall receive the first reward of his honesty, skill, industry or enterprise; and shall in no manner and to no extent be deprived of the same by another, who, to that end, appropriates and applies to his productions the *same or a colorable* imitation of the same *name, mark, device or symbol*, so that the public are, or *may be*, deceived or misled into the purchase of the productions of the one, supposing them to be those of the other. 17 *Barbour*, 608; 3 *Sanford*, 725; 25 *Barb.*, 416."

In the case of *Insurance Oil Tank Co. v. Scott*, recently decided by us and reported in 33 *A.*, 946, this Court considered and passed upon a question much like this; in the last named case, the word *patented* being used upon the labels or plates, when it was contended that the article had not been really patented. We there held:

"Defendant urges that the use of the abbreviation 'Pat.,' meaning *patented*, in the trade-mark, is a fraud on the public and a violation of law, which deprives plaintiff of the right of redress. It is undoubtedly true that the affixing of the word 'patent' to an unpatented article, 'for the purpose of deceiving the public,' is prohibited, under penalties, by the laws of the United States; *U. S. R. S.*, sec. 4901; and that a representation in a trade-mark that an important article is protected by a patent, *prima facie* amounts to a misrepresentation of an important fact, which would disentitle the owner of the mark to relief in a Court of Equity, as against a pirate. *Browne on Trade-Marks*, sec. 572; *Coddington's Digest Tr.-M. Cases*, sec. 548; 38 *Conn.*, 450. But to have such effect, the use of the word 'patented' must be 'with the purpose of deceiving the public,' and if such fraudulent intention does not exist, and the use of the word may be explained in any reasonable sense consistent with truth and honesty, the party will not be prejudiced. *High on Injunctions*, sec. 674; *Coddington's Dig.*, secs. 570, 571." Also: "It may be, as contended by defendant, that the oil sold by him under plaintiff's trade-mark is equal, in all respects, to the oil of plaintiff. But, if defendant may use

this mark, other less conscientious dealers may employ it for inferior and dangerous oils; and the public would thereby be deprived of the security now enjoyed in the purchase of oil so marked, and the business of plaintiff would be destroyed." *Ibid.* "Defendant has no right, in justice or in law, to trade upon the reputation and business sagacity and enterprise of plaintiff, which are represented by and embodied in its trade-mark." *Ibid.* See also *Coddington's Dig.*, secs. 546, 543, 558, 561, 565, 570, 571; *Cox' Manual of Trade-Marks*, 117, 195, 591, 106, 180.

The use of the words "Sole Agent," by plaintiff, which is dwelt upon by the defence, has been satisfactorily explained and falls under the above reasoning, because they were not used for the purpose of deceiving the public or with fraudulent intent.

4th. Defendants contend that, from long use by others they were justified in imitating the trade-mark, and they supposed acquiescence on the part of the owner.

2. The doctrine of acquiescence is ably and elaborately discussed in *Browne on Trade-Marks*, sec. 585. That author says: "Story, J., once spoke thus: Again it has been said that other persons have imitated the same spools and labels of the plaintiffs, and sold the manufacture. But this aggravates rather than excuses the misconduct, unless done with the consent or acquiescence of the plaintiffs, which there is not the slightest evidence to establish; or that the plaintiffs ever intended to surrender their rights to the public at large or to the invader in particular." 3 *Story*, 458. In another case, Woodbury, J., said: "I am not aware of any principle by which a usage in this or a foreign country is competent evidence in defence of a wrong." "But I am not aware that a neglect to prosecute, because one believes he had no rights, or from mere procrastination, is any defence at law, whatever it may be in equity." "There is something very abhorrent in allowing such a defence to a wrong, which consists in counterfeiting others' marks or stamps, defrauding others of what had been gained by their industry and skill, and robbing them of the fruits of their 'good name,' merely because they have shown forbearance and kindness." "It is rather an aggravation to the plaintiff that many others have injured them." 2 *Wood & M.*, 1; 44 *Mo.*, 173.

5th. Defendant invokes the prescription of one year. We do not think it tenable. We concur with counsel for the plaintiff and the authorities cited by him, that the "infringer who illegally appropriates an invention to his own use, making profit thereby, may be treated as his trustee in respect to such profits and compelled to account therefor in equity." *Browne on Trade-Marks*, sec. 507; *Longue's Dig.*, p. 571; 19 A., 492, &c.

Under the circumstances of the case, however, we are not disposed to increase the damages allowed by the lower Court.

The judgments appealed from are, therefore, affirmed at cost of the appellants.

Rehearing refused.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

HOSTETTER, AND ANOTHER,*vs.*ADAMS, AND ANOTHER.

DECIDED 18 FEBRUARY, 1882.

REPORTED 10 FEDERAL REP., 838.

“Hostetter’s Bitters” Case.

1. The label and method of preparation for market of “Hostetter’s Celebrated Stomach Bitters,” is infringed by that adopted for “Clayton & Russell’s Celebrated Stomach Bitters,” inasmuch as the latter is plainly copied from the former by design, and its general effect is such as to deceive an ordinary observer having no cause to use more than ordinary caution.
2. The plaintiffs’ mark of trade is the entire style of their bottle and label, of which the name of their article forms a part, and the other details of design and lettering.

A. H. Clark, W. W. Goodrich and J. Watson, for plaintiffs.
W. A. Arnoux and A. Dutcher, for defendants.

BLATCHFORD, C., J.:

The bill alleges that the plaintiffs are, and for 27 years or more have been, partners doing business as Hostetter & Smith, and during that time engaged in making and selling a medicine known as "Hostetter's Celebrated Stomach Bitters;" that they have the sole ownership of the good-will, labels, or trade-marks of said bitters; that said bitters have acquired a reputation as a safe and valuable medicine; that, in order to designate said bitters as of their own compounding and as genuine, and to prevent fraud by having spurious bitters sold as and for the genuine, they from the beginning devised certain labels, tokens, or trade-marks, and a certain manner of putting up said bitters, placing them upon the market in a style different from that in use by manufacturers or dealers in like articles, and that they have adhered to said style up to the present time; that said bitters are placed by them in square bottles, of uniform size, known as No. 6, containing about one and a half pints, and having blown therein the name "Dr. J. Hostetter's Stomach Bitters," and upon these bottles they cause to be pasted labels or trade-marks, and the bottles then have revenue stamps put on them, and are packed in square boxes, each box containing a dozen bottles, and, so boxed, are sold to dealers; that the defendants are making and selling a spurious and inferior article of bitters, prepared in imitation of, and intended to be sold as and for, the genuine Hostetter's Celebrated Stomach Bitters of the plaintiffs' own manufacture, and calculated to deceive the public and consumers, and to enable the defendant to reap the profits of the reputation and sale of them; that, with like intent, the defendants have printed a false label or trade-mark in imitation of, and closely resembling, one of the plaintiffs' labels, said false label being well calculated to mislead and deceive customers of the genuine bitters; and that the defendants use the bottles of the plaintiffs, from which the genuine bitters have been used, and pack them in the same manner, in cases of the same shape, one dozen bottles in each case, in which manner they are sold. The bill prays for an injunction restraining the defendants from using said spurious label, and for other proper relief. The case has been heard on pleadings and proofs.

The plaintiff's bottle is of dark glass and has a four-sided body, the sides being of equal size and the faces rectangular. On one side is an engraved label with a white body. This label is substantially as long and as wide as the face of the bottle. Near the top, in four lines, in black, are the words "Hostetter's Celebrated Stomach Bitters," one word in each line. The third and fourth lines have letters of the same size and character, larger than the letters in the first and second lines. The letters in the first line are larger than those in the second line, and of different character from them, and from those in the third and fourth lines. The letters in the first line and those in the fourth line each of them form a curve, the convexity of which is upward. The second and third lines are horizontal. The letters in the first, third, and fourth lines are shaded. Underneath the fourth line is a horse without harness vaulting in the air towards the left, with his hind feet on the ground and his fore-feet in the air, mounted on his bare back by a naked man, with a helmet on, and a flying robe over his right arm, and in his two hands a spear, with which he is striking at a dragon below him on his left. The open mouth of the dragon is near the left knee of the rider, and the point of the spear is just above that knee. The body of the dragon passes under the horse, and his tail comes around the right hind leg of the horse and nearly reaches the body again. In a fore-paw of the dragon, near the end of his tail, appears to be a piece broken off from the head of the spear. The horse has flying mane and a sweeping tail. The horse, man, and dragon are dark on a white ground. Below them is a shield, commencing at a little below the middle of the length of the label. The shield has a dark ground. On it are letters printed in white. There are 16 lines of letters. Lines 1, 2, 4, 7, 8, 9, 10, 12, 13, 14, and 15 are the same size of type. The reading of the 16 lines, divided into lines, is this:

(1) "The best evidence of the merit of an article is" (2) "the disposition to produce counterfeits;" (3) "and we regard it as" (4) "the strongest testimony to the value of" (5) "Hostetter's" (6) "Celebrated Stomach Bitters" (7) "that attempts of that description have" (8) "been frequent." "A due consideration of" (9) "the public welfare has induced us to" (10) "obtain a

fine engraving, of which" (11) "this is a *fac simile*," (12) "and to append our note of" (13) "hand, which cannot be" (14) "counterfeited without" (15) "the perpetration" (16) "of a felony."

The word "and" and the word "as," in line 3, are smaller than the other letters. The words "we regard it," in line 3, and also lines 5, 6, 11, and 16, are on a black ground darker than the rest of the ground, and the letters are somewhat larger than the rest. All the letters in the shield are capitals. The line of the top of the shield consists of two curves of equal length, starting from an apex in the middle of the width and concave upwards, and having a uniform sweep, and alike, and rising each to a point as high as the starting point, and then each falling off by a short concave upward curve, to a point. Then the two sides of the shield sweep around downward, by equal curves, to the center of the width of the label and the lower point of the shield, completing the outline of the shield. The space on each side, between the outer edge of the shield and a border around the label and a horizontal line running across at the lower point of the shield, is filled in with engraved work of waving, irregular figures. Underneath the shield, in a parallelogram, is a promissory note for one cent, payable to the bearer on demand, signed "Hostetter & Smith." In the middle of the width of the upper part of the note in a small circle, having in it the head and bust of an aged man with a long white beard. There is a border around the whole label.

The defendants' bottle is of the same size, color, shape, and material as the plaintiffs', and many of the defendants' bottles are old bottles of the plaintiffs with the name "Hostetter" blown in the glass. The side which has that name on it is covered by the defendants' label. The defendants buy such old bottles when empty which the plaintiffs have sold in the market with bitters in. On one side is an engraved label with a white body. This label is substantially as long and as wide as the face of the bottle, and is of the same size as the plaintiffs' label. Near the top, in four lines in black, are the words "Clayton & Russell's Celebrated Stomach Bitters," one word in each line. The third and fourth

lines have letters of the same size and character, larger than the letters in the first and second lines. The letters in the first line are larger than those in the second line, and of a different character from them, and from those in the third and fourth lines. The letters in the first line and those in the fourth line each of them form a curve, the convexity of which is upward. The second and third lines are horizontal. The letters in the first, third, and fourth lines are shaded. The appearance presented by those four lines, as to the size and character and shading of the letters in the corresponding lines, and as to ornamentation in flourishes and dashes, is identical with the appearance presented by the corresponding four lines in the plaintiffs' label, as to the same particulars, except the difference resulting from substituting the words "Clayton & Russell's" for the word "Hostetter's." Underneath the fourth line is a horse, with harness and caparison and saddle upon him, vaulting in the air towards the right, with his hind feet on the ground and his fore feet in the air, mounted by a man with clothing on his trunk and feet, and a helmet, with wings on his head, and in his right hand a spear, with which he is striking at a scorpion on the ground in front of him. The horse has a sweeping tail. The horse, man, and scorpion are dark on a white ground. They and the four lines above them occupy respectively the same space up and down as the corresponding parts in the plaintiffs' label. Below them, commencing at the same point as in the plaintiffs', is a shield, which has a dark ground, with letters printed on it in white. There are 15 lines. The lines are all the same size of type, and the size of the type in line 1 in the plaintiffs'. The reading of the 15 lines, divided into lines, is this:

(1) "The bitters of Clayton & Russell will be" (2) "found a highly aromatic liquid and en-" (3) "tirely free from injurious substances." (4) "One wineglassful taken three times" (5) "a day before meals will be a swift" (6) "and certain cure for dyspepsia a" (7) "mild and safe invigorant for delica-" (8) "te females a good tonic preparation" (9) "for ordinary family purposes a" (10) "powerful recuperant after the" (11) "franie has been reduced by" (12) "sickness an excellent app-" (13) "etizer and an agreeable" (14) "and wholesome" (15) "stimulant."

All the letters in the shield are capitals. The line of the top of the shield is made up of four curves, and corresponds in all respects with the line of the top of the shield in the plaintiffs'."

The shield is the same size and shape as the plaintiffs', and has a corresponding space on each side, filled in with engraved work, waving in character, though larger in detail than in the plaintiffs. The lower point of the shield comes down to the same point as in the plaintiffs'. Underneath the shield, in a parallelogram, are the words: "Vendors do not require a liquor dealer's license, being a medical compound." There is a border around the whole label of about the same width as in the plaintiffs', though of a different character. There is a narrow space of white in the defendants' all around the lower parallelogram, and the side lines of white are carried up on each side of the top of the shield, and these continue down around the outer edges of the shield, differing in these respects from the plaintiffs'. The words beginning with "one wineglassful," to the end, at "stimulant," are formed in a label of gold letters, printed on a bronze ground, which is on another face of the plaintiffs' bottle.

1. It is shown that there are no such persons as Clayton & Russell, and that the defendants' label was prepared from the plaintiffs' by intentionally making the parts in it which are like corresponding parts in the plaintiffs', to be so like. It is plain that it is a copy from the plaintiffs' by design. Variations are made of such a character as to be capable of discernment and description. But the general effect to the eye of an ordinary person, acquainted with the plaintiffs' bottle and label, and never having seen the defendants' label, and not expecting to see it, must be, on seeing the defendants', to be misled into thinking it is what he has known as the plaintiffs'. The size, color, and shape of the bottle,—the four lines of letters at the top of the label being, as to the three lower ones, identical, and as to the upper one, differing only in the name,—the general effect of the horse and his rider, the size and shape and color of the shield, the white letters in it, and their size and arrangement in lines contracting in length towards the lower point of the shield, the whole in black on white ground, and the border, give an affirmative resemblance

calculated to deceive an ordinary observer and purchaser, having no cause to use more than ordinary caution, and make him believe he has before him the same thing which he has before seen on the plaintiffs' bottle and expects to find on the bottle he is looking at. The differences which he would see on having his attention called to them are not of such a character as to overcome the resemblance to the eye of a person expecting to see only the plaintiffs' bottle and label, and having no knowledge of another. The testimony to the above effect is of great strength.

2. The plaintiffs have no exclusive right to make the bitters. Their trade-mark is not in the words "Celebrated Stomach Bitters," nor have any exclusive right to a bottle of the size, shape, and color of the one which they use. But the entire style of their bottle and label, of which those words form a part, is, in connection with the other particulars above mentioned, in which the defendants' bottle and label are like theirs, the mark of their trade. *Williams v. Johnson*, 2 Bos., 1; *McLean v. Fleming*, 96 U. S., 245; *Frese v. Bachof*, 14 Blatchf., 432; *Coleman v. Crump*, 70 N. Y., 573; *Morgan's Sons' Co. v. Troxell*, 23 Hun, 632, and *Cox's Manual*, Case 674; *Sawyer v. Horn*, *Cox's Manual*, Case 667; *Mitchell v. Henry*, 43 Law Times Rep., (N. S.), 186.

The evidence as to transactions after the filing of the bill is admissible. It comes in not to show infringement, but to characterize the practical use of the subject-matter of the suit. The objection as to the recalling of witnesses is overruled. The plaintiffs are entitled to an injunction, and to a reference to a Master to take an account of profits, and to the costs of the suit.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

P. LORILLARD & CO.

vs.

DRUMMOND TOBACCO CO., AND OTHERS.

DECIDED 28 FEBRUARY, 1882.

REPORTED 14 FEDERAL REP., III.

"Tin Tag Label" Case.

Neither a letter nor a horseshoe, nor any such simple device can be claimed as a label.

Gifford & Gifford, for plaintiffs.

S. S. Boyd, for defendants.

BLATCHFORD, C. J.:

The first claim of the reissue ("Improvement in Plug Tobacco," granted to Charles Seidler, October 24, 1876), is the only one involved in this suit. That claim has not been directly sustained in any suit on final hearing. It was not directly sustained in the suit against Dohan. The third claim was infringed and sustained

in that suit, and the novelty of that claim was put upon the ground of a distinction between metallic letters too large to have enough to answer the purpose of a label, and a label with letters on it. If in that suit the first and fourth claims were considered, the word "label" in those claims did not require, for the purposes of the infringement, that any label not having letters on it should be considered.

The defendants' device in this case is a plain metallic horseshoe with no letters on it. It may be a trade-mark, but as such it is not like the plaintiffs' device as a trade-mark. As anything else, it is no more a label than the letters which, in the *Dohan Case*, were held not to be labels, were labels. A single letter, recognizable as such, is quite as much a distinguishing mark made by a piece of separate material as is a piece of metal of the form of a horseshoe. The letter B would be called the letter B, and the plain horseshoe would be called a horseshoe; but, to sustain the patent, neither can be called the label referred to in it.

The motion is denied.

See *Hostetter v. Adams*, 10 *Fed. Rep.*, 838.

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CIRCUIT COURT UNITED STATES, WESTERN
DISTRICT OF TENNESSEE. IN EQUITY.

SINGER MANUFACTURING CO.*vs.*RILEY, AND OTHERS.

DECIDED 7 APRIL, 1882.

REPORTED 11 FEDERAL REP., 706.

*“Singer Sewing Machine” Case.*TRADE-MARK—USE OF TRADE NAME AND MARK—AFTER
PATENT EXPIRED.

Where a patentee uses his name and marks to designate his invention, and also the product of it, as manufactured by himself, so that the public cannot separate the one from the other, he cannot acquire any right to the exclusive use of the name and marks after the patent has expired. HELD, therefore,

That the Singer Manufacturing Company, of New Jersey, has no exclusive property or trade name in the word “Singer,” and that their shuttle device, as a trade-mark, had not been violated by the devices used on the Williams machine, of Montreal, or the Sigwalt machine, of Chicago, the alleged imitations not being calculated to deceive a purchaser.

APPLICATION FOR INJUNCTION.

THE bill and amended bill allege that the plaintiff manufactures and sells "Singer Sewing-Machines;" has done so for many years, in all the countries of the world; and that by their excellence the machines have acquired a valuable reputation. It claims a *trade name* for the use of the word "Singer," and alleges that the defendants are fraudulently using it for purposes of injury to the plaintiff and to deceive the public. They also claim a *trade-mark* in certain devices described in the bill, which it is alleged the defendants have violated. The prayer is for an injunction. The answer denies that the defendants have ever pretended to sell machines of plaintiff's manufacture, and avers that they sell machines as good or better in point of manufacture. But defendants admit that they do use the name "Singer," either alone or in combination with other descriptive names of machines they sell. They explain this by averring that one Singer procured a patent for an invention of sewing machines of great excellence of mechanical construction, and enjoyed a monopoly of the patent for many years, until recently, when the patent expired and Congress refused to renew it; that this peculiar patented construction was from the beginning designated by the word "Singer," and the name was used to describe it throughout the world. Defendants aver that they have always been careful not to represent their goods as manufactured by the plaintiff, nor to deceive any one on that point. They deny the use of the same devices or such similar ones as are calculated to deceive, and produce samples of their own and plaintiff's machines in support of the denial. Affidavits are filed with both the bill and answer, and also the circulars and advertisements of the defendants.

U. W. Miller, for plaintiff, cited:

Coates v. Halbrook, *Cox Trade-Mark Cases*, 20, 27; *Taylor v. Carpenter*, *Id.*, 45, 57; *Coffeen v. Brunton*, *Id.*, 85, 86; *Davis v. Kendall*, *Id.*, 114; *Howard v. Henriques*, *Id.*, 129; *Walton v. Crowley*, *Id.*, 172; *Brooklyn White Lead Co. v. Mausury*, *Id.*, 210; *Clark v. Clark*, *Id.*, 210; *Dale v. Smithson*, *Id.*, 282; *Colton v.*

Thomas, Id., 507; *Amoskeag Manuf'g Co. v. Garner, Id.*, 540; *Dixon Crucible Co. v. Guggenheim, Id.*, 559, 562, 569; *Congress Spring Co. v. High Rock Spring Co., Id.*, 599, 624; *Filley v. Fassett, Id.*, 530; *S. C.*, 44 *Mo.*, 168; *Holmes v. Holmes*, 27 *Ct.*, 278; *Meriden Britannia Co. v. Parker*, 39 *Ct.*, 450; *Newby v. Oregon Cent. R. R.*, 1 *Deady*, 609; *Kimball v. Singer Manuf'g Co.*, 45 *Scottish Jurist*, 201; *Dunbar v. Glenn*, 42 *Wis.*, 134; *Canal Co. v. Clark*, 13 *Wall.*, 322; *McLean v. Fleming*, 96 *U. S.*, 245, 251; *Braham v. Bustard*, 1 *Hem. & Miller*, 447; *Eddleton v. Fick*, 23 *Eng. L. & Eq.*, 51; *Singer Manuf'g Co. v. Wilson*, 3 *App. Cas. L. R.*, 389; *Witthaus v. Mattfeld*, 44 *Md.*, 303; *Browne, Trade-Marks*, pp. 33, 34, secs. 396, 496; *Coddington Trade-Mark Dig.*, 415, 416, 418, 429, 453; *Singer Manuf'g Co. v. Larsen*, 13 *Chi. Leg. N.*, 59; *U. S. v. Roche*, 1 *McCrary*, 385, 2 *Daniell, Ch.* 1648, *et nota*; 3 *Wait, Ac. & Def.*, 195, 741, 742; 20 *Am. Law Reg.*, 34; 9 *Reporter*, 603, 737; *Patridge v. Menck*, 2 *Barb.*, 101; *Fronks v. Weaver*, 10 *Beav.*, 297; *Singer Manuf'g Co. v. Brill, Superior Ct., Cincti., July Term*, 1880; *Singer v. Lemaire, Belgium, MSS.*; *Warren v. Wing, Superior Ct. N. Y. Referee's Report*, Jan. 13, 1881; *Singer Manuf'g Co. v. Phillips, Ky. Dist.*, Oct. 11, 1880; *Singer Manuf'g Co. v. Kayser, N. Y. Supreme Ct., Jan.*, 1879.

H. F. Dix and W. W. Goodwin, for defendants, cited :

Bell v. Locke, 8 *Paige*, 75; *Fairbanks v. Jacobs*, 14 *Blatchf.*, 337; *Singer Manuf'g Co. v. Wilson, L. R.*, 2 *Ch. Div.*, 434; *Tucker Manuf'g Co. Case*, 9 *O. G.*, 455; *Singer Manuf'g Co. Stanage*, 6 *Fed. Rep.*, 297; *Singer Manuf'g Co. v. Loog, London Daily News*, Dec. 15, 1880; *Manuf'g Co. v. Trainer*, 101 *U. S.*, 51.

HAMMOND, D. J.:

1. The application for a preliminary injunction must be denied. The case of *Singer Manuf'g Co. v. Stanage*, 6 *Fed. Rep.*, 279, so fully expresses the conclusions to which I have come that it is not necessary to repeat the argument to be there found in favor of this judgment, although I have given the subject an extensive investi-

gation. The bill before me would, perhaps, entitle the plaintiff to an injunction, for it makes no mention of any patent, nor any reference to the fact that for many years the plaintiff's manufacture of sewing machines was thus protected, whatever may be said of those patents in their relation to the question of fact, which the House of Lords was unable to determine in *Singer v. Wilson, L. R.*, 3 *App. Cas.*, 376.

The answer, however, avers that the plaintiff used its alleged trade name and trade-mark to designate the principles of construction of sewing machines under the patents, and, while denying all allegations of misrepresentation and deceit, explains that the defendants only used the name "Singer" to represent that the machines sold were of that construction, and never to represent that they were machines manufactured by the plaintiff. The affidavits of plaintiff's witnesses only show that the defendants represented theirs as genuine "Singer" machines, and are not inconsistent with the averments of the answer; while the defendants' witnesses swear that they were told that the machines were of superior manufacture to those of the plaintiff, but that they were "Singer" machines. Hence, however, the proof at the hearing may affect the case, as it now stands there can be no injunction in any view of the question.

So, in reference to the labels and other devices claimed as trade-marks, the proof here is not satisfactory of any counterfeiting or misrepresentation by defendants. The respective machines have been brought into Court, and I must say I do not see how any person could be deceived by mistaking one for the other, if any reliance is placed on the devices as distinguishing characteristics. It is true, the general appearance of the machines is somewhat the same, as two tables or desks are alike, but even here some of the defendants' machines are dissimilar to those of the plaintiff in having the box used to cover the machinery on the table ornamented with moulding. The labels affixed to the arms of the machine are in no way alike, except that they are brass and oval, and are placed in relatively the same spot on the machines. The well-known device of the plaintiff, consisting of a shuttle, needles crossed, and the letter S made with the representation of the

thread surrounded by a partial wreath of a plant and the words "The Singer MFG. Co." and "Trade-Mark," is replaced in the other labels by entirely dissimilar devices. The one is a lion's head in bold relief, surrounded by the words "C. W. Williams MFG. Co., Montreal," and "Trade-Mark," while the other is a monogram of S. and M. upon a rough, flat surface, made by a chasing of parallel horizontal lines, surrounded with a raised dotted line, indented at opposite sides in the shape of a small segment of a circle, the words "The Sigwalt Sewing Machine Co., Chicago, Ill.," being imprinted around the entire device.

The said shuttle device is also cast in the frame-work of the leg or stand of one pattern of the plaintiff's machine. It is, of course, in that form more rude, but is plainly enough recognizable as the same device as that on the brass label. The corresponding device on the Williams machine is a large and well-defined horseshoe, surrounding the letter S (broad in its construction, and in no way resembling the S. of the shuttle device) and the word "Trade-Mark."

I am well aware that mere dissimilarity of detail is not a defence in cases like this, and the location of the mark on the package or article has much to do with the intention to deceive. Some of the cases have carried this principle to a great length, to prevent the fraud of using another's trade name or labels, or even form of packages. But the fraud consists in an imitation calculated to deceive and I think none of the best considered cases would hold that a trader could acquire an exclusive right to use an oval brass label on the fore-arm, and the letter S on the leg, of a sewing machine. It must be so ruled to declare against these devices of the defendants' machines, for they are not otherwise like those of the plaintiff.

The precise attitude of the English cases on this question is stated in a review of them by the *Solicitors' Journal*, reproduced in the *Central Law Journal*, vol. 11, pp. 3, 25, 84, 106. Vice-Chancellor Bacon's opinion in *Singer Manuf'g Co. v. Loog, L. R.*, 18 *Ch. Div.*, 395, 401, in favor of the plaintiff's claim, held that the plaintiff had established a right to the word "Singer" as its trade-mark and property, and that the defendant, whose un-

licensed use of the name was clearly proven, had entirely failed to show that the name "Singer" was known to the trade as descriptive of sewing machines of a particular construction or character not necessarily of the plaintiff's manufacture. But the opinion of the Court of Appeals, overruling this judgment of the Vice-Chancellor, says of the circulars and advertisements and devices, what as well applies to this case, that the documents set forth how the machines were manufactured, and there was nothing to lead any purchaser of them to suppose that he was buying machines manufactured by the plaintiff. The plaintiff company had no monopoly in the manufacture of sewing machines, their patent having expired some years ago, nor had they any property or right in the word "Singer" in the sense that they could restrain any one from describing his goods as "Singer's," however he might qualify or explain his use of that word. Lord Justice James said aside from the brass label he could not "see anything which could deceive any human being." In that case the label, which was voluntarily discontinued, unlike the labels in this case, contained upon it the word "Singer" in combination with others calculated to deceive a purchaser into the belief that he was buying a machine manufactured by the plaintiff. *L. R.*, 18 *Ch. Div.*, 395, 412.

The case of *Singer v. Phillips*, in the Circuit Court for the District of Kentucky, was *ex parte*, the bill being taken for confessed, and a formal decree entered for the plaintiff. There was no opinion or judgment such as could be considered an authority binding on this Court.

Our patent laws protected the plaintiff for many years in a monopoly to that extent that it needed no trade-marks for any other purpose than to designate the comparative excellence of the inventions protected. It and its licensees could have, while the patent lasted, no rival manufacturers of "Singer's sewing machines," and their work, as manufacturers of them, could not, therefore, be brought into competition with any one. Nor do I think the suggestion of counsel that there were many parts of the machine and principles of mechanical action and combination not patented affects the question as long as any part of it was so patented. The word had come to be descriptive of peculiarities,

not of manufacture by a particular person, but inherent in the machine itself, and when this is so no right to an exclusive use can arise, whether there be a patent or not.

It is a part of the history of our inventions, known to the Courts as well as others, that the names of inventors are used to distinguish their inventions, and there have been "Howe," "Singer," "Grover & Baker," "Wheeler & Wilson," etc., to indicate the different kinds of patented sewing machines.

It is the consideration now due to the public, when the patents have expired, that it shall have the unobstructed benefit of these inventions, and there is not the least foundation in principle or reason for allowing the patentees to continue to enjoy as much of the monopoly as they can save by the claim to use exclusively the trade names and marks by which they identified and secured to themselves the reputation of their inventions. These go along with the invention as a dedication to the public for purposes of description and identification, and the patentees should not by this means be permitted to take any advantage by them where they have so commingled their marks for the invention, and their marks for their own manufacture, that the public cannot separate the two as in this case. The following additional authorities may be instructively consulted on the general subject. 25 *Abb. L. J.*, 203; 21 *Abb. L. J.*, 444; *London Law Times*, Jan. 1, 1881; *Levy v. Walker*, L. R., 10 Ch. Div., 436; *Singer Manuf'g Co. v. Loog*, L. R., 11 Ch. Div., 656; *Ewing v. Johnson*, L. R., 13 Ch. Div., 434; *Massam v. Thorley Cattle Food Co.*, L. R., 14 Ch. Div., 748; S. C., *Id.*, 736; *Pepper v. Labrot*, 8 *Fed. Rep.*, 29; *Sawyer v. Kellogg*, 7 *Fed. Rep.*, 720; *Sawyer v. Horn*, 1 *Fed. Rep.*, 24; *Carroll v. Ertheiler*, *Id.*, 688; *Dixon v. Benham*, 4 *Fed. Rep.*, 527.

Injunction refused.

99 William Rogers Manf'g Co. *vs.* Rogers & Spurr Manf'g Co.

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CIRCUIT COURT UNITED STATES, DISTRICT
OF MASSACHUSETTS. IN EQUITY.

WILLIAM ROGERS MANUFACTURING CO.

vs.

ROGERS & SPURR MANUFACTURING CO.

DECIDED 22 APRIL, 1882.

REPORTED 11 FEDERAL REP., 495.



“Rogers Silverware” Case.

1. TRADE-MARK—RIGHT.—The right to use a trade-mark is one which depends on use.
2. SAME—USE OF NAME.—Any one has a right to the use of his own name in business, but he may be restrained from its use if he uses it in such a way as to appropriate the good-will of a business already established by others of that name, nor can he, by the use of his name, appropriate the reputation of another by fraud, either actual or constructive.
3. SAME—ENJOINING USE OF NAME.—Any one who rightfully uses a name of established reputation as part of a trade-mark in a particular business may enjoin its interfering use by others.

F. Chamberlain, and O. H. Platt, for complainants.

T. W. Clark, and B. S. Parker, for defendant.

LOWELL, C. J.:

The plaintiffs allege that one William Rogers, of Hartford, had been a skillful manufacturer of silver-plated ware long before 1865, and had acquired a high and valuable reputation; and in that year a copartnership was formed between one Birch and one Pierce, who agreed with William Rogers that the firm should be called the William Rogers Manufacturing Company, and agreed with him and his son, William Rogers, Jr., that they might adopt and use as trade-marks, “ Wm. Rogers & Son,” and “1865, Wm. Rogers Mfg. Co.,” and that they were so used until 1872, when the present corporation was formed, and bought all the stock, good-will, etc., of the firm; that the two companies, successively, have used these trade-marks, from 1865 to the time of filing the bill, by stamping them upon their goods, and have taken great pains with the manufacture of the plated spoons, forks, and knives which they have put upon the market, and thus their goods have become favorably and extensively known as the “Rogers” and “Rogers & Son” goods, and are inquired for by these names; that both these names are of great value and distinguishing appellations in the trade, and the spoons, forks, and knives so stamped have acquired and possess a special value; that on or about January 1, 1880, Lorenzo Spurr and George W. Spurr, associated as George W. Spurr & Co., manufacturers of silverware, at Greenfield, knowing the premises, combined and confederated with David C. Rogers and George E. Rogers, a son of said David, to cheat and defraud the complainants by stamping their spoons, forks, and knives with the names, “Rogers” and “Rogers & Son” and “Rogers & Son,  Greenfield, Mass.,” and that in February, 1881, the said George W. Spurr, David C. Rogers, and George E. Rogers, with others, formed the defendant corporation, with the intent to make, and that said corporation has made and sold, spoons, forks, and knives stamped Rogers & Son, Greenfield, Mass., (with an arrow); that

99 William Rogers Manf'g Co, *vs.* Rogers & Spurr Manf'g Co.

those stamps are not distinguished by ordinary purchasers, using ordinary care, from the stamps of the plaintiff company; that they make and sell inferior goods; that they adopted their pretended trade-marks in order to deceive purchasers.

The prayer of the bill is for an account; an injunction against the use of the trade-marks set out in the bill, or any other stamp having the word "Rogers" or "Rogers & Son" as the whole or part thereof upon silver-plated forks, knives, and spoons; and for general relief.

The answer denies all the allegations of the bill as to the plaintiffs' title, and charges that the complainants deceived the public by pictures, advertisements, etc., representing their wares to be the veritable manufacture of William Rogers and William Rogers, Jr.; admits the use of the trade-mark Rogers & Son, (with an arrow), but denies that it can deceive the public.

The evidence on both sides proves that there were three brothers Rogers in Connecticut, who were honest and skillful silver-platers; among the first, if not the first, in this country to adopt the electrotyping process; that they failed in business and afterwards severally gave the use of their name, for value, to two or three different companies in Connecticut, and assisted them in the manufacture for a longer or shorter time. These companies are now friendly, as I understand, and have long used trade-marks, three of which still survive, viz., "Rogers Bros.," "Rogers & Bro.," and "Wm. Rogers & Son," with an anchor, which are used by these several manufacturers respectively; the last by the plaintiffs only. The title of the Meriden Company to use one of them was established in *Meriden Britannia Co. v. Parker*, 39 Conn., 450.

The firm called the William Rogers Manufacturing Company, predecessors of the plaintiff corporation of the same name, had an arrangement with William Rogers (one of the three brothers) and his son for the use of the name, and William Rogers was a silent partner and had charge of the plating. This connection, which was to have lasted for a long time, was terminated in two years, for reasons not necessary to be considered here. The father and son then advertised and wrote letters and circulars declaring

themselves the sole owners of the trade-mark, "Wm. Rogers & Son," and were restrained by the Court from continuing such publications and announcements; and the son having violated the injunction was punished. The whole record of this case is in evidence. A part of it is reported in *William Rogers Manuf'g Co. v. Rogers*, 89 *Conn.*, 121. Since that time no one has disturbed the plaintiffs in the use of their trade-marks; and for this reason it is immaterial to enter into the merits of that controversy.

1. The right to use a trade-mark is, above all other rights, one which depends upon use.

All those companies whose trade-marks were originally derived from the brothers Rogers have maintained a remarkably good standard of merit in their manufactures, so that all plated spoons, etc., marked "Rogers" or known as "Rogers" goods, command a superior price. The plaintiffs' goods are not known as "anchor," but as "Rogers" and "Rogers & Son" goods.

There is no doubt that George W. Spurr, a silver-plater of Greenfield, intended to obtain some of the value of the Rogers name, and that with this object he paid a royalty of five cents a dozen to D. C. Rogers & Son for the use of their trade-mark from August, 1880, to January, 1881; then he organized the defendant company, who agreed to pay D. C. Rogers and E. C. Rogers at the rate of four cents a dozen for 25,000 dozen, for the use of the trade-mark, but would make no final agreement until this suit should be decided. The history of this trade-mark is that D. C. Rogers and George E. Rogers applied in February, 1879, to the Patent Office to register under the Act of Congress a trade-mark consisting of the words "Rogers & Son," with an arrow. In the sworn application or "statement and declaration" required by law they represented themselves as doing business at Greenfield, Massachusetts, under the firm-name of Rogers & Son, and declared that they intended to use the trade-mark upon table cutlery, knives, forks, etc. Mr. Grinnell, of Greenfield, whom D. C. Rogers consulted upon the subject, asked him the pertinent question whether he intended to use this trade-mark himself or merely to trade upon; and he answered that he intended to use it in the manufacture of goods himself; and the application to the

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Patent Office conforms to this answer. But what the father and son did was to trade upon it; they let it out to George W. Spurr & Co. for a royalty, and afterwards to the defendants for a royalty. This royalty is paid for a falsehood. The names of these Rogerses is not of the slightest value in the silver-plating business, which they never learned or practiced; nor were they ever partners, as I read the evidence, except in hiring out this trade-mark. It is impossible that this royalty can be paid for anything but the chance of purchasers supposing it to represent some other Rogerses. A Court of Equity cannot be expected to look with much favor upon a trade-mark thus acquired and thus used.

The name of the defendant company was undoubtedly adopted by its originator and chief stockholder, George W. Spurr, with the same purpose. His letters make this clear. If it had been his own business and reputation alone which he intended to preserve and foster, the name would have been Spurr without the Rogers, or Spurr first and Rogers afterwards. Speaking for myself only, I should be much inclined to say that the use of such a corporate name might well be enjoined at the suit of those who had given the Rogers name its value, as in *Holmes v. Holmes, Booth & Atwood Manuf'g Co.* 37 Conn., 278, for reasons which I shall give presently; but Gray, C. J., in *Gilman v. Hunnewell*, 122 Mass., 139, 152, has thrown some doubt upon the decision in that case; and in *Massam v. Thorley*, L. R., 14 Ch. D., 748, 763, the Lord Justices, in a case very like the present, refused to enjoin the use of the name entirely, if it could be so used as not to injure the plaintiff.

The defendants insist that the plaintiffs have made false and fraudulent statements to the public, to the effect that they are still manufacturing under the direction and management of William Rogers and William Rogers, Jr. Both parties have fallen into the mistake of supposing that it was important to have a Rogers and his son to authorize them to use the trade-mark Rogers & Son. The law is not so. Any one might use that trade-mark for the first time that it was used, and if there was no Rogers in the same business no Rogers could complain. *Levy v. Walker*, L. R., 10 Ch. D., 436; *Massam v. Thorley Co.*, L. R., 14 Ch. D., 738.

It was unnecessary for the plaintiffs to send around pictures of William Rogers and his son, as they have done. Such a method of advertising is more appropriate to the trade in patent medicines. But I do not quite see the injury to the public in this course of action. I think there is little doubt, upon the facts proved, that the reputation which the goods marked Rogers & Son, and Rogers & Bro., and Rogers Bros., have now acquired, depends upon the conduct of those who now use those names, and not upon any supposition in the minds of the purchasers that the persons who originated the business still conduct it. Under these circumstances it does not seem to me that the plaintiffs have dis-entitled themselves to relief.

2. A great deal was said in argument about the natural right of a man to use his own name in any business that he chooses to adopt. This, however, as I have said, is the case of a defendant corporation which has adopted a name to suit its business: and of persons, having the name, who have adopted a trade-mark to let out for hire to other persons.

Even if we grant all that has been said about the freedom to use names, (and I grant upon that subject much more than has been argued, for I set no limits to that freedom, excepting interference with acquired rights), the books are full of cases in which defendants have been restrained from using their own names in a way to appropriate the good-will of a business already established by others of that name. *Croft v. Day*, 7 *Beav.*, 84; *Metzler v. Wood*, L. R., 8 *Ch. D.*, 606; *Fallwood v. Fallwood*, L. R., 9 *Ch. D.*, 176; *Levy v. Walker*, L. R., 10 *Ch. D.*, 436; *Massam v. Thorley*, L. R., 14 *Ch. D.*, 748; *McLean v. Fleming*, 96 *U. S.*, 245; *Devlin v. Devlin*, 69 *N. Y.*, 212; *Filkins v. Blackman*, 13 *Blatchf.*, 440; *Stonebraker v. Stonebraker*, 33 *Md.* 252; *Shaver v. Shaver*, 54 *Iowa*, 208; (*S. C.*, 6 *N. W. Rep.*, 188); *Churton v. Douglas, Johna. (Eng.)*, 174. See 25 *Albany Law J.*, 203.

"All these cases in equity depend upon an appropriation by one person of the reputation of another, sometimes actually fraudulent, and sometimes only constructively so.

"It should never be forgotten in these cases that the sole right to restrain anybody from using any name that he likes in the

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course of any business that he chooses to carry on, is a right in the nature of a trade-mark; that is to say, that a man has a right to say: 'You must not use a name, whether fictitious or real; you must not use a description, whether true or not, which is intended to represent, or calculated to represent, to the world that your business is my business, and so by fraudulent misstatement, deprive me of the profits of the business, which would otherwise come to me.''' *Per James, L. J., Levy v. Walker, L. R., 10 Ch. D., 447-8.*

The reason why artificial trade-marks are absolutely protected, without inquiry into motives, etc., is that the defendant has no natural right to such a symbol, and has the whole world of nature from which to choose his own. The same principle, in my judgment, applies to corporate names; but here I am met by authorities hesitating to take this ground, as I have said. The defendants insist that there is no sufficient evidence that purchasers would be misled. The purpose being what it was, it would not need a great deal of evidence to prove it successfully accomplished. There is evidence that buyers at retail would be very likely to be deceived.

But the defendants say, again, "Rogers" has become a mere designation of a particular kind of ware, like Thompsonian medicines, or Singer sewing machines. *Thompson v. Winchester, 19 Pick., 214; Singer Co. v. Arsen, Cox, Dig., No. 659.* But the evidence does not support this defence. The Rogers name does not express a certain sort of goods, but serves as a warranty of good workmanship, because all those persons who have used it have followed faithfully the excellent example of the original Rogerses, who insisted on honest work.

It is further argued that the Rogerses are so many that the Court cannot find an intent to appropriate the reputation of one of them more than another; and that, if any suit will lie, it must be by all those who use any trade-mark whose distinctive feature is the name Rogers.

3. I believe it to be true that the Greenfield Rogerses did not inquire, nor did the defendants care, whose reputation they were

making available; but I am of opinion that any one of those who rightly uses the name, may enjoin its interfering use by others.

Profits stand on a different footing. As at present advised, I should say that the profits made from the name Rogers belong to all those who rightly use it. It is possible, however, that the plaintiffs may be able to prove facts which will give them special profits. They are entitled to, at least, an injunction, costs, and nominal damages, and, if they choose to take the burden of going to a Master, I am bound to permit them.

Interlocutory decree for the complainants.

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COURT OF APPEALS, STATE OF NEW YORK.
IN EQUITY.

ENOCH MORGAN'S SONS' CO., RESPONDENT,

*vs.*BENJAMIN F. TROXELL, ET AL., APPELLANTS.

DECIDED 30 MAY, 1882.

REPORTED 89 N. Y., 292.

"Sapolio vs. Pride of the Kitchen Soap."

1. Where there is a simulation of trade-mark, and the intent becomes a subject of inquiry, the form, color and general appearance of the package may be material; but the party cannot appropriate an ordinary and usual form of package and fashion of label, and exclude all others from its use, or from the use of anything resembling it; to sustain an action restraining such use there must be an imitation of something that can legally be appropriated as a trade-mark.
2. The mere idea represented by some figure, on an article sold for polishing purposes, that it will make things bright enough to be used as mirrors, cannot be appropriated as a trade-mark.
3. An action cannot be maintained to restrain a defendant from selling his own goods in packages and with labels, he has a legal right to use, and which did not infringe upon any trade-mark of the plaintiff, and

because of fraudulent representations and devices on the part of defendant to palm off his goods as those of the plaintiff's.

4. Plaintiff prepared and sold a soap for cleaning and polishing, which was put up in square cakes, wrapped in paper coated with tinfoil, with a band of blue paper about it, on which, on one side of the package, is printed in gold letters the label, "Sapolio, for cleaning and polishing, manufactured by Enoch Morgan's Sons' Co., 440 West Street, New York." On the other side, "Enoch Morgan's Sons' Sapolio," with the device of a human face opposite to and reflected in a pan. Defendant thereafter prepared and sold a soap put up in cakes of a different shape from those of plaintiff, wrapped in tinfoil, with a band of blue paper; on one side printed in large gilt letters, "Troxell's Pride of the Kitchen Soap," then the small figure of a monkey looking at some indistinct object held in his hand, on each side of which is the word "trade-mark," and below in small letters the words, "scouring and polishing." On the other side is printed in large letters, the words, "Pride of the Kitchen Soap," and six lines in small letters describes its uses. **HELD:**

That the facts did not show any infringement of a trade-mark; and that an action was not maintainable to restrain defendants from so preparing and selling their soap.

E. M's Sons' Co. vs. Troxell, (23 *Hun*, 632), reversed.

APPEAL from judgment of the General Term of the Supreme Court, in the First Judicial Department, entered upon an order made February 4, 1881, which affirmed a judgment, in favor of plaintiff, entered upon the report of a referee. (Reported below; 23 *Hun*, 632).

This action was brought to restrain defendant from an alleged infringement upon plaintiff's trade-mark.

The material facts are stated in the opinion.

E. More, for appellants.

Defendants cannot be restrained in the use of their trade-mark, although it has a general resemblance to plaintiff's, as they have neither copied or simulated plaintiff's, nor appropriated anything they had not a right to. (*Amoskeag Case*, 2 *Sandf.*, 606, 608; 58 *N. Y.*, 233; *Gillott v. Esterbrook*, 47 *Barb.*, 455; *Wolfe v. Burke*, 56 *N. Y.*, 115, 122; 7 *Lans.*, 151; *Browne on Trade-*

Marks, secs. 271-2; *Faber v. Faber*, 2 *Abb.*, [N. S.], 115; *Falkenburgh v. Lucy*, 35 *Cal.*, 52; *Coddington on Trade-Marks*, secs. 19-159; *Blackwell v. Wright*, 73 *N. C.*, 310; *L. R.*, 41 *Ch.*, 359; 46 *Id.*, 707; 42 *L. T. Rep.*, [N. S.], 857; *Cook v. Starkweather*, 12 *Abb. Pr.*, [N. S.], 392; *Moorman v. Hoge*, 2 *Sawyer*, 75; *High on Injunctions*, p. 400, sec. 690; *Frese v. Bachof*, 13 *Off. Gaz.*, 17 *Barb.*, 608; 4 *Abb.*, 114; 61 *N. Y.*, 74; 35 *Cal.*, 52; 44 *Mo.*, 173; *L. R.*, 13 *Ch. Div.*, 181; *Enoch Morgan's Sons v. Schwachofer*, 55 *How.*, 38). Where there is a particular infringement, where defendant has attempted to imitate something which was plaintiff's exclusive property, the rule, as applicable to shelf goods, is that the purchasers must read the label, unless it is sold and known by the mark. (1 *How. App. Cas.*, 358; 2 *Sandf. Ch.*, 625; 11 *H. of L. Cases*, 36 *L. J.*, 504; *Coleman v. Crump*, 70 *N. Y.*, 578). If defendants' package is fair competition the judgment cannot be sustained, either as to damages or injunction, on the outside pretence that they caused their goods to be sold as plaintiff's. (*Matthews v. Coe*, 19 *N. Y.*, 61).

Sam'l Hand, for respondent.

A manufacturer of a valuable commodity, who affixes any *indicia* thereto, whereby the genuineness of its origin is assured, thereby becomes vested with an exclusive right to use such *indicia* in the sale of such commodity. (*Colloday v. Baird*, 7 *Upp. Can.*, *L. J.*, 132; *McAndrews v. Bassett*, 10 *L. T.*, [N. S.], 442; *Appolinaris Co. v. Norris*, 23 *Id.*, 242). The character of the mark is not of judicial prescription. Whatever the manufacturer first appropriates, a Court of Equity will protect. (*Wotherspoon v. Currie*, 27 *L. T.*, [N. S.], 303; *Coleman v. Crump*, 7 *N. Y.*, 573; *Enoch Morgan's Sons' Co. v. Schwachofer*, 55 *How.*, 37; *Same v. Troxell*, 23 *Hun.*, 632; *Perry v. Truefitt*, 6 *Beav.*, 66; *Coats v. Holbrook*, 2 *Sandf. Ch.*, 594; *Williams v. Johnson*, 2 *Bosw.*, 6; *Cook v. Starkweather*, 13 *Abb. Pr.*, [N. S.], 392; *Popham v. Wilcox*, 38 *N. Y.*, *Sup. Ct.*, 280). If a trade-mark may be constituted of labels, names, marks, letters, symbols, form, appearance, color, style, rim, glazed or shellacked preparations, packages, cases and vessels, then such mark is infringed by the use

of any such mark thereof, *a fortiori*, may it be infringed by the use of that which is the most conspicuous and striking portion thereof. (*Hostetter v. Vanwinkle*, 1 *Dill*, 329; *Wotherspoon v. Currie*, 27 *L. T.*, [*N. S.*], 303; *Taylor v. Carpenter*, 3 *Story*, 548; *Braham v. Bustard*, 9 *L. T.*, [*N. S.*], 199; *Woolman v. Ratcliff*, 1 *H. & M.*, 259; *Amoskeag Co. v. Spear*, 2 *Sandf., Sup. Ct.*, 599). The question is, would the public be deceived? (*Thompson v. Laight*, 18 *Beav.*, 164; *Walton v. Crowley*, *U. S. C. C., S. D., N. Y.*, 3 *Bl. C. C.*, 440; *Clark v. Clark*, 25 *Barb.*, 76; *R. Cox*, 206; *Colton v. Thomas*, 7 *Phila.*, 257; 2 *Brewst.*, 308; *R. Cox*, 507; *Filley v. Fassett*, 44 *Mo.*, 173; *R. Cox*, 538; 8 *Am. L. Reg.*, [*N. S.*], 402; *Popham v. Wilcox*, 14 *Abb. Pr.*, [*N. S.*], 206; *Colman v. Crump*, 8 *J. & S.*, 548; 70 *N. Y.*, 573; 16 *Alb. L. J.*, 352; *McLean v. Fleming*, 96 *U. S.*, [6 *Otto*], 245; 13 *U. S. Pat. Gaz.*, 913; *Hennessey v. White*, 6 *W. W. & A. B. Eq.*, 216, 221; *Swift v. Dey*, 4 *Robt.*, 611; *R. Cox*, 319; *Boardman v. The Meriden B. Co.*, 35 *Conn.*, 402; *R. Cox*, 490; *Moses v. Sargood, Ewing & Co.*, *Nov.* 22, 1878). Absolute identity is not required. (*Seixo v. Provezende*, *L. R. Ch.*, 192; 12 *Jur.*, [*N. S.*], 215; 14 *L. T.*, [*N. S.*], 314; 14 *W. K.*, 357; *Bradley v. Norton*, 33 *Conn.*, 157; *Cox*, 331; *Barrows v. Knight*, 6 *R. J.*, 434; *Cox*, 238; *Harrison v. Taylor*, 11 *Jur.*, [*N. S.*], 408; 12 *L. T.*, [*N. S.*], 339; *Wotherspoon v. Currie*, *L. R.*, 5 *H. of L.*, 508; 42 *L. J. Ch.*, 130; 27 *L. T.*, [*N. S.*], 393; 22 *Id.*, 260; 18 *Weekly Rep.*, 562; 42 *L. J. Ch.*, 130; 23 *L. T.*, [*N. S.*], 443; 18 *Weekly Rep.*, 942; *L. R.*, 5 *H. of L.*, 517; *Stephens v. Peel*, 16 *L. T.*, [*N. S.*], 145; *Sohl v. Geisendorf, Wilson*, [*Ind.*], 60; *Meriden B. Co. v. Parker*, 39 *Conn.*, 450; 12 *Am. Rep.*, 401; 13 *Am. L. Reg.*, [*N. S.*], 153; *McLean v. Fleming*, 96 *U. S.*, [6 *Otto*], 241. In case where it appears that the defendant has adopted the plaintiff's trade-mark, and it is proved that the defendant's object in doing so was to pass off his own goods as those of the plaintiff, the Court will, without further inquiry, restrain the defendant. (*Hope v. Evans*, 30 *L. T.*, [*N. S.*], 204). The Court will also restrain a defendant where there has been such deception, although proof of the defendant's object be wanting, if it appear that any one has in fact been deceived, being thereby

induced to buy the defendant's goods as being the goods of the plaintiff. (*Colman v. Crump*, 70 *N. Y.*, 578; *Seixo v. Provezende*, 4 *L. T.*, [*N. S.*], 314; *Edelstein v. Vick*, 11 *Hare*, 78; *Taylor v. Taylor*, 53 *L. T. Ch.*, 225; *Enoch Morgan's Sons' Co. v. Schwachofer*, 55 *How. Pr.*, 37; 17 *Alb. L. J. Notes of Cases*, 1867, 134; *Lea v. Wolf*, 13 *Abb.*, [*N. S.*], 389; *Godillot v. Hazard*, 49 *How.*, 9; *Popham v. Wilcox*, 38 *N. Y. Sup. Ct.*, 280; 66 *N. Y.*, 74; *Lockwood v. Bostwick*, 2 *Daly*, 521; *Kinney v. Basch*, 16 *Am. L. Reg.*, 597; *Coddington's Dig. of Trade-Marks*, 411). Plaintiff is entitled to an injunction against the defendants, for the reason that their sales tend to deceive the public, and to produce a confusion of goods. (*Wooddam v. Ratcliff*, 1 *H. & M.*, 259; *Amoskeag Co. v. Spear*, 2 *Sandf.*, 399; *Wolfe v. Hart*, 4 *Vict.*, [*Australia*], *L. R. Eq.*, 125; *Perry v. Truefitt*, 6 *Beav.*, 73; *Binninger v. Wattess*, 28 *How.*, 207; *Wolf v. Goulard*, 18 *How. Pr.*, 64; *Burgess v. Burgess*, 17 *L. & E.*, 257; *Amoskeag Co. v. Spear*, 2 *Lond. S. C.*, 599; *Fettridge v. Wells*, 13 *How.*, 385; *Leighton v. Bolton*, 3 *Dow.*, 293; *Merrimack Co. v. Garner*, 4 *E. D. Smith*, 487; *Croft v. Daly*, 1 *Beav.*, 84; *Corwin v. Daly*, 7 *Bosw.*, 222). The fact that the two labels are different on comparison of the infringement with the genuine, is of itself no defence. (*Lockwood v. Bostwick*, 2 *Daly*, 521; *Dixon Crucible Co. v. Guggenheim*, 2 *Brewst.*, [*Penn.*], 321; *Philadelphia Legal Gazette*, April 8, 1870; *Swift v. Day*, 4 *Robt.*, 612-13; *Millington v. Fox*, *Myl. & Cr.*, 353; *Coffeen v. Brunham*, 4 *McL.*, 516; *Knott v. Morgan*, 2 *Keen*, 213). Plaintiff was not guilty of laches. (*Taylor v. Carpenter*, 2 *Woodf. & M.*, 1; *Amoskeag Co. v. Spear*, 2 *Sandf.*, 599; *Rogers v. Nowill*, 22 *L. J.*, [*N. S.*], *Ch.*, 404; 17 *Eng. L. & Eq.*, 83; *S. C.*, 17 *Jur.*, 109; *Gillott v. Esterbrook*, 48 *N. Y.*, 374; 47 *Barb.*, 445; *Wolf v. Barnett*, 24 *La. An.*, 97; *Lazency v. White*, 41 *L. J.*, [*N. S.*], *Ch.*, 354; *Taylor v. Carpenter*, 2 *Woodf. & M.*, 120; *Rodgers v. Rodgers*, 31 *L. T.*, [*N. S.*], 285; *McLean v. Fleming*, 6 *Otto*, 1; *Harrison v. Taylor*, 11 *Jur.*, [*N. S.*], 408; *Moet v. Couston*, 3 *Beav.*, 580; *Edelston v. Edelston*, 1 *DeG.*, [*N. S.*], 185; *Estcourt v. Estcourt*, *L. R.*, 1 *Ch.*, 276).

RAPALLO, J.:

Specimens of the packages and labels used by the plaintiff, and of those used by the defendants, and which are claimed to be an infringement of the plaintiff's trade-mark, have been submitted to our inspection, and we are clearly of opinion that there is too great a dissimilarity between the two to sustain the judgment in this case. The only point of similarity between the two articles sold are, that they are both small cakes of soap covered with tin-foil or tinned paper, and having a blue band around them, with gilt lettering. The cakes are not even of the same shape, one being nearly-square, and the other an oblong.

But we are of opinion that this form of package, with a blue band and gilt letterings, could not be appropriated by the plaintiff as a trade-mark. There is nothing peculiar about it, and it is an *appropriate* and usual form in which to put up small cakes of soap, and the law of trade-marks has not yet gone so far as to enable a party to appropriate such a form of package and fashion of label, and exclude every one else from its use, or from the use of anything resembling it. If it had, the different forms and fashions of cigar boxes and packages of chewing tobacco, perfumery, canned goods, and other small articles, and the color or style of labels which every dealer, according to his taste adopts or selects from those in use, would afford food for litigation, sufficient to give constant occupation to the Courts.

All those articles of each class bear a general resemblance to each other, and the products of the different dealers can be distinguished only by the brands, marks, or names which they may put upon them, and these can be protected as trade-marks only so far as they are new and comply with the other conditions necessary to constitute a trade-mark.

Where there is a simulation of a trade-mark, and the intent becomes a subject of inquiry, the form, color, and general appearance of the package may be material, but to sustain an action there must be an imitation of something that can legally be appropriated as a trade-mark. When we come to look at the brands or contents of the labels, they are entirely different. The label of

the plaintiff on one side of the package is "Sapolio for cleaning and polishing, manufactured by Enoch Morgan's Sons' Co., 440 West Street, New York," and on the other side, "Enoch Morgan's Sons' Sapolio," with a well drawn figure of a human face opposite a pan, and reflected in it.

The label of the defendants does not bear the slightest resemblance to this, except that it is blue paper, with gilt lettering; it is different in shape, and the wording is on one side in large letters, "Troxell's Pride of the Kitchen Soap," the words "Scouring & Polishing" being printed at the bottom in small letters. On the other side is printed in large letters, "Pride of the Kitchen Soap" under which are six lines in small letters describing its uses. The only mark upon the defendants' package which presents even an idea similar to that of the plaintiff, is a very small figure of a monkey, setting down, tail in the air, and looking at something which he holds in his hand, which may be supposed to be a mirror, or pan, or some bright article, but so diminutive as not to be at all conspicuous, and entirely different in appearance from the distinct and well-drawn figure printed on the plaintiff's label, and on each side of the monkey is the word "Trade-Mark," in very small letters. The dissimilarity in these figures is much greater even than that of the hogs in *Popham v. Cole*, (66 N. Y., 74; 23 Am. Rep. 22).

2. The mere idea represented by some figure on an article sold for polishing purposes, that it will make things bright enough to be used as mirrors, cannot be appropriated in a trade-mark. The figure by which that idea is sought to be conveyed may perhaps be adopted, but in this case there is no similarity whatever in the figures.

3. If, as we think, there was no imitation of any trade-mark of the plaintiff, the judgment cannot be sustained on the ground of fraudulent representations, or devices on the part of the defendants to palm off their goods upon individuals as the goods of the plaintiff. What remedy there is for such a wrong, if proved, it is not necessary now to inquire.

4. But the remedy clearly is not to restrain the defendants from selling their own goods in packages and with labels which they

have a legal right to use, and which do not infringe upon any trade-mark of the plaintiff.

The judgment should be reversed, and a new trial ordered, costs to abide the event.

Judgment reversed.

All concur, except MILLER and TRACY, JJ., absent.

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CIRCUIT COURT UNITED STATES, NORTHERN
DISTRICT OF NEW YORK. IN EQUITY.

SHAW STOCKING CO.

vs.

MACK, AND ANOTHER.

DECIDED JUNE, 1882.

REPORTED 12 FEDERAL REP., 707.

“Shawknit 830” Case.

1. TRADE-MARK DEFINED—OBJECT AND PURPOSES OF.—A trade-mark is a mark by which the wares of the owner are known in trade; its objects being—*First*, to protect the party using it from competition with inferior manufacturers; and, *second*, to protect the public from imposition.
2. SAME—OF WHAT MAY CONSIST.—The trade-mark may consist of a token, letter, sign, or seal. Names, ciphers, monograms, pictures, and figures may be used, and numerals united.
3. SAME—NUMERALS—INFRINGEMENT.—Where numerals constituted one of the most prominent features in plaintiff's design, and the same numerals were used in a similar design by defendants, such use, when adopted to designate the same kind of articles, is calculated to aid in deceiving the public, and is an infringement of plaintiff's trade-mark.

4. SAME—SIMILITUDE.—It is enough that such similitude exists as would lead an ordinary purchaser to suppose that he was buying the genuine article and not the imitation; and it is not necessary that the resemblance should be such as would mislead an expert, or such as would not be easily detected if the original and spurious were seen together.
5. SAME—RIGHT TO USE OF TRADE-MARK.—The right to a trade-mark is a right depending on use; and where complainant had used certain numerals long enough to convey to any one versed in the nomenclature of the trade a precise understanding of what goods were intended, when such numerals were used alone, disconnected from any extrinsic information, its right to their exclusive use as a trade-mark must be upheld.
6. SAME—PROTECTION BY INJUNCTION.—An injunction will be granted to restrain the defendants from using the numerals appropriated by plaintiff, to designate the same kind of goods sold by the defendants and not made by the plaintiff, and from using on their labels a word printed in script, with a flourish underneath, in imitation of a word used by the plaintiff on its labels.

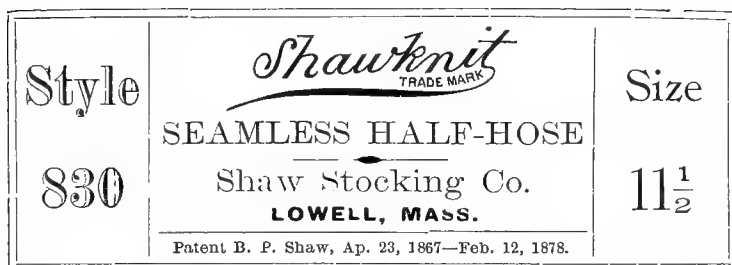
Miller & Fincke, for complainant. *John L. S. Roberts*, of counsel.

Thomas Wilkinson, for defendants. *E. Countryman*, of counsel.

COXE, D. J.:

The Shaw Stocking Company is alleged to be a corporation engaged in the manufacture and sale of hosiery at Lowell, Massachusetts. Its goods differ in some important respects from the productions of other manufacturers, and have by virtue of their inherent worth acquired a wide-spread reputation and popularity. The complainant, with perhaps a pardonable assurance, insists that these goods possess many excellent and novel qualities and characteristics hitherto unknown or unapplied. 'It is not disputed, however, that in some respects the assertion is well founded. The defendants apparently entertained a very high opinion of the complainant's hosiery, for as late as April 19, 1882, they wrote as follows: "Now, since you have determined you will not give us further supplies, * * * we do not care to continue our hosiery trade at all. * * * We want the best make or none," etc.

Upon the question of quality, it is sufficient to say that no one of the affiants produced by the defendants alleges that there are goods in the market superior to the complainant's. Some are said to be equal, none superior. For a period of two years, complainant's hosiery has been packed and sold in boxes, to which were attached labels in the following form:



The central compartment of the label was the same in every instance, without reference to the contents of the boxes. The figures at either end differed according to the style and size of the hosiery, the numerals "830" having long been used by complainant to designate seamless half-hose of a mottled drab color manufactured by it. Half-hose of this particular variety had been advertised by these numerals, were known to the trade as "830's," and as such had become popular as the wares of complainant.

In May, 1881, complainant commenced selling to the defendants' firm at Albany, large quantities of its goods. At the request and solicitation of defendants, complainant sent them several thousand circulars or price-lists, signed by the Shaw Stocking Company, and containing the announcement that the wares manufactured by that company and described in the circular could be obtained of "Mack & Co.," who would supply them to buyers at the prices indicated. These circulars were sent by the defendants extensively to their customers throughout the State, it being generally understood that the "Shawknit" goods could be obtained as favorably at Albany as at Lowell. The statements

contained in the circular, emanating as it did directly from the company, taken in connection with the fact that the defendants advertised themselves on their bill-heads as "manufacturers' agents," caused it to be commonly supposed that Mack & Co. were the New York agents of the complainant, or at least conveyed information from which such an inference could reasonably and properly be drawn by the commercial world. In March, 1882, the defendants having maintained this connection with the complainant for nearly a year, and having a large quantity of its hosiery undisposed of, commenced putting up and selling, without previous notice, other goods, similar in color and texture, but inferior in many respects to its productions, as complainant insists, and lighter in weight and cheaper in price, as defendants admit. These goods were sold under labels like the following:



The wares so labeled and sold were not manufactured by the defendants, but were purchased of stocking makers at Birmingham, Connecticut, the labels on the boxes being removed by the defendants and the above labels substituted, not only on the Birmingham, but also on the "Shawknit" boxes.

Defendants' own account of their action in this regard, and of the motives which prompted it, is stated under date of April 11, 1882, in the following words:

"This state of affairs (*viz.*, the alleged withdrawal of styles by the complainant) was the first incentive to using Birmingham hose, and our idea was to work the two makes together in such a way as to save us from loss on yours, which were the higher cost, and

at the same time in such a manner that any variations from your regular prices would not reflect on you, or become detrimental to your interests in any manner, and, at the same time, enable us, on an average cost, to make something; and consequently we had our labels printed and our own bands, putting them on all,—your make and Birmingham both,—making no claim as to any particular or distinctive manufacture, only retaining in the label the number adopted by you to distinguish style," etc.

The letter was written after notice of complainant's grievance, and it is fair to assume that it contained as favorable a presentation of defendants' case, and their motives and intentions, as at that time suggested itself to the mind of the letter-writer.

The foregoing facts are in their essential features undisputed.

The complainant also produced affidavits tending to show that many dealers had been deceived by the defendants' labels; that "Shawknit" goods had been ordered and paid for as such, and the Birmingham goods supplied by defendants in response to such orders; that defendants' agents sold by "Shawknit" samples, but the orders were not filled with "Shawknit" goods.

The defendants deny that they have been guilty of any attempt to deceive the public, and offer an explanation of the various occurrences relied on by the complainant to establish a fraudulent intent. They also produce a number of affidavits intended to establish two or three leading propositions, viz.. That the Birmingham is not inferior to the "Shawknit" hosiery; that the numerals used by complainant are intended simply and solely to designate the quality and style of its goods, and not for the purpose of indicating their origin or identifying their makers; that the two labels are so dissimilar that no one, exercising ordinary care, would be misled.

Defendants also produce an affidavit made by one of their agents, in which the affiant states that on the first day of June, 1882, he visited the City of New York, and in five stores there, found seamless half-hose made by different manufacturers, the quality being distinguished by the numerals "830." He fails, however, to give the name of any of the manufacturers, the date

when the figures were first used, or any *data* upon which the complainant could base an investigation.

The question to which the attention of counsel was chiefly devoted on the argument, was whether the complainant had an exclusive right to number "830" to designate and distinguish its hose of a particular variety.

1. Broadly defined, a trade-mark is a mark by which the wares of the owner are known in trade. Its object is two-fold: *First*, to protect the party using it from competition with inferior articles; and *Second*, to protect the public from imposition. There is hardly a limit to the devices that may be thus employed; the whole material universe is open to the enterprising merchant or manufacturer. Anything which can serve to distinguish one man's productions from those of another may be used. The trade-mark brands the goods as genuine, just as the signature to a letter stamps it as authentic.

2. The trade-mark may consist of a token, letter, sign, or seal. Names, ciphers, monograms, pictures, and figures may be used. Why not numerals united? What consistency is there in allowing it in a combination of letters, but denying it in a combination of figures?

A careful examination of the authorities cited by the learned counsel for the defendants leads to the conclusion that where the Courts have refused protection to alleged trade-marks composed of letters or numerals, it has been because on the facts of each case, it was determined that the figures or letters were intended solely to indicate quality, etc., and not because figures and letters in arbitrary combination are incapable of being used as trade-marks. It is very clear that no manufacturer would have the right exclusively to appropriate the figures 1, 2, 3, and 4, or the letters A, B, C, and D, to distinguish the first, second, third and fourth quality of his goods, respectively. Why? Because the general signification and common use of these letters and figures are such, that no man is permitted to assign a personal and private meaning to that which has by long usage and universal acceptance acquired a public and generic meaning. It is equally clear, however, that if for a long period of time he had used the same figures in combination, as "3214," to distinguish his own goods from

those of others, so that the public had come to know them by these numerals; he would be protected. The Courts of last resort in Connecticut, in Massachusetts, and New York have distinctly held that doctrine. *Boardman v. Meriden B. Co.*, 35 Conn., 402; *Lawrence Co. v. Lowell Mills*, 129 Mass., 325; and *Gillott v. Esterbrook*, 48 N. Y., 374,—the numerals sustained being respectively “2340,” “523,” and “303.” The defendants concede this, but insist that the case of *Manufacturing Co. v. Trainer*, 101 U. S., 51, affirms a contrary doctrine, and that it should be controlling. Undoubtedly the decisions of the Supreme Court should be followed, but I do not understand the doctrine enunciated by the Court in this case as conflicting with the general principle contended for by the complainant. The case appears to have been decided upon the theory that the letters “A, C, A” were simply used to denote quality and not origin, and turned mainly upon the question of fact as to whether or not they were so used. Upon this question the Court was divided. Mr. Justice Field, who delivered the prevailing opinion says, at page 54: “The object of the trade-mark is to indicate, either by its own meaning or by association, the origin or ownership of the article to which it is applied.” And at page 55: “It is clear from the history of the adoption of the letters ‘A, C, A,’ as narrated by the complainant, and the device within which they were used, that they were only designated to represent the highest quality of ticking which is manufactured by the complainant, *and not its origin*,”—hence, Mr. Justice Field’s decision. Mr. Justice Clifford, in an able opinion, dissented, and directly antagonizing the foregoing interpretation of the evidence, says, at page 59: “Attempt is made in argument to show that the symbol of the complainants was not adopted by them for any other purpose than to designate the grade or quality of the fabric which they manufacture and sell in the market; but it is a sufficient answer to that proposition to say that it is *wholly unsupported by evidence, and is decisively overthrown by the proof introduced by the complainants*;—hence, Mr. Justice Clifford’s dissent. Had the evidence been understood by the two Justices alike, there is no reason to believe that there would have been any disagreement as to the law.

Subsequent to the decision of the Supreme Court in the *Trainer Case*, and with full knowledge thereof, the case of the *Lawrence Co. v. Lowell Mills, supra*, was decided by the Supreme Court of Massachusetts. There is a striking resemblance between that case and the case at bar. Rarely is there such a similarity between the facts of two cases wholly separate and distinct. The trade-mark in the Massachusetts case consisted of an eagle surmounting a wreath formed of the branches of the cotton plant. Inside the wreath, and printed in a circle, were the words "Lawrence Manufacturing Company;" underneath it the word "trade-mark;" and below all the figures "523." As in the case at bar the word "trade-mark" does not appear to have had any connection with the numerals. It was attached and connected with the vignette. The figures were below and separated from it. This device had been used to designate hosiery of a certain grade for many years, and was known and recognized as indicating that the goods so marked were of the plaintiff's manufacture. Other numerals, and in fact another device, had, prior thereto, been used to indicate the same grade of hosiery. The wreath and eagle, without the figures "523," or any figures, had also been used on other grades of goods. Defendants' device was an eagle surmounting a double circle or garter, on which were the printed words "extra-finish iron frame," and beneath were the figures "523" in the same relative position. The eagle and garter were used by defendant before the eagle and wreath were used by plaintiff, and plaintiff made no claim to them disconnected from the figures. The Court, after referring to and considering the *Trainer Case* and other cases, proceeds to say:

"These considerations would be decisive, if the plaintiff here claimed the exclusive right to the numerals "523," when used only to indicate the quality, and not with reference to the origin, of the goods. But such is not the plaintiff's position. Its claim is that the purpose of using these figures in connection with the other parts of its trade-mark was to aid the buyer in distinguishing its goods from similar goods made and sold by others."

3. This is precisely the position of the complainant here, and could hardly have been stated more tersely. In that case the

goods were known and described as "523's;" in this as "830's." Again the Court says:

"The defendant's imitation was produced by using the same figures, printed in the same style, and placed as to the other parts of the device in the same relative position as the plaintiff's. These numerals constituted one of the most prominent features in the plaintiff's design, and, when used in connection with the rest of defendant's mark were calculated to aid in deceiving the public.

4. "It is not necessary that the resemblance produced should be such as would mislead an expert, nor such as would not be easily detected if the original and the spurious were seen together. It is enough that such similitude exists as would lead an ordinary purchaser to suppose that he was buying the genuine article and not an imitation."

I understand this case as holding distinctly that a party who has adopted an arbitrary combination of figures to designate his wares, and to distinguish them from the productions of others, is entitled to protection in the use of those figures. I am unable to see any difference in principle between it and the case at bar, as the latest adjudication directly upon this subject, I think it should be controlling.

That the facts in the case at bar bring it directly within the doctrine declared in the Massachusetts case, I have no doubt. The complainant, through its officers, explicitly states that the figures were adopted to distinguish its wares from those of other manufacturers, and it is difficult to perceive why such a number, "830," was chosen, unless some such object was in view. If the design had simply been what the defendants insist it was, the figures 1, 2, and 3, etc., would have suggested a more convenient and less perplexing method than the one actually adopted.

It was the intention of the complainant to have its goods known in the market by these numerals; they were, in reality, so known. Not only is the fact sworn to in the complaint, but it is admitted in the answer at folio 22; the allegation being in the following language:

"And these defendants, further answering, severally say that they have been informed, and believe it to be true, and therefore

admit, that such 'Shawknit' seamless half-hose of a mottled-drab color have been more generally known, called, and spoken of as '830's' by dealers in hosiery than by any other name, and that under that designation such hose have sometimes been ordered, purchased, and sold."

A very persuasive piece of evidence is found in an order produced by defendants, forwarded to them by their agent, in which these goods are described simply as "830, 2 doz.," and in a bill, also produced by defendants, the same goods are charged to one of their customers as "2 doz. hose, 830, 2.40, \$4.80."

5. The right to use a trade-mark is one depending upon use, and it appears that complainant had used these numerals long enough to convey to any one versed in the nomenclature of the trade a precise understanding of what goods were intended when the numerals were used alone, disconnected from any extrinsic information.

I must hold, then, that the complainant has a right to the exclusive use on its labels of the numerals "830" as applied to hosiery of a mottled-drab color. Regarding the word "Shawknit," printed in script letters, there is no denial of complainant's exclusive right.

The question that now remains to be considered is whether or not the defendants have infringed and invaded the rights and privileges of the complainant in such a manner as to call for interference of a Court of Equity. The intimate relations which existed between complainant and defendants warrant the assumption on the part of the business community that the defendants were the agents of the Shaw Company, and could furnish the wares of that company upon terms as advantageous in every respect as the company itself. A merchant ordering "Shawknit" goods, or "830's" from the Macks, would be less likely to scrutinize them with care, and more likely to accept them without thorough inspection, than if the same goods had been ordered from some irresponsible house. The seal of genuineness had been set on the goods furnished by Mack & Co., by the indorsement which the complainant had given them. Suspicion was disarmed, confidence invited.

In these circumstances the defendants, having on hand a large stock of the complainant's hosiery, purchased goods cheaper, and certainly not superior, from a rival manufacturer, removed the maker's labels from both, and substituted therefor the label originated by themselves. They must have had some motive in doing this. What was it? The explanation in the letter of April 11th, that they wanted to find a substitute for complainant's retired stock, is hardly satisfactory, so far as the goods involved in this action are concerned, for in the last price list issued by complainant April 7, 1882, is found "830, mottled-drab, 2.40" still in stock. If the defendants intended to derive no benefit from the known reputation of the "Shawknit" goods—if they intended to sell the Birmingham goods solely on their merits—why would not some other number than 830 have suited them as well?

As is said by Judge Lowell in *Rogers v. Rogers*, 11 *Fed. Rep.*, 495: "The reason that artificial trade-marks are absolutely protected, without inquiry into motives, etc., is that the defendant has no natural right to such a symbol, and has the world of nature from which to choose his own." Is it not clear that defendants, occupying the relation they did to the complainant, by using the number "830" in connection with the word "seamless" placed in the same relative position, printed in the same script, and with the identical flourish as the word "Shawknit," are in a position where, even though intending no wrong, their acts may work injury to the complainant? Are they not within the prohibition of the law, stated in such homely but vigorous language in *Levy v. Walker*, L. R., 10 *Ch. D.*, 447.

"It should never be forgotten in these cases, that the sole right to restrain anybody from using any name that he likes in the course of any business he chooses to carry on, is a right in the nature of a trade-mark, that is to say, a man has a right to say, 'You must not use a name, whether fictitious or real—you must not use a description, whether true or not, which is intended to represent, or calculated to represent to the world, that your business is my business, and so, by fraudulent misstatement, deprive me of the profits of the business which would otherwise come to me.'"

It is well settled that one man has no right to sell his goods as those of another. Whether the converse of this proposition is also true—that a man has no right to sell another's goods as his own—it is unnecessary to decide in this case, as the question has not been discussed; and yet, according to defendants' version of the transaction, complainant's hosiery was sold by them as their own. It seems to me, that, irrespective of the question relating to the technical infringement of complainant's trade-mark, the defendants are in a position where they have gained, or may gain, an unlawful advantage in trade by means of a simulated label. It is hardly necessary to cite authorities where the Courts have interfered for the protection of the injured in such cases.

In *Fleischmann v. Schuckmann*, 62 *How. Pr.*, 92, the defendant was restrained from using the word "Vienna," as applied to bread, because the plaintiff has built up a business by so using it.

In *Hier v. Abrahams*, 82 *N. Y.*, 519, defendants, using the words "Pride of Syracuse," were enjoined, the plaintiff using the words "Hier and Aldrich's Pride."

Also the following: *Knott v. Morgan*, 2 *Keene*, 213; *Edelston v. Edelston*, 1 *DeG., J. & S.*, 185; *Colman v. Crump*, 70 *N. Y.*, 573; *Williams v. Spence*, 25 *How. Pr.*, 367.

I am therefore compelled to say, after carefully examining the evidence, and the elaborate briefs submitted, that in my judgment, there is such a simulation as will probably deceive the complainant's customers. Great damage might result to the complainant by the continuance of defendants' label. I fail to see, however, how the defendants can be materially injured by its disuse. They are not manufacturers of hosiery, but are simply selling the productions of others. What legitimate profits can they lose by selling the goods as they come from the manufactory with the original labels attached?

6. I think an injunction should issue restraining the defendants from using the numerals "830" to designate mottled-drab hose not made by complainant, and from using on their labels the the word "seamless" printed in script, with the flourish underneath, in imitation of the word "Shawknit," as used by complainant.

Motion granted.

See *Burton v. Stratton*, *ante* 696, and *note*.

NOTE BY ROBERT DISTY, EDITOR OF FEDERAL REPORTER, 1882.

TRADE-MARK.—A trade-mark may consist of anything—marks, forms, words, signs, symbols, or devices—designating origin or ownership, but not anything merely denoting name or quality; (*Godillot v. Hazard*, 49 *How. Pr.*, 5; *Ferguson v. Davol Mills*, 2 *Brewst.*, 314); and a manufacturer may by priority of appropriation acquire a property therein as a trade-mark. (*Stokes v. Landgraff*, 17 *Barb.*, 608; *Robertson v. Berry*, 50 *Md.*, 591; *Trade-Mark Cases*, 100 *U. S.*, 82). All the essential requisites to the right of production of law arises from prior use of the device which has created a celebrity or value for the article; (*Messerole v. Tynberg*, 36 *How. Pr.*, 141); and the mark or device should be annexed to or stamped, printed, carved, or engraved upon the article, (*St. Louis Piano Manuf'g Co. v. Merckell*, 1 *Mo. App.*, 305); and when stamped upon the articles manufactured by him he is entitled to its exclusive use. (*Taylor v. Carpenter*, 11 *Paine*, 292). It must be such a mark as will identify the article to which it is affixed. (*Phalon v. Wright*, 5 *Phila.*, 464). So, the omission to put the advertising name “Moline plow” on their plows divests the company of its exclusive right to the use of “Moline.” (*Candee v. Deere*, 54 *Ill.*, 439).

One may appropriate an arbitrary number as a valid trade-mark, although not using it in connection with any word signifying ownership. (*Collins v. Reynolds' Card Manuf'g Co.*, 7 *Abb. N. C.*, 17; *India Rubber Co. v. Rubber, etc. Co.*, 45 *N. Y. Super.*, 258; *Lawrence Manuf'g Co. v. Lowell H. Co.*, 129 *Mass.*, 125). Letters or figures affixed to merchandise for the purpose of denoting its quality only can be appropriated; (*Amoskeag Manuf'g Co. v. Trainer*, 101 *U. S.*, 51; *Sohl v. Geisendorf*, 1 *Wills. (Ind.)*, 60); but the words on labels “established 1780,” which had been long used, were held entitled to protection. (*Hazard v. Caswell*, 57 *How. Pr.*, 1). So injunction was granted

to restrain the use of the trade-mark "The * Shirt," (*Morrison v. Case*, 9 *Blatchf.*, 548); or the symbol $\frac{1}{2}$ printed in a special or unusual manner, (*Kinney v. Allen*, 1 *Hughes*, 106); or numerals associated with words, as "303" with words "Joseph Gillott, extra fine." (*Gillott v. Esterbrook*, 48 *N. Y.*, 374; 47 *Barb.*, 455; *Same v. Kettle*, 3 *Duer*, 624). A street number may be appropriated by one who has exclusive use of the building. (*Glen, etc. Co. v. Hall*, 6 *Lans.*, 258). But the use of IXL as a sign was refused protection. (*Lichtenstein v. Mellis*, 8 *Or.*, 464).

SIMILITUDE.—Putting up goods with an infringing mark, will render the party so doing liable, (*Sawyer v. Kellogg*, 13 *Rep.*, 196), as the use of similar packages with the same words and figures embossed thereon. (*Frese v. Bachof*, 14 *Blanchf.*, 432). The peculiar style of the package in which the article is put up, and the combination constituting the label, is protected; (*Cook v. Starkweather*, 13 *Abb. Pr.*, 393; *Lea v. Wolf*, *Id.*, 391); as the use of a barrel with a red rim and glazed head; with the letters AAA and a Maltese cross. (*Cook v. Starkweather*, 13 *Abb. Pr.*, 392). Any labels, devices, or hand-bills calculated to deceive the public into the belief that the article is the same as that made and sold by the plaintiff is an infringement. (*Williams v. Spence*, 25 *How. Pr.*, 366). In all cases the essence of the wrong consists in the sale of the goods of one person as those of another, (*Amoskeag Manuf'g Co. v. Spear*, 2 *Sandf.*, 599; *Samuel v. Berger*, 4 *Abb. Pr.*, 88); and the true inquiry is whether the marks or symbols actually deceive the public. (*Blackwell v. Wright*, 73 *N. C.*, 10). Simulated labels, marks, *indicia*, or advertisements such as would ordinarily deceive customers, will be enjoined; (*Talcott v. Moore*, 13 *N. Y. Super.*, 106); or where the imitation would have the effect to pass the goods as those of another with any one but the most cautious; (*Brooklyn White L. Co. v. Masury*, 25 *Barb.*, 416); or where the resemblance would raise the probability of mistake on the part of the public. (*McCartney v. Garnhart*, 45 *Mo.*, 593). The words, letters, figures, lines and devices on a label must be so similar, that any person with such reasonable observation as the public generally are capable of, would mistake the goods for those of the other.

(*Gilman v. Hunnewell*, 122 Mass., 139). The imitation need not be exact and complete; (*Hostetter v. Vowinkle*, 1 Dill, 329; *Filley v. Fassett*, 44 Mo., 168); it is sufficient if it is likely to deceive or mislead; (*Filley v. Fassett*, 44 Mo., 168; *Hostetter v. Vowinkle*, 1 Dill, 329; *Robertson v. Berry*, 50 Md., 591; *Leidersdorf v. Flint*, 50 Wis., 401), an ordinary purchaser. (*Lockwood v. Bostwick*, 2 Daly, 521). The resemblances must amount to a false representation liable to deceive, (*Popham v. Cole*, 66 N. Y., 69; *Osgood v. Allen*, 1 Holmes, 185). The intent to deceive is sufficient. (*McLean v. Fleming*, 96 U. S., 245), or if it is so close that a crafty vendor may palm off on the buyer the article manufactured as that of the other. (*Brown v. Mercer*, 37 N. Y. Super., 265). If the general effect is to mislead an ordinary person it is sufficient, (*Hostetter v. Adams*, 10 Fed. Rep., 838), or if calculated to mislead the public, though the distinction between the imitation and the original, would at once be seen, on a slight or casual examination. (*Popham v. Wilcox*, 14 Abb. Pr., (N. S.), 206). If it is a colorable representation of plaintiff's label, calculated to produce in the mind of the purchaser the impression that the goods were manufactured or sold by the person whose trade-mark was imitated, it is sufficient. (*Burke v. Cassin*, 45 Cal., 567). A colorable imitation will be enjoined where it requires careful inspection to distinguish it from the original, (*Partridge v. Menick*, 2 Sandf. Ch., 622), and a substantial similarity is sufficient; (*Bradley v. Norton*, 33 Conn., 157); or where the difference would not be noticed when seen at different times and places. (*Sohl v. Geisendorf*, 1 Wils. (Ind.), 60). An imitation with partial differences, such as the public would not observe, (*Clark v. Clark*, 25 Barb., 76), or which would not be perceived without strict examination, will not protect it from injunction, (*Williams v. Johnson*, 2 Bosw., 1), and should be disregarded; (*Laird v. Wilder*, 9 Bush, 131); but if the alleged imitation has not deceived an ordinary purchaser an injunction will not be granted. (*Hurricane Lantern Co. v. Miller*, 56 How. Pr., 234). Where the name of the imitator was substituted in a label, and the imitation in other respects not exact, yet so great that a purchaser, who did not read the name, might be deceived,

it is a violation of the trade-mark. (*Boardman v. Meriden Brit. Co.*, 35 *Conn.*, 402). So the use of the word "Apollinis" on a label, in connection with a representation of a bow and arrow or anchor was restrained on account of similarity to the word "Apollinaris," with the representation of an anchor. (*Apollinaris Brunnen v. Somborn*, 14 *Blatchf.*, 380). An article of the same kind, called "Saphia," put up in similar wrappers as the article called "Sapolio," the imitation being intended to deceive, should be restrained. (*Enoch Morgan's Sons' Co. v. Schwachofer*, 5 *Abb. N. C.*, 265. See *Same v. Troxell*, 57 *How. Pr.*, 121). A trade-mark, "The Rising Sun," with a vignette of the sun, is not infringed by the words "Rising Moon," with a vignette of the moon. (*Morse v. Worrell*, 10 *Phila.*, 168).

PROTECTION OF RIGHT.—The doctrine of protection of trade-marks is based upon the broad principle of protecting the public from deceit; (*Matsell v. Flanagan*, 2 *Abb. Pr.*, (*N. S.*), 459); an injunction will be granted to restrain its practical use; (*Rowley v. Houghton*, 7 *Phila.*, 39); but to authorize an injunction, plaintiff's title to its exclusive use should be clear and unquestionable, (*Ellis v. Zellin*, 42 *Ga.*, 91), and be clearly established. (*Wolfe v. Goulard*, 18 *How. Pr.*, 64; *Corwin v. Daly*, 7 *Bosw.*, 222; *Coffeen v. Brunton*, 5 *McLean*, 256). The legal right of plaintiff and violation by defendant must be clear. (*Merrimack Manuf'g Co. v. Garner*, 2 *Abb. Pr.*, 318; *Fetridge v. Merchant*, 4 *Abb. Pr.*, 156; *Samuel v. Berger*, *Id.*, 88; *Partridge v. Menck*, 2 *Barb. Ch.*, 101). A person having appropriated to himself a particular label, sign or trade-mark is entitled to the protection thereof, and the Courts will enjoin their use without authority, (*Collady v. Baird*, 4 *Phila.*, 139; *Coates v. Holbrook*, 2 *Sandf. Ch.*, 586; *Taylor v. Carpenter*, *Id.*, 603), unless he has acquiesced in its use by third party. (*Delaware, etc. Canal Co. v. Clark*, 7 *Blatchf.*, 112; *Caswell v. Davis*, 58 *N. Y.*, 223; *Filley v. Child*, 16 *Blatchf.*, 376; *McLean v. Fleming*, 96 *U. S.*, 245). If the representation of the trade-mark does not mislead the public, and is substantially true, it will be entitled to protection. (*Meriden Brit. Co. v. Parker*, 39 *Conn.*, 450). A party may be restrained from the use of his own name in business, if he uses

it for the purpose of deception; (*Decker v. Decker*, 52 *How. Pr.*, 218; *Consult Benninger v. Wattles*, 28 *How. Pr.*, 286; *Holloway v. Holloway*, 13 *Beav.*, 209; *Clark v. Clark*, 25 *Barb.*, 76; *Stonebraker v. Stonebraker*, 33 *Md.*, 252; *Devlin v. Devlin*, 67 *Barb.*, 290; *Rogers v. Nowill*, 6 *Hare*, 325; *Holmes v. Holmes*, 37 *Conn.*, 278; *Comstock v. White*, 18 *How. Pr.*, 421; *Faber v. Faber*, 49 *Barb.*, 357; *McLean v. Fleming*, 96 *U. S.*, 246; *Probasco v. Boyon*, 1 *Mo. Appeal*, 241), or so as to appropriate the good-will of a business established by others of that name. (*William Rogers Manuf'g Co. v. Rogers, etc. Co.* 11 *Fed. Rep.*, 495. See *Gillis v. Hall*, 7 *Phila.*, 422; *Ainsworth v. Bentley*, 14 *Week. Rep.*, 630).

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SUPREME COURT OF ERRORS, NEW HAVEN
COUNTY, CONNECTICUT. IN EQUITY.

JOHN A. WILLIAMS, AND OTHERS,*vs.*

GEORGE A. BROOKS, AND ANOTHER.

DECIDED JUNE, 1882.

REPORTED 50 CONN., 278.

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“Tayler’s Hair-Pins” Case.

1. The plaintiffs were partners under the name of “D. F. Tayler & Co.,” and for several years had manufactured and sold hair-pins, which were well known and had a ready sale as “Tayler’s Hair-Pins” and “D. F. Tayler & Co’s Hair-Pins,” the device on the packages, which were put up in pink and yellow wrappers, being used exclusively by them and being well known to the trade. The defendants were also engaged in the manufacture and sale of hair-pins, and had procured from one L. B. Taylor, the right to mark their packages “L. B. Taylor & Co.,” to which was added the words “Cheshire, Conn.” In a suit for an injunction against the use of their device, it was found that “the size and color of the labels and wrappers, and the device printed thereon used by them, resembled the plaintiffs’ labels, wrappers and devices thereon, to such a degree that they were liable to deceive careless and

unwary purchasers who buy such goods with but little examination, but that purchasers who read the entire trade-mark and label could not be deceived. It was further found that the defendants adopted the label and device in good faith and in the belief that they were not infringing the plaintiffs' rights. **HELD:**

That an injunction should be granted. (One Judge dissenting.)

2. And that the injunction should be "against such a use by the defendants of the name of 'S. B. Taylor & Co.,' in connection with any device upon pink or yellow wrappers, inclosing hair-pins of their manufacture, as that the combination would be liable to lead purchasers to believe that hair-pins manufactured by them were manufactured by the plaintiffs.
3. The defendants were not excused for the use of the label and device, by the fact that they acted in good faith, and believed that they were not infringing the rights of the plaintiffs. The injury to the plaintiffs remained the same:
4. The purpose to be effected by an injunction in such a case, is not primarily to protect the purchaser, but to secure to the manufacturer the profit to be derived from the sale of his goods to all who may desire and intend to purchase them.
5. And **HELD** that, for the purpose of proving the defendants' packages with their labels so closely resembled those of the plaintiffs as to mislead an ordinary purchaser, wholesale dealers in hair-pins might testify as experts.

SUIT for an injunction against the use of a trade-mark and for an account and payment of profits; brought to the Superior Court. Facts found by a committee, and case reserved, upon the report and a remonstrance against its acceptance, for the advice of this Court. The case is fully stated in the opinion.

C. R. Ingersoll, and *H. E. Pardee*, for the plaintiffs.

H. Stoddart, and *H. L. Hotchkiss*, for the defendants.

PARDEE, J.:

1. The plaintiffs are now, and for ten years last past have been, partners under the name and firm of D. F. Tayler & Co., at Birmingham, England, manufacturing among other articles hair-pins of different sizes and qualities, some of them known as "best

double japanned," "plain," and "curvilinear;" these were gathered into ounce packages, the curvilinear in pink, the plain in yellow paper; these were made into pound packages; these last into packages weighing six, twelve, and eighteen pounds, wrapped in brown or drab paper, and in this last form were brought into the United States, where by reason of their superior quality they had a good reputation and ready sale under the name of "Tayler's Hair-pins," "Tayler's Plain Hair-pins," and "D. F. Tayler & Co's Hair-pins."

The device or trade-mark printed upon the wrapper of each ounce package has been used exclusively by the plaintiffs during the past ten years upon their pins sold in the United States, and has become, and is, in combination with the pink and yellow wrappers, well known to the trade. The device upon each ounce package can be seen only in part when these are gathered into pound packages.

1. Since 1879 the defendants have manufactured, put up, and sold in the United States, curvilinear and plain hair-pins in ounce packages; the former in pink and the latter in yellow wrappers, upon which there is the printed statement that the hair-pins were manufactured by L. B. Taylor & Co., Cheshire, Connecticut, and the finding is that "the size and color of the labels and wrappers and the trade-mark or device printed thereon on the ounce packages used by the defendants * * * resemble the plaintiffs' labels, wrappers and devices thereon used on ounce packages * * * to such a degree that they are liable to deceive careless and unwary purchasers, who buy such goods hastily and with but little examination; but purchasers who read the entire trade-mark and label on the defendants' goods cannot be deceived, nor mistake the defendants' goods for the plaintiffs'." The defendants used their label with full knowledge of the plaintiffs' trade-mark and of the reputation of their hair-pins in the United States.

All manufacturers of hair-pins put them in ounce packages, combining the ounce into pound, and the pound into packages of six or more pounds; and many inclose the ounce packages in pink and yellow paper.

Generally, the defendants sold their hair-pins to jobbers in six pound packages or more, rarely retaining them in ounce packages. Nothing in the appearance of the six pound packages would mislead jobbers or wholesale dealers as to the place of manufacture.

The defendants have always sold their pins as of domestic manufacture, and for a less price than that obtained by the plaintiffs; and when their ounce packages are looked at separately, the words "Cheshire, Conn." plainly appear; but when these are gathered into pound packages the whole of the printed label is not seen.

In 1869, Levi B. Taylor and his father Milo A. Taylor, were manufacturing hair-pins in Massachusetts as partners under the name of L. B. Taylor & Co., and inclosing ounce packages in wrappers having printed thereon a label substantially like the one of which the plaintiffs now complain. In that year, upon the death of the father, Levi B. Taylor sold the tools, machinery and stock, together with a quantity of these wrappers, with the right to use the same, to the Connecticut Cutlery Company of Naugatuck in this State, and subsequently became president thereof. In 1875, when the defendants began to manufacture hair-pins at Cheshire in this State, Levi B. Taylor closed his connection with the Connecticut Cutlery Company, and became and still continues to be a travelling salesman for them, his remuneration depending upon the amount of sales effected by him; and it was orally agreed between them that they should have the right to use the name of "L. B. Taylor & Co.," upon such hair-pins of full weight as they should manufacture and that he should have the exclusive sale of them. Both parties have observed this contract, and under the authority thus given the defendants placed the name of "L. B. Taylor & Co.," upon packages of hair-pins; the name being printed in imitation of the signature made by L. B. Taylor.

In 1879, the defendants having manufactured and sold hair-pins inclosed in a wrapper upon which was printed a device and a statement that the pins were manufactured by "L. B. Taylor & Co.," and which resembled the one used by the plaintiffs, the latter claimed damages for the injury resulting therefrom to their

business. A compromise was effected, and as part consideration therefor the defendants signed an agreement thereafter to desist from any infringement of the plaintiffs' legal or equitable rights in or to their device within the United States. The committee annexed a copy thereof to his report, marked as exhibit 13.

The device and label complained of were subsequently adopted by the defendants upon the advice of counsel, in good faith, and in the belief that it is not an infringement of the plaintiffs' rights.

Conceding as a general rule to all persons the privilege of selecting the name under which they will transact business, yet the defendants have no right to destroy or diminish the property of plaintiffs in the name of "D. F. Tayler & Co.," and in the device and vignette with which it is connected, applied to the manufacture and sale of hair-pins, by so printing the name of "L. B. Taylor & Co.," not borne by either of them, but purchased solely for use in connection with this particular branch of their business, as part of a device and vignette upon a pink or yellow wrapper inclosing an ounce of hair-pins, as that their entire device shall so closely resemble that of the plaintiffs as to be liable to deceive careless and unwary purchasers, and this regardless of the fact that the defendants believed their manner of use of the name and vignette to be within the law; for the injury to the plaintiffs remains the same.

In *Croft v. Day*, 7 *Beav.*, 84, the Master of the Rolls said (p. 89): "My decision does not depend upon any peculiar or exclusive right the plaintiffs have to use the name of 'Day & Martin,' but upon the fact of the defendants using their name in connection with certain circumstances, and in a manner calculated to mislead the public, and to enable the defendant to obtain, at the expense of Day's estate, a benefit for himself, to which he is not in fair and honest dealing entitled. * * * He has the right to carry on the business of a blacking manufacturer honestly and fairly; he has the right to the use of his own name. I will not do anything to debar him from the use of that or any other name calculated to benefit himself in an honest way; but I must pre-

vent him from using it in such a way as to deceive and defraud the public."

In *Thorley's Cattle Food Co. v. Massam*, 42 *Law Times* (N. S.), 851, Bramwell, L. J., said: "It is said it is hard if a man has the name of Thorley that he cannot make food and call it 'Thorley's Food.' So he may, but if unfortunately for him some preceding Thorley has carried on the business of making cattle food in such a way that by the name 'Thorley's Cattle Food' is understood the manufacture of that man, then the second Thorley, or the man who assumes his name, must take care so to conduct his business that he is not mistaken for the original Thorley, and if he willfully, or even I should say without willfulness, does carry on his business so as to be mistaken, he must be restrained from doing it; and really there is no hardship upon him at all."

In *Holloway v. Holloway*, 13 *Beav.*, 209, the Master of the Rolls said: "The defendant's name being Holloway he has a right to constitute himself a vendor of Holloway's pills and ointment, and I do not intend to say anything tending to abridge any such right. But he has no right to do so with such additions to his own name as to deceive the public and make them believe that he is selling the plaintiff's pills and ointment."

4. The purpose to be effected by this proceeding is not primarily to protect the consumer, but to secure to the plaintiffs the profit to be derived from sale of hair-pins of their manufacture to all who may desire and intend to purchase them. It is a matter of common knowledge that many persons are in a greater or less degree careless and unwary in the matter of purchasing articles for their own use; but their patronage is not for that reason less profitable to the manufacturer; and when such persons have knowledge of the good qualities of the plaintiff's hair-pins and desire to purchase them, the law will not permit the defendants to mislead them.

In *Meriden Britannia Company v. Parker*, 39 *Conn.*, 450, the finding is that the respondent's stamps "resembled the petitioners' trade-mark * * * to such a degree that they are calculated to deceive unwary purchasers and those who buy such goods hastily and with but little examination of the trade-mark, * * * but purchasers who read the entire trade-mark on the respondent's

goods * * * cannot be deceived." The Court said: "The fact that careful buyers are not deceived does not materially affect the question. It only shows that the injury is less, not that there is no injury. Another class of purchasers to whom large quantities have been sold are deceived. Such purchasers, perhaps will have no reason to complain, as they, if they are injured by the deception, must attribute the injury to their own want of diligence. But the petitioners stand on entirely different ground. No amount of diligence on their part will guard against the injury. An injunction is their only adequate remedy; and to that we think they are entitled."

In *Singer v. Wilson*, 3 L. R., *Appeal Cases*, 376, Lord O'Hagan said. "I think we should be cautious in holding that although a person of intelligence and observant habits might, in a case like this, by exercising reasonable vigilance, escape misleading, there should be no restrictive interference to prevent others from being misled. It is a question of degree, of more or less; there can be no rigid rule, and the special facts must be considered in every case. There are multitudes who are ignorant and unwary, and they should be regarded in considering the interest of traders who may be injured by their mistakes. If one man will use a name, the use of which has been validly appropriated by another, he ought to use it under such circumstances and with such sufficient precautions that the reasonable probability of error should be avoided, notwithstanding the want of care and caution which is so commonly exhibited in the course of human affairs."

The defendants insist that the committee erred in receiving their written promise to abstain from any infringement of the plaintiffs' rights in or to their trade-mark. The objection is not well taken. The complaint is that the defendants have willfully disregarded the plaintiffs' rights; it was the privilege of the latter to prove this allegation; and this written promise of the defendants bore directly upon the question of their good faith in the formation and use of their present device; and although this alone, of all items of evidence bearing upon that question introduced on one side and the other, is set forth in connection with the report of the committee, yet, inasmuch as the finding is that the defendants acted in good

faith, we are unable to see that its presence works any injury to them. Indeed neither its presence nor its absence can at all affect the advice to be given to the Superior Court.

5. For the purpose of proving that the defendants' ounce packages of hair-pins so closely resembled those of the plaintiffs as to mislead an ordinary purchaser and consumer, the plaintiffs offered the testimony of several persons, who were or had been wholesale dealers in hair-pins in New York and Philadelphia, as experts. The committee received the evidence, notwithstanding the defendants' objection. We see no error in this.

In *Gorham Company v. White*, 14 *Wallace*, 511, the testimony of die-sinkers, designers, editors of scientific publications, solicitors of patents, and dealers, was received upon the question whether ordinary purchasers would be misled by the similarity between two designs for forks and spoons. And in *In re Worthington Co's Trade-Mark*, 14 *L. R., Chan. Div.*, 8, brewers deposed that in their opinion a proposed trade-mark for ale would be calculated to deceive "as the two marks might, and probably would, be exhibited together in houses where fermented liquors are sold." *Jessel, M. R.*, said: "Now is such a trade-mark intended to deceive, or is it calculated to deceive? I have evidence before me to show that people would be deceived." In the first cited case especially, some of the testimony was from witnesses who are not shown to have ever been dealers in any manner in the articles concerning the appearance of which they expressed an opinion.

The question in the case before us is, does the defendants' trade-mark so closely resemble that of the plaintiffs' that it is liable to deceive purchasers; a matter which is to be determined by the eye, largely by the eye of the trier doubtless. And in view of these authorities we think it may properly be instructed by men who have looked at the packages in question with the interested and careful eye of the dealer.

The trade-mark for injury to which the plaintiffs complain is not theirs by creation, but by purchase, and one of them identifies it by stating the time and place of its origin and the mode of acquisition by themselves. He deposes, partly upon information and partly of knowledge, that it was established by Daniel Foot

Tayler and Henry Shuttleworth, of Gloucestershire, more than thirty-seven years since, and that it passed in 1843 from them to John Alfred Williams and Peter Eddleston and from these last to the plaintiffs. But the finding of the committee is as follows:—“When the firm composed of John Alfred Williams and Peter Eddleston was dissolved does not appear, nor how Peter Eddleston’s interest was transferred to the present firm, if it ever was. Nor does it appear how the interest of Daniel Foot Tayler was transferred to the firm composed of John Alfred Williams and Peter Eddleston, if it ever was.”

In the absence of proof of injury to the plaintiffs in the past and the finding being only that the ounce packages of the defendants “are liable to deceive purchasers,” our advice to the Superior Court will concern the future only.

The Superior Court is advised to pass a decree restraining the defendants from such use of the name of “L. B. Taylor & Co.,” in connection with any device upon pink or yellow wrappers inclosing hair-pins of their manufacture, as that the combination will be liable to lead purchasers to believe that hair-pins manufactured by the defendants were manufactured by the plaintiffs, when, upon a further hearing to be had for that purpose only by said Court, the plaintiffs shall complete the proof of title in themselves to the device and trade-mark claimed in their complaint.

In this opinion PARK, C. J., and LOOMIS, J., concurred.

CARPENTER, J., (dissenting):

I cannot concur in the result to which my brethren may have come. The only ground for an injunction is to prevent the defendants from defrauding the plaintiffs. To justify an injunction it should be reasonably certain that the plaintiffs will be defrauded. There is no intention to defraud, for it is expressly found that the defendants acted in good faith. It is not found that the defendants, in a single instance, or others, have sold the defendants’ goods as the plaintiffs’; and it is not reasonably certain that such will be the result in the future. The only part of the finding which indicates such a result is the following:—“The size and

color of the labels or wrappers and the trade-mark or device printed thereon on the ounce packages used by the defendants as hereinbefore stated, resemble the plaintiffs' labels, wrappers and device thereon used on ounce packages as hereinbefore stated, to such a degree that they are liable to deceive careless and unwary purchasers who buy such goods hastily and with but little examination; but purchasers who read the entire trade-mark and label on the defendants' goods cannot be deceived or mistake the defendants' goods for the plaintiffs'."

It will be observed that the name "Taylor & Co.," as an essential or material feature of the case is carefully executed. Three things only are important—the device, and the size and color of the labels. The plaintiffs claim nothing from the device or trade-mark proper. Hence that may be laid out of the case. In respect to the size the finding is that "in general all hair-pin makers put up their goods in similar sized packages, wrapped around with a paper of the size and shape of exhibit No. 1,"—the plaintiffs' wrapper or label. As to color, it is found that "pink and yellow papers of substantially the same shape and size and shade of the paper used by the plaintiffs in this case are used by other hair-pin manufacturers in putting up their goods for market." How, under this finding, the plaintiffs can have any right superior to that of the defendants, to the use of labels of the size, shape and color of those used by other manufacturers generally, is beyond my comprehension.

But assuming, as I think a majority of the Court must assume, that the imitation consists in the general arrangement and appearance of the labels, including of course the name as an important feature of it, still I contend that the plaintiffs have suffered and are in danger of suffering no legal damage. "Liable to deceive" purchasers. That is not equivalent to finding that they will be deceived, or that the arrangement is calculated to deceive. And it certainly falls far short of showing that it is reasonably certain that they will be deceived. It indicates a possibility but not necessarily a probability. A man is liable to be struck by lightning, but hardly one in a million ever experiences it. If that is objected to as an extreme case, take another illustration. Every man

who travels by railroad or steamboat is liable to be injured by some accident, and yet hardly one in ten thousand is so injured. I use these illustrations for the purpose of showing that a liability ordinarily imports less than a liability.

It will be claimed however that the word as used in this finding is used in a different sense, or at least that it must be interpreted with reference to the subject-matter to which it is applied. That I readily grant; and I concede all that I think can be reasonably claimed, that it shows that there is an even chance that some purchasers will be deceived. What if some few of the many millions of those who use hair-pins are led to purchase the defendants' goods supposing them to be the plaintiffs' ? When we consider that it is only consumers that are liable to be deceived—for it is expressly found that dealers are not—and that each consumer purchases in small quantities, paying therefor a mere trifle, it is obvious that the loss of profits to the plaintiffs from that source will be very small and that it will require large numbers of persons to be thus misled before the loss will be appreciable. The finding fails to show that that will be the result. The loss of profits may and probably will be infinitesimal. Courts of Equity do not grant injunctions for trifling matters. On the other hand the loss may be considerable; but that is uncertain; the Court is called upon to act, not upon facts but upon conjecture. It seems to me much better that the plaintiffs should be required to wait until they can show positively that they will suffer material damage before asking for an injunction.

Again, it is only the careless and unwary that are liable to be deceived. The consumer who knows the plaintiffs' goods and really desires to buy them will be vigilant and know what he buys. He cannot be deceived. The consumer who does not know them, or who has no particular preference for them, will be careless and unwary, or in other words indifferent. No manufacturer has a better right than others to the trade of that class. That is open to legitimate competition; and when a customer is secured by one, so long as there is no fraud actual or constructive and no deception, there can be no injury in a legal sense to another.

I take it that this proposition cannot be controverted, that no injunction can properly issue unless the defendant represents or is about to represent in some manner or by some means that the goods which he makes and sells are the goods of another. When his purpose to do so clearly appears the case is free from difficulty and Courts will protect the injured party in respect to all classes of purchasers. But when, as in this case, the resemblance is not designed, but is incidental, and results solely from the similarity of names in connection with the style and manner of preparing the goods for market, which style and manner are common to all manufacturers, the case is different, and Courts ought to proceed with more caution. This distinction is an important one, and seems to me not to have been considered by the majority of the Court. To cases of the former class the language of the Courts as cited in the majority opinion may well apply. But it cannot be applied indiscriminately to cases of the latter class without danger of doing injustice. There is a rule however applicable to these cases which is well established. I quote from some of the authorities, both English and American:—

In *I. W. Thorley's Cattle Food Co. v. Massam*, 42 *Law Times*, (N. S.), 856, Baggallay, L. J., says:—"Have the company, in offering for sale the article manufactured by them, made representations which were *calculated to induce a reasonable belief* on the part of those to whom the offers were made that the articles were manufactured by Joseph Thorley?"

In *Leather Cloth Co. v. American Leather Cloth Co.*, 11 *House of Lords Cas.*, 535, the Lord Chancellor says: "All which can be done is to ascertain in every case as it occurs whether there is such a resemblance as to deceive a purchaser using ordinary caution." In *McLean v. Fleming*, 96 *U. S. Reps.*, 245, Clifford, J., says: "Colorable imitations which require careful inspection to distinguish the spurious trade-mark from the genuine are sufficient to maintain the issue; but Courts of Equity will not interfere when ordinary attention by the purchaser would enable him at once to discriminate the one from the other. When the similarity is sufficient to convey a false impression to the public mind, and is of a character to mislead and deceive the ordinary purchaser, in

the exercise of ordinary care and caution in such matters, it is sufficient to give the injured party a right of redress if he has been guilty of no laches. What degree of resemblance is necessary to constitute an infringement is incapable of exact definition as applicable to all cases. All that Courts of justice can do in that regard is, to say that no trader can adopt a trade-mark so resembling that of another trader, as that ordinary purchasers, buying with ordinary caution, are likely to be misled. When, therefore, a party has been in the habit of stamping his goods with a particular mark or brand, so that the purchasers of his goods having that mark or brand know them to be of his manufacture, no other manufacturer has a right to adopt the same stamp; because, by doing so, he would be substantially representing the goods to be the manufacture of the person who first adopted the stamp, and so would or might be depriving him of the profits he might make by the sale of the goods which the purchaser intended to buy." This last remark is substantially in the language of Lord Chancellor Cranworth in *Seixo v. Provezende*, L. Reps., 1 Ch. Ap., 196. "The Court is not bound to interfere where ordinary attention will enable purchasers to discriminate between the trade-marks used by different parties." *Popham v. Cole*, 66 New York, 76. If the trade-mark "would not probably deceive the ordinary mass of purchasers an injunction will not be granted." *Blackwell v. Wright*, 73 N. Car., 310. "All the authorities agree that the Court will not restrain the defendant from the use of a label on the ground that it infringes the plaintiff's trade-mark, unless the form of the printed words, the words themselves, and the figures, lines and devices, are so similar that any person with such reasonable care as the public generally are capable of using and may be expected to exercise, would mistake the one for the other." *Gilmore v. Hunnewell*, 122 Mass., 139.

These quotations indicate to my mind the true rule. The imitation or resemblance must be of such a character as to amount to a representation that the goods which the defendants make are goods made by the plaintiffs. It necessarily follows that before there can be any legal injury the representation *must be believed by the purchaser*. The careful and vigilant purchaser examines

and takes pains to know before he purchases; and if he purchases the defendant's goods for the plaintiffs', it is because he believes them to be such. On the other hand the careless and unwary purchaser takes little or no pains and purchases without any real belief on the subject. He may have a vague and indefinite notion, but it does not amount to a belief, so that it can be truly said of him that he has been misled.

This illustrates at once the distinction, and the reasonableness of the rule, for which I am contending. The careless and unwary purchases the goods made by one man, not because he believes they were made by another, but because he is so far indifferent that he takes no pains to ascertain. He has not been legally misled. The cautious man purchases them because he believes they were made by another. He has been misled.

Hence the propriety of the rule that the imitation must be calculated to deceive purchasers of ordinary caution.

For these reasons I think the injunction should not issue.

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CIRCUIT COURT UNITED STATES, EASTERN
DISTRICT OF MICHIGAN. IN EQUITY.

BURTON*vs.*STRATTON, AND OTHERS.

DECIDED 3 JULY, 1882.

REPORTED 12 FEDERAL REP., 696.

"Twin Brothers Yeast" Case.

1. TRADE-MARKS—MERE WORDS—GENERIC NAME.—The difficulty is in distinguishing cases where the property has acquired a generic name as indicating the quality of the article rather than its origin and ownership.

The only satisfactory rule we have been able to gather from the authorities is that each case is matter for the Court to determine, not alone from the mark itself, but from the testimony, whether the words have become so well known as to stand in the public eye as denoting the character and quality of the article and not its origin or ownership.

Mere words may become valid trade-marks, when they are merely arbitrary or are indicative of origin or ownership in the original proprietor.

2. SAME—WHEN PROTECTED.—Words which have acquired a significance in the market as expressive only of the name or quality of an article cannot be appropriated as a trade-mark. But if the primary object of

the trade-mark be to indicate origin or ownership, the mere fact that the article has obtained such a wide sale that the mark has also become indicative of quality, is not of itself sufficient to debar the owners of protection, or make it the common property of the trade. To hold otherwise would be to deprive the owner of the exclusive use of his trade-mark just at the time when it had become most valuable to him, and stood most in need of protection. But if the name be suffered to come into general use without objection from the proprietor, it may become merely generic, or indicative of quality.

3. SAME—AN APPURTENANCE—SALE OR ASSIGNMENT OF.—A trade-mark, indicative of origin or ownership in the proprietor of a certain business, may be sold or assigned by him as an appurtenance of such business, and the assignee may become entitled to the exclusive use of such mark, even as against such proprietor himself. **HELD:**

That the right to use the words "Twin Brothers," in connection with portraits of the twins, had been lawfully assigned to the plaintiff, and that he was entitled to an injunction against one of the twins who had set up a separate establishment, and was making use of this trade-mark in manufacturing yeast.

THIS was a bill in equity to enjoin the use of a trade-mark. The bill set forth that the plaintiff had, for a long time, made a certain yeast, put up in wrappers and labels, specimens of which were attached to his bill; that since 1877 he had claimed the words, devices, figures, and arrangements shown by said label as a trade-mark, especially employing the figures of two heads in an oval setting, and the words "Twin Brothers Improved Dry Hop Yeast," and "Twin Brothers" in connection with the yeast as a trade-mark; that the defendant Stratton and his brother Thomas J. Stratton were the two men represented by the two figures; that they originated the yeast, and were the original owners of the trade-mark; that defendant, Jackson B. Stratton, before 1867, made and sold this yeast under the name of "Twin Brothers Improved Dry Hop Yeast" in the State of Ohio, and in 1867 complainant and said defendant Stratton formed a partnership and made and sold this yeast; that late in the year 1867 complainant bought out from said Stratton his interest in the partnership and trade-mark, paying therefor \$4,000; but he continued to employ Stratton, under various agreements, until the year 1877, in the manufacture of this

yeast; that in 1869 he purchased from Thomas J. Stratton the factory theretofore leased from him, and his interest in the trade-mark, and had since continued to use the same, with the wrappers and labels, and particularly the term "Twin Brothers Yeast," both separately from and in connection with the bust figures shown upon the wrappers; that at the time of his purchase from the defendant the yeast was not extensively known, and the demand therefore was not large, but that since said purchase the business has been greatly extended and the demand for the yeast is now large and constant; that defendant Stratton and others were making a spurious article and selling the same as "Twin Brothers Dry Hop Yeast," and using wrappers and labels like those of the plaintiff; that the spurious article is a fraud upon the public, who purchased it believing it to be the genuine Twin Brothers yeast made by the plaintiff.

PRAYER:—That the defendants be enjoined from imitating the label, and from selling any yeast made by them, or any other person than the plaintiff, as and for the "Twin Brothers" yeast, and in using the name of Twin Brothers in any way, shape, or form in connection with the sale of yeast.

The defendant claimed an absolute right to use the words "Twin Brothers Yeast," in so far as they constituted the original trade-mark of Stratton Brothers, on the ground that Stratton never sold his interest in such trade-mark to complainant; that a Court of Equity will not protect plaintiff in the use of his trade-mark, although he bought it of Stratton, because in using it he represents to the public that he was the originator, and that it indicates an origin in himself, when such is not the truth; that Twin Brothers is a generic name of a compound made under Stratton's discovery; and that the defendants or any other person making the genuine article may sell it under its proper name. They deny the charge that the yeast made by them is a spurious article, and claim that it is the genuine original compound discovered by defendant Stratton, and substantially the same as made by the complainant.

C. F. Burton and Alfred Russell, for plaintiff.

H. C. Winser, for defendant.

BROWN, D. J.:

We think there is a decided preponderance of testimony in favor of the plaintiff's theory that at the time his partnership with the defendant Stratton was dissolved he purchased not only his interest in the business, but also his moiety of the trade-mark. Indeed, the defendant seems to have had very little else of any value to sell. Plaintiff had put but a thousand dollars into the venture. Defendant had contributed nothing but his attention and skill. The partnership lasted but eight or nine months, and the business done was very limited. They would get a little meal and make a small quantity of yeast; then they would shut up the factory and go out and sell it, get a little more meal, and start again. After conducting the business in this way about six months the demands of their creditors became so urgent that plaintiff was obliged to advance \$300 more to continue it. Soon after, an investigation of the books showed their affairs to be in such a precarious condition that defendant Stratton wanted to go out of the business, and the plaintiff bought his interest and paid him \$4,000. At the time of the sale there appears to have been no stock on hand, and the factory had been shut down for some six weeks. Under these circumstances it seems to us quite improbable that they could have made ten or twelve thousand dollars in nine months, or that there could have been debts due the firm to the amount of \$8,000. Add to this the testimony of several witnesses who swear that defendant stated to them repeatedly, and in regretful manner, that he had sold his interest in the trade-mark, and had nothing else to sell to the plaintiff, and his subsequent conduct after he left plaintiff's employ in commencing to sell under the name of the "Standard Yeast," we can entertain but little doubt of the fact, notwithstanding the agreement was not in writing.

The principal question involved in this case is whether the words "Twin Brothers" are a trade-mark of such a character as entitles the plaintiff to be protected in his monopoly of them. The point is certainly not free from difficulty. There are few classes of cases in the whole domain of the law so difficult to reconcile as those

wherein the validity of a trade-mark is discussed. The following proposition, however, may be considered as settled:

1. That a Court of Equity will enjoin unlawful competition in trade by means of a simulated label, or of the appropriation of a name; as where the defendant appropriates the name of a hotel conducted by the plaintiff, or imitates his label upon preparations. *Howard v. Henriques*, 3 Sandf., 725, (*Irving House Case*); *Woodward v. Lazar*, 21 Cal., 448, (*What-Cheer House Case*); *Howe v. Searing*, 10 Abb. Pr., 264, (*Howe's Bakery Case*); *McCardell v. Peck*, 28 How. Pr., 120, (*McCardell House Case*); *Williams v. Johnson*, 2 Bosw., 1, (*Genuine Yankee Soap Case*); *Day v. Croft*, 2 Beav., 488, (*Day & Martin Blacking Case*); *Davis v. Kendall*, 2 R. I., 566, (*Pain-Killer Case*); *Meriden Britannia Co. v. Partridge*, 39 Conn., 450. The ground of interference in this class of cases is fraud; that is, the attempt to palm off the goods of the defendant as the goods of the plaintiff.

2. A Court of equity will not protect a person in the exclusive use of a word which expresses a falsehood; as, if the article bears the word "patented" when in fact it is not patented, or exhibits an untruth as to the place of manufacture or composition of the article. *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. of L., 531; *Browne, Trade-Marks*, sec. 72; *Flavel v. Harrison*, 10 Hare, 467; *Partridge v. Menck*, 1 Barb. Ch., 101; *Pidding v. How*, 8 Simmons, 477, (*Howqua Mixture Case*); *Palmer v. Harris*, 60 Pa., 156, wherein the trade-mark indicated that certain cigars were made in Havana, when in fact they were made in New York; *Fetridge v. Wells*, 13 How. Pr., 385, (*Balm of Thousand Flowers Case*); *Phalon v. Wright*, 5 Phila., 464, (*Night-Blooming Cereus Case*); *Cocks v. Chandler*, L. R., 11 Eq., 446, (*Reading Sauce Case*); *Connwell v. Reed*, 128 Mass., 477, (*East Indian Remedy Case*).

3. That no one can extend his monopoly of a patented trade-mark. By the expiration of the patent the public acquires the right not only to make and sell the article, but to make and sell it under the name used by the patentee. *Singer Manuf'g Co. v. Stanage*, 6 Fed. Rep., 279; *In re Richardson*, 3 O. G., 120; *Tucker Manuf'g Co. v. Boyington*, 9 O. G., 455.

4. A person cannot, by means of a trade-mark, monopolize the name of the place where the article is manufactured. *Canal Co. v. Clark*, 13 Wall., 311, (*Lackawanna Coal Case*); *Brooklyn White Lead Co. v. Masury*, 25 Barb., 416. Nor the ordinary numerals or letters. *Manuf'g Co. v. Trainer*, 101 U. S., 51, (*A. C. A. Case*); *Am. Manuf'g Co. v. Spear*, 2 Sandf., 599; *Avery v. Meikle*, 23 Alb. Law J., 443. This proposition has, however, been disputed. See *Gillott v. Esterbrook*, 48 N. Y., (*The 303 Case*); *Boardman v. Meriden Britannia Co.*, 35 Conn., 402. Nor can a person monopolize a name expressive of the character or composition of an article. *Caswell v. Davis*, 35 N. Y., 281, (*Ferro-Phosphorated Elixir of Calisaya Bark Case*).

5. So where the words used are expressive only of the name or quality of the article, and have acquired that significance in the market. *Am. Manuf'g Co. v. Spear*, 2 Sandf., 599; *Manuf'g Co. v. Trainer*, 101 U. S., 51; *Stokes v. Landgraff*, 17 Barb., 608; *Corwin v. Daly*, 7 Bosw., 222, (*Club House Gin Case*); *Ferguson v. Davol Mills*, 2 Brewster, 314; *Choynski v. Cohen*, 39 Cal., 501, (*Antiquarian Book Store Case*); *Phalon v. Wright*, 5 Phila., 463; *Singleton v. Bolton*, 3 Doug., 293, (*Case of Dr. Johnson's Yellow Ointment*); *Thomson v. Winchester*, 19 Pick., 214, (*Thomsonian Medicine Case*); *Benninger v. Wattles*, 24 How. Pr., 204, (*Old London Dock Gin Case*); *Raggett v. Friedlater*, L. R., 14 Eq., 29, (*The Nourishing Stout Case*).

In order that mere words may be upheld as a trade-mark they must be merely arbitrary, or they must indicate the origin or ownership of the article or fabric to which they are affixed. *Am. Manuf'g Co. v. Spear*, 2 Sandf., 597; *Canal Co. v. Clark*, 13 Wall., 322; *Falkinburg v. Lucy*, 35 Cal., 52; *Browne, Trade-Marks*, sec. 216; *Durham Tobacco Case*, 3 Hughes, 157; *Wotherspoon v. Currie*, L. R., 5 E. & I. App., 508, (*The Glenfield Starch Case*); *Ford v. Foster*, L. R., 7 Ch. App., 611, (*Eureka Shirt Case*); *Hier v. Abrahams*, 82 N. Y., 519, (*Pride Tobacco Case*); *McAndrew v. Bassett*, 10 Jur., (N. S.), 550; S. C., 12 Week. R., 777, (*Anatoleo Case*); *Lee v. Haley*, L. R., 5 Ch., 155, (*Grimes Coal Co. Case*); *Seixo v. Provezende*, L. R., 1 Ch., 192,

(*Seixo Wine Case*); *Braham v. Bustard*, 1 *Hem. & M.*, 447, (*Excelsior Soap Case*).

There are cases which appear to differ from those above cited, but we think most if not all of them, can be distinguished from them.

The defendant takes the ground in this case that the words "Twin Brothers Yeast" is a generic name, and indicates, not the origin or ownership of the article, but its specific quality, and that it has acquired in the market a reputation under that name. This defence appears to be somewhat of an after-thought, and it is doubtful whether it is properly before the Court, since no allusion is made to it in the answer, and it was not until the case had been at issue a year and the proofs taken that defendant made an affidavit to the effect that "Twin Brothers Yeast" was the generic name of a specific article of merchandise, and that he was the only person who ever was or ever could be able to manufacture it. The defence, too, seems to be somewhat inconsistent with the previous testimony. Upon being called as a witness Stratton swore that he made a discovery of a yeast compound, and that he did not get it patented because he considered it of more value to him as a secret than as a patent. He had imparted the secret to the employees of the plaintiff. He had also imparted it to the Judds, who manufactured "Judd Bros." yeast according to his formula; that he had also imparted the secret to one Hopper, who made the same yeast under the name of the "National Yeast;" that while a member of the firm of A. G. Smith & Co., he manufactured and sold the same yeast under the name of the "Standard" yeast, and that he manufactured the same yeast for a firm in Toledo, who sells it under the name of the "Lion Brand."

1. The difficulty is in distinguishing cases where the property has acquired a generic name, as indicating the quality of the article rather than its origin or ownership. One would say at once that Congress Water was an example of a generic name, since it is universally known by that name in the market; and yet the Court of Appeals in New York sustained it as a trademark, apparently upon the ground that complainants were the exclusive owners of the spring known as the Congress Spring, and

that the right to use the name was passed as appurtenant to the property. The only satisfactory rule we have been able to gather from the authorities is that in each case it is a matter for the Court to determine, not alone from the mark itself, but from the testimony, whether the words have become as well-known as to stand in the public eye as denoting the character and quality of the article and not its origin or ownership. Thus, if it should appear that the article had been manufactured and sold by a number of dealers under a particular name, this would be decisive that the plaintiff had no right to the exclusive use of that name. Most if not all of these generic names were at first indicative of the origin, but finally, by constant use, ceased to subserve that purpose and have become indicative of the quality. An example of this is "Fowler's Solution of Arsenic," which clearly indicates origin, but the article is nevertheless put up by druggists all over the country, and this name has become public property. We think that most if not all the cases upon this subject, when carefully examined will be found to have turned upon the extent to which the name is used, rather than upon the name itself. Thus, in the *A. C. A. Case*, 101 *U. S.*, 51, it was said by the Court that it was clear, from the history of the adoption of the letters as narrated by the complainant and the device itself, that they were only intended to represent the highest quality of ticking manufactured by the plaintiff, and not its origin. It appeared that other letters were used to indicate inferior grades of the same article.

In *Stokes v. Landgraff*, 17 *Barb.*, 608, it appeared it was a practice of manufacturers of glass to designate the several qualities by names similar to those used by the parties to the action, and not by words or figures, in terms expressing the qualities. In *Corwin v. Daly*, 7 *Bosw.*, 222, it appeared that the words "Club House" had been applied to articles of merchandise, including gin of a special quality, for a number of years. See, also, *Ferguson v. Davol Mills*, 2 *Brewster*, 314; *Thompson v. Winchester*, 19 *Pick.*, 214; *Wolfe v. Goulard*, 18 *How. Pr.*, 64. (*Scheidam Schnapps Case*).

2. But if the primary object of the trade-mark be to indicate the origin or ownership, the mere fact that the article has obtained such a wide sale that the mark has also become indicative of quality is not of itself sufficient to debar the owner of protection or make it the common property of the trade. To hold otherwise would be to deprive the owner of the exclusive use of his trade-mark just at the time when it had become most valuable to him and stood most in need of protection. But if the same be suffered to come into general use without objection from the original proprietor, it became merely generic, or indicative of quality.

Applying these principles to the case under consideration, it is pertinent to observe that no such defence is set up in either of the answers to the original bill, which was filed in December, 1880. In the answer of Orange Judd it is expressly averred that he is manufacturing Judd Brothers yeast; that for a number of years he manufactured yeast for the complainant of precisely the same kind as he is now manufacturing, and which said complainant sold as Twin Brothers yeast. He admits that he is selling to said Jackson B. Stratton and Asa Judd the yeast manufactured by this defendant, which, as before stated, is precisely the same kind of yeast he before manufactured for the plaintiff. He further avers that what Stratton and Asa Judd (his brother) do with the said yeast this defendant does not know except from hearsay, but he denies that he is directly or indirectly using the "Twin Brothers" trade-mark, or any mark except that owned by himself, to wit, the trade-mark of Judd Brothers; and further, that if Stratton and Asa Judd are using complainant's trade-mark, it is upon their own responsibility and without any agency or authority from him. He further, in paragraph 7, says that he is now and has been selling to the trade—large quantities of the same kind of yeast which he has been selling said defendants Stratton and Asa Judd; that all said yeast sold by him is sold under the name of "Judd Brothers Yeast." The testimony also shows, as heretofore stated, that the same yeast was sold under the name of Standard yeast and of the Lion yeast.

The first intimation we have of the claim now set up is contained in the affidavit of Jackson B. Stratton, filed in Decem-

ber, 1881. His original defence was that he did not sell his interest in the trade-mark. It is true that in several of the contracts entered into between the plaintiff and defendant Stratton the yeast is spoken of as the Twin Brothers yeast; and sometimes of the "kind and quality" known as Twin Brothers yeast; and so it was undoubtedly known, as between the parties themselves, as representing the yeast of the compound of which Stratton possessed the secret; but this is no answer to the fact that it was manufactured and held out to the public under different names, such as were most convenient for Stratton. Upon the whole, it does not seem to us that the words "Twin Brothers," under the testimony, can be considered as indicating to the public the quality of the yeast, though it certainly does indicate origin and ownership in the persons whose likenesses appear on the trade-mark. The question whether this trade-mark was such a one as could be the subject of assignment to the plaintiff, and lawfully used by him, is not free from difficulty. He was not one of the Twin Brothers, nor are either of the heads in the oval figure representations of himself or of any one now connected with him in business. But the cases are numerous in which it has been held that a party may lawfully assign and sell not only a trade-mark indicative of origin in himself, but even the right to use his own name in connection with a particular business.

3. Several of these are cited in the recent opinion of Mr. Justice Matthews in the case of *Pepper v. Labrot*, 8 Fed. Rep., 29, in which the right to use the words "Old Oscar Pepper" were held to pass to an assignee in bankruptcy of the proprietor of a distillery and premises, even as against such former proprietor himself, who had set up a separate establishment in another county. The comments of Justice Field in this connection in *Ridd v. Johnson*, 100 U. S., 517, are decisive of the right of a party to sell a trade-mark used in connection with a certain business, though it be indicative of origin in himself. In the case under consideration it seems to me clear that the Strattons could lawfully transfer to the complainant, in connection with their sale to him of their interest in the business, the exclusive right to use their trade-mark. Whether such trade-mark could be assigned separate from the

business to which it was appurtenant, or whether it would pass by a sale of the business alone, we are not called upon to decide. Complainant paid a valuable consideration for this trademark, and we think he should be protected by injunction in his right to use it.

See *Shaw Stocking Co. v. Mack*, *post*, 707, and *note*, 717.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

THE COLLINS COMPANY

vs.

OLIVER AMES & SONS CORPORATION.

DECIDED 3 JULY, 1882.

REPORTED 18 FEDERAL REP., 561.

“Collins & Co.” Case.

TRADE-MARK—FIRM-NAME—INFRINGEMENT.

Prior to 1834, S. W. Collins, D. C. Collins, and another, copartners as Collins & Co., made edge-tools, using as a trade-mark “Collins & Co.” In 1834, they assigned to the Collins Manufacturing Company, a corporation, the right to such trade-mark. In 1843, the right to make all articles of metal was conferred on the corporation, and its name was changed to the Collins Company, the plaintiff. It always stamped “Collins & Co.” on its productions. In 1856, the firm of Oliver Ames & Sons began to put the stamp and label “Collins & Co.” on shovels made by it, and sent to Australia. The plaintiff had not up to that time made shovels, but it had a market in Australia for the articles it made and stamped “Collins & Co.” The object of Oliver Ames & Sons in putting the stamp “Collins & Co.” on the shovels, was to avail themselves of the credit and reputation and market which the plaintiff

had established for itself for articles stamped "Collins & Co." The plaintiff, at the time of bringing this suit, had not sent or sold any shovels to Australia. The defendant, in succession to Oliver Ames & Sons, continued to do what the latter so began to do in 1856. **HELD:**

That the acts of Oliver Ames & Sons, and of the defendant, were always unlawful. The plaintiff having had, from 1843, the right to make all articles of metal, and having gone on from that time, both before and after 1856, extending its manufacture beyond edge-tools into digging tools, such as picks and hoes, and having always put the mark "Collins & Co." on its best quality of articles, the fact that it did not, before 1856, make a digging tool such as the shovel on which, in 1856, Ames & Sons put the mark "Collins & Co.," does not warrant the conclusion that that mark was not, in 1856, the mark of the plaintiff's trade in respect to such shovels.

John Sherwood, for plaintiff.

William M. Evarts and *Charles C. Beaman, Jr.*, for defendant.

BLATCHFORD, J.:

Prior to May, 1834, Samuel W. Collins, David C. Collins and John F. Wells, as copartners under the name of Collins & Co., had been carrying on, in the State of Connecticut, the business of making and selling axes and other edged tools. They have been in the habit of using as a trade-mark the words "Collins & Co." stamped on the articles which they made. They failed in business. In May, 1834, the Legislature of Connecticut created a corporation by the name of "The Collins Manufacturing Company," to be located in the town of Canton, in that State, "for the purpose of manufacturing edged tools." In October, 1834, the *corporation in said firm* assigned to said corporation "the reputation and good-will of the business heretofore carried on by the said firm of Collins & Co., of manufacturing and vending axes and other edged-tools, also the right to stamp the name of Collins & Co., on the articles manufactured by the said corporation." From that time until April 3, 1835, the corporation had Samuel W. and David C. Collins in its employ. On the latter date each of those persons executed an agreement with the corporation, whereby he agreed to continue in its employ for five years from September 27, 1834, and it agreed to employ him for that time, and he assigned to the

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corporation "the reputation and good-will of the business heretofore carried on by Collins & Co., of manufacturing and vending axes and other edge-tools, also the sole and exclusive right to stamp the name of Collins & Co., Hartford, on the articles manufactured by said corporation," and he agreed not to sell any axes or other edge-tools having on them the name of Collins or Collins & Co., except such as should be made by said corporation, its successors or assigns. The consideration of each agreement was an annual salary, and certain shares of the capital stock of the corporation. In May, 1843, the Legislature of Connecticut altered and enlarged the charter of the corporation, so that it should have "power to manufacture iron and steel, and other metals, and any article composed of said metals, or either of them," and enacted that the name of the corporation should be "The Collins Company," instead of "The Collins Manufacturing Company," these provisions being conditioned on their acceptance by the corporation at a future meeting of the same, duly convened. In October, 1844, such a meeting was duly convened, and at it the stockholders accepted the said alterations of the charter. The capital of the corporation was originally \$300,000. The Legislature increased it in 1863 to \$500,000, and in 1866 to \$1,000,000.

The factories of the corporation have always been at Collinsville, in the town of Canton, in Hartford County, Connecticut; about 16 miles from Hartford. The manufacturing business of the old firm of Collins & Co. had been carried on at Collinsville. It had an office in Hartford. The charter of the corporation was obtained for the benefit of the creditors of the firm, and the property of the firm passed into the possession of the corporation, and became a part of its capital stock.

The complaint in this suit alleges that the plaintiff corporation has, from its organization, been engaged in making "axes, hatchets, adzes, picks, and other agricultural and mechanical tools and implements;" that it has always used as its trade-mark the name of "Collins & Co.," but has placed and now places that name upon such goods only as have obtained a high standard of excellence; that said trade-mark name was intended to and did inform the purchasers that the goods upon which it appeared were

of the manufacture of the plaintiff exclusively; that its goods, made at Collinsville, have been and are almost exclusively sold on commission in the City of New York, by a firm there called Collins & Co., which has existed since 1849; that the goods of the plaintiff "have been and are sold in large quantities in all parts of this country, in Mexico, in most countries of South America, and in the West India Islands, in England, Germany, Russia, and other countries of Europe, and also in parts of Asia and Africa, and in Australia; that the plaintiff, for more than 30 years last past, has gradually increased and extended its manufacture from "axes, hatchets, broad-axes, picks, mattocks, and other similar tools and implements, such as hoes of various descriptions, *machetes*, and other cane-cutting implements for use in the West Indies and South America, and also, about the year 1857, special implements and tools for digging Peruvian guano, and, soon afterwards, other implements and tools, such as spades and plows;" that, for more than 20 years last past, it has made and sold shovels of various forms, patterns, and descriptions, and its trade, especially for export, in such shovels has been and is now successful and profitable; and that the best qualities of the said tools and implements of the plaintiff's manufacture have been and are stamped with the said name and word "Collins & Co." and the shovels so made and sold by it have been and are now stamped or branded and labeled with the said name and words "Collins & Co."

The defendant is a corporation created by the State of Massachusetts, having its factories at North Easton, in that State, and largely engaged in making shovels, spades, scoops, and other similar implements and tools. The complainant alleges that, in the autumn of the year 1879, the plaintiff for the first time discovered that shovels had been and were being sold in the City of New York, having stamped or branded upon the iron the name and words "Collins & Co.," "Cast Steel," and that upon the handles thereof were pasted or fastened labels, which had the following words printed or engraved thereon: "Best Cast Steel, Manufactured and Warranted by Collins & Co., North Easton, Mass., U. S. A.;" that the said shovels were in fact made and so stamped or branded and labeled by the defendant, and not by the plaintiff;

that said shovels were sold by the defendant in the City of New York; that the statement and representation contained in and made by said stamps or brands and labels, that the said shovels were made by "Collins & Co.," is false; that no such firm as "Collins & Co." is or has been engaged in any such manufacture at North Easton, Massachusetts; that no firm in the country, in the same business, bears the name of "Collins & Co." other than that represented by the plaintiff, or its said commission house of Collins & Co., of New York; that the shovels made by the defendant, and so branded, stamped, and labeled "Collins & Co.," have been and are now being sold by it in the City and State of New York, and elsewhere in the country, and considerable quantities thereof have been exported to foreign countries, such as Australia, South Africa, and elsewhere; that the use of the name of "Collins & Co." on shovels or any other article by the defendant is unauthorized; that said name has been taken and is so used by the defendant to induce purchasers to believe that said goods were and are made by the plaintiff; that the effect of such use and misrepresentation by the defendant is also to defraud the plaintiff in its trade, and to injure its reputation; that in December, 1879, the defendant was requested by the plaintiff to discontinue the use of the name of "Collins & Co." on shovels, tools, and implements made and to be made by the defendant, but it refused to do so; that the defendant makes and sells shovels with the name of "Collins & Co." thereon, and said shovels are of an inferior quality to those of the plaintiff, and also of an inferior quality to those of the defendant upon which it uses its own name, and the reputation and trade of the plaintiff are injured by the said acts of the defendant; and that the plaintiff has thereby sustained damages to a large amount. The prayer of the complainant is that the defendant be enjoined from stamping or branding the name or words "Collins & Co." or "Collins" on any shovel or implements of its manufacture, and from placing any labels with the name or words "Collins & Co." or "Collins" on any shovels or implements of its manufacture, and from selling or disposing of any shovels or implements with the name "Collins & Co." or "Collins" thereon, and from using in any manner the name or

words "Collins & Co." or "Collins" as a trade-mark upon any shovels, implements, or other articles, and from using in any manner the plaintiff's trade-mark of "Collins & Co." or the name of "Collins." It also prays for an accounting and for \$10,000 damages. This suit was brought in the Supreme Court of New York, and was removed into this Court. The complaint was put in, in the State Court. The answer and the replication to it were put in, in this Court. The answer states that it treats the complaint as a bill of complaint.

The answer denies that the reputation of any goods of the plaintiff's manufacture has been injured or impaired by any imitation or infringement by the defendant, and that the defendant has imitated or infringed any of the goods or marks or trade-marks of the plaintiff. It avers that the defendant and its predecessors are, and have been for upwards of 75 years, largely engaged in the business of manufacturing shovels, spades, scoops, and similar implements and tools. It admits and avers that, in the autumn of 1879, as well as for upwards of 23 years before that time, shovels of the manufacture of the defendant and its predecessors were being and had been sold in the City of New York, having stamped or branded on them the name and words "Collins & Co., Cast Steel," or put in similar words, and having pasted or fastened on the handles thereof labels which had the following words, or such or similar words, printed or engraved thereon; "Best Cast Steel, Manufactured and Warranted by Collins & Co., North Easton, Mass., U. S. A.;" and that such shovels, bearing such marks and labels thereon, were in fact manufactured, and so stamped and branded or labeled, by the defendant and its predecessors, as well as by other manufacturers, and not by the plaintiff. It avers that the defendant and its predecessors had been in the habit of manufacturing shovels, and stamping, branding, and labeling them with the said words, or with such or similar words, from time to time since the year 1856, and that the plaintiff and its predecessors have known that fact for many years last past, and since about the time of the use thereof by the predecessors of the defendant, in the year 1856. It admits and avers that the defendant and its predecessors have made such shovels from time to time since the year

1856, as aforesaid, and that no such firm as "Collins & Co." is or has been engaged in any such manufacture at North Easton, in Massachusetts; that the shovels made by the defendant, and so branded, stamped, and labeled "Collins & Co.," have been and are now being sold by it in this country, and that large quantities thereof have been exported to foreign countries, such as Australia, South Africa, and elsewhere; that such sale and export have been going on in the usual and ordinary course of business of the defendant and its predecessors for 25 years or thereabouts; and that neither the plaintiff, nor the Collins Manufacturing Company, nor any firm of Collins & Co., ever manufactured any shovels branded, stamped, or labeled with the name of Collins & Co., or any shovels whatsoever, until long after such shovels of the defendant, so branded, stamped, and labeled, had been introduced into the market and sold and exported to a large amount, and had acquired a high reputation in consequence of the quality of the material of which they were manufactured, and the care and skill exercised in the manufacture and selection thereof, or even manufactured or sold any such shovels until within the last few years, if at all. It denies that the use by the defendant of the name "Collins & Co." on shovels, or any other articles upon which such name may be used by it, is unauthorized or involves any false representation in respect thereto, or that said name has taken, or has been or is used, by the defendant to induce purchasers to believe that said goods were or are manufactured by the plaintiff, or that the effect of such use, or of any representations by the defendant in respect thereto, is either to deceive purchasers or the public, or to defraud the plaintiff in any way, or to injure any good name or reputation which it may have. It avers that, in using the same, the defendant used only its own trade-mark, to which it became entitled by reason of the use of such mark by it and its predecessors upon its and their shovels since the year 1856. It admits that in December, 1879, the defendant was applied to by the plaintiff to discontinue the use of the name of "Collins & Co." upon its shovels, and that it refused to discontinue such use thereof, asserting that it had the lawful right to use such name upon the shovels manufactured and sold by it. It admits and avers that the defendant

makes and sells, and it and its predecessors have, for nearly 25 years, made and sold, considerable quantities of such shovels, with the name of "Collins & Co." thereon; and that such designation is used by it upon a quality of shovels inferior to the very superior grade of shovels upon which it uses its own name. It denies that such shovels are of an inferior quality to any shovels manufactured by the plaintiff; that the reputation of the plaintiff or its trade is injured or impaired by any acts of the defendant; or that the plaintiff has thereby sustained any damages. It avers that, if the plaintiff is now manufacturing any shovels, and is stamping the same with the brand of "Collins & Co.," and selling the same either for domestic consumption or export, it is wrongfully acquiring great benefit and advantage from the use which the defendant and its predecessors have heretofore made of such title of "Collins & Co." upon shovels of its and their manufacture, and is infringing upon rights which the defendant has heretofore acquired by such use of such name in connection therewith. It avers that, in the year 1856, Oliver Ames, Oakes Ames, and Oliver Ames, Jr., of North Easton, in the State of Massachusetts, were doing business as copartners under the firm name of Oliver Ames & Sons, and were engaged, as they and their predecessors, for upwards of 50 years, had been, in the manufacture, at said North Easton, of shovels and spades; that for the very highest grade of shovels manufactured by the said firm, which was of superior excellence and comprised only shovels and spades selected with great care from the production of their factories, the name of O. Ames was used as the trade-mark of said firm; that for grades of the shovels and spades manufactured by said firm which, although inferior to the first grade above mentioned, were superior to most of the shovels and spades manufactured by other persons or parties, other names and trade-marks were applied, which were selected for the purpose; that in the month of April, 1856, the name "Collins & Co." was by said firm stamped upon and used to designate certain of the shovels which were manufactured by it; that, since that time, the said name of "Collins & Co." has been, from time to time, stamped by the said firm and its successors, including the defendant, upon shovels and

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spades manufactured by it and them; that such firm and its successors, including the defendant, have thereby acquired a right to the use of such name upon and in connection with the shovels and spades manufactured by said firm and its successors, including the defendant; that such firm of Oliver Ames & Sons continued until the year 1876, new members being admitted to such firm from time to time, and the original members thereof having died; that such firm continued, notwithstanding such changes in the membership thereof, to carry on its business of the manufacture of shovels and spades without interruption, and to own and enjoy the marks and trade-marks thereof, and to carry on the business of manufacturing shovels and spades at the same place, and in the same factories, and with the same establishment, until the said year 1876, when the defendant, then a corporation under the laws of Massachusetts, succeeded to and became, by transfer from the said firm, the owner of all its rights, property, marks, and trade-marks, including the right to the use of the name or mark "Collins & Co." upon shovels, and the brands, stamps and labels therefore used in connection therewith by the said firm; that the defendant thereby acquired the right of the said firm to the use of the said name, brands, stamps, and labels, and has since continued to exercise the right to the use thereof, which has now been enjoyed by the defendant and its predecessors for nearly 25 years; that if the firms of Collins & Co., and the Collins Manufacturing Company, and the plaintiff, exist and have existed, they have all acquiesced in and assented to the use by the defendant and its predecessors of the name of the said "Collins & Co.," and the brands, stamps, and labels above mentioned, in connection with shovels, in the like manner to that in which the same are now used by it in connection therewith, and have ratified and approved the same, and are estopped now from objecting thereto; that neither of said firms of Collins & Co., nor the said Collins Manufacturing Company, nor the plaintiff, made any use of the name "Collins & Co." upon or in connection with any shovels manufactured by it or them, or either of them, or ever manufactured any shovels upon which it or they or either of them could or might have used such name, until such use thereof had for many years been made

by the predecessors of the defendant and by the defendant; and that any attempted use of the name "Collins & Co." by the plaintiff, after the acquisition by the defendant of the rights which it had so acquired in respect to the use of such name or mark, was and is an infringement upon the rights of the defendant to the use of such name or mark upon and in connection with shovels manufactured by it.

The circumstances under which the firm of Oliver Ames & Sons the predecessors of the defendant, began to use the mark "Collins & Co." on shovels, were these: on the twenty-first of March, 1856, John W. Quincy, a merchant in the City of New York, wrote the following letter to Oliver Ames & Sons:

MESSRS. OLIVER AMES & SONS.

Gents.:—A party here has an order from Australia for the following shovels: they must be exactly to order as to *weight* and *size*. His order is for *Collins'* shovels, but I have no doubt that your shovels are wanted. I gave him your list prices and 5 per cent. for cash. These parties' name are J. & R. Osborn, and if they write you, please turn them over to me, or give them five per cent. for cash. I expect my advertisement brought them, and I want to make part of advertisement out of these folks. Their order runs thus:

"100 dozen best and lightest bright D handled shovels, C. S., well packed in cases; should weigh only $3\frac{1}{2}$ pounds; handles to measure 23 to 24 inches *only*.

"25 dozen C. S. spades, with extra long strap and side strap, if made so.

"12 dozen long-handle shovels, square.

"12 dozen long-handle shovels, round.

"The above is exact copy of order, and the party wishes us to furnish the price of each. As the first lot of 100 doz. are lighter than your regular shovels, I told him I would write you, and get an answer at once direct, and inform him.

"Please say how soon you can furnish them if wanted, and the probable cost of packing. Your immediate answer will oblige.

"Yours, truly, JOHN W. QUINCY."

"NEW YORK, *March 21*, 1856."

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On the twenty-fourth of March, 1856, Oliver Ames & Sons replied to Mr. Quincy by letter, but neither it nor a copy of it is produced.

To that letter Mr. Quincy replied as follows, March 26, 1856:

NEW YORK, *March 26, 1856.*

MESSRS. OLIVER AMES & SONS.

Gents.:—Your favor of the 24th inst. is at hand. The party gave me the order; he thinks the 100 dozen shovels are to be *square* point, as the order does not say round point. Please send them as per our letter of the 21st inst. Please have a label made for them thus: ‘Made expressly for C. G. Stevens,’ and get a stamp *for the shovels*, Collins & Co., and keep the stamp for our use, as we expect to get further orders for them; or, if you prefer it, I will get them made here and sent to you. We would like the shovels made and forwarded as soon as practicable.

“To be packed in boxes and strapped as usual for shipping. These boxes are to be shipped to England and put in custom-house (bond) there and then they go to Australia free of duty. It costs less to ship this way than to pay *duty* direct to Australia; you will, therefore, have them packed right.

“Yours, truly,

JOHN W. QUINCY.”

Mr. Quincy was at that time, and before and after, a dealer in the shovels made by Oliver Ames & Sons. The shovels so ordered were made by Oliver Ames & Sons, and were stamped or branded “Collins & Co.” by them. At that time the selling firm of Collins & Co. existed in New York. The plaintiff did not at that time make shovels, but the articles which it did make were sent to Australia, and it had an established reputation for the excellent quality of such articles. The shovels then and theretofore made by Ames & Sons had the reputation of being the best shovels made.

It is very clear that when Quincy stated to Ames & Sons that the order he had received was for “Collins’ Shovels,” he understood, and he meant that Ames & Sons should understand, and they did understand, that the order as given, was for shovels made or to be

made by the Collins Company, that is, the plaintiff. But Quincy knew that the plaintiff made no shovels and that Ames & Sons did make shovels. So he showed to those who came to him the shovel list of Ames & Sons. For some reason, a party in Australia, wanting shovels, had ordered "Collins' shovels," although there were none. Other articles of the plaintiff's manufacture were found in Australia, of high repute and good quality, articles of steel, kindred in character to shovels. It would be natural to think that, as other good articles of steel were of the Collins' make, the way to surely get a good shovel was to get one of Collins' make; and it would be natural to assume that there were Collins' shovels. The letter of Quincy shows that he informed those who came to him with the order that there were no Collins' shovels, and also informed them that he proposed that the order should be filled with shovels made by Ames & Sons. This was very well, and, so far, was fair dealing. The proposal was acquiesced in, for the arrangement was that Quincy should write to Ames & Sons and obtain the prices at which the articles would be furnished. It would appear that Ames & Sons, in reply, desired to know whether the order was given absolutely or not to Quincy; for Quincy replied that the party had given the order to him. He then requested Ames & Sons to fill it, and also directed that, besides the label "Made expressly for C. G. Stevens," which it must have been intended should be pasted on the wooden part of each shovel and each spade, each shovel of the 100-dozen order should have on it, impressed on the metal, the mark "Collins & Co.," to be made by a stamp. As it was understood that these articles were to go to Australia, both Quincy and Ames & Sons must have had some object in view connected with Australia. Quincy states, in his second letter, that he wishes the stamp to be kept for his use in filling further orders for like shovels, meaning further orders from Australia. He and the defendant could have intended nothing but that the idea which had come from Australia that there were Collins', though incorrect in fact, should become to the minds of people in Australia a realized idea, by their seeing on shovels the stamp "Collins & Co.," and deriving therefrom the belief that the same Collins & Co. which had made the axes and

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other articles before familiar to them had made these shovels. It appears that the axes and other articles made by the plaintiff, and which before that time were known and used in Australia, were stamped "Collins & Co." Therefore, although the shovels made by Ames & Sons under this order and subsequently, stamped "Collins & Co.," and sent to Australia and elsewhere, may intrinsically have been of high quality, yet the only object of the defendant in putting the stamp "Collins & Co." upon them must have been to avail himself of the credit and reputation and market which the plaintiff had established for the article it made and sold with the stamp "Collins & Co." upon them. There was no other purpose in this. Clearly, those who purchased shovels made by Ames & Sons, and stamped "Collins & Co.," would believe that such shovels were made by the plaintiff, for there was no other Collins & Co. than the plaintiff. This was an unlawful appropriation of the plaintiff's trade-mark. It is true that the plaintiff up to that time had made no shovels. It is also true that Ames & Sons and the defendant have built up a business in shovels stamped "Collins & Co." But the plaintiff had a right to make shovels, and it had made kindred articles of metal, and its good name and reputation in its business were wholly connected with the use, in its trade, of the mark "Collins & Co." Quincy's first letter shows that the nature of the plaintiff's trade was such that persons in Australia, desiring shovels, expected to find shovels made by the plaintiff, which shovels, if found, would have borne the stamp "Collins & Co." If, when the inquiry was made of Quincy, he had produced the shovels, the make of Ames & Sons, already made and stamped "Collins & Co.," in the same condition as when they were afterwards made on the order, the purchaser would have believed that the shovels were the make of the plaintiff, that being what the order really asked for, if nothing had been said or shown to indicate that they were not made by the plaintiff. As the fact was, the impression produced in Australia, by the shovel itself, with the stamp "Collins & Co.," was the same, although the persons who visited Quincy were informed that the shovels were the make of Ames & Sons.

It is true that the plaintiff's business in shovels has been very small, while that of Ames & Sons and the defendant has been very large. It is also true that the plaintiff has never sold or sent any shovels to Australia. It is also true that Ames & Sons and the defendant have put the stamp "Collins & Co." on only a particular description of shovel or spade, in all 52,000 dozen since 1856, while their make of shovels for the last 10 years has been from 100,000 dozen to 120,000 dozen a year. The 52,000 dozen have gone abroad wholly, largely to Australia. But the question of profit to the defendant or damage to the plaintiff is aside from the question of the right of the plaintiff to its trade-mark. In view of the circumstances under which Ames & Sons adopted the mark "Collins & Co.," on the shovels, it must be held that they had no right to adopt it, and that its use by them was always unlawful.

The *animus* of the defendant is shown in the representation in the label on the shovel that "Collins & Co." is a firm making shovels in North Easton, and that the shovel stamped "Collins & Co." was made by that firm at that place. To the user or purchaser of the individual shovel in Australia, the mark "Collins & Co." on the steel or the wood would be all that was needed to induce him to believe that he was using or buying a shovel made by the same "Collins & Co." which made the excellent edge-tools, while in the United States it could be asserted that every dealer would know that there was no firm of "Collins & Co." at North Easton making shovels, and so that representation would there deceive no one, and would not there induce the belief that the shovels were made by the plaintiff.

It is strongly urged, on the part of the defendant, that a mark or stamp, to be a trade-mark, must be the mark of an existing trade; that the mark "Collins & Co." on shovels, when adopted by Ames & Sons, became the mark of a trade in shovels carried on by Ames & Sons; that the plaintiff had no trade in shovels at the time, that the mark "Collins & Co." thus became the mark of Ames & Sons' trade in shovels, and the property of Ames & Sons in respect to shovels made by them, by prior right; that any use of that mark on shovels afterwards by the plaintiff became wrongful

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as against Ames & Sons or the defendant; and that the plaintiff has no right in the premises which it can enforce against the defendant. This view is specious but unsound. The plaintiff having from 1843 the right to make any article of iron, steel, or other metal, and having gone on from that time, both before and after 1856, extending its manufacture beyond edge-tools, into digging tools, such as picks and hoes, and having always put the mark "Collins & Co." on its best quality of articles, the fact that it did not before 1856 make a digging tool such as the shovels on which, in 1856, Ames & Sons put the mark "Collins & Co." does not warrant the conclusion that that mark was not in 1856 the mark of the plaintiff's trade in respect to such shovels.

The plaintiff is entitled to a decree for a perpetual injunction, as prayed in the bill, and for an accounting before a Master as to profits and damages, and for the costs of the suit.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

GINTER

vs.

KINNEY TOBACCO COMPANY, AND OTHERS.

DECIDED 15 JULY, 1882.

REPORTED 12 FEDERAL REP., 782.

“Straight Cut Tobacco” Case

1. TRADE-MARK—“STRAIGHT CUT.”—The term “straight cut,” as applied to cigarettes, is a term descriptive of the ingredients and character of the article used, and cannot be appropriated as a trade-mark, so as to preclude another from advertising cigarettes made of straight cut tobacco.
2. SAME—USE OF TERM TENDING TO DECEIVE.—The use of a term by complainant in a manner calculated to mislead the public in reference to the components or nature of the article to which it is applied, will not be tolerated.

Wm. D. Shipman, for complainant.*Charles B. Meyer*, for defendants.

WALLACE, C. J.:

1. So far as appears upon this motion the term "straight cut," as applied to cigarettes, is a term descriptive of the ingredients and characteristics of the article, and therefore the complainant cannot appropriate it as a trade-mark and enjoin the defendants from advertising their article as "straight cut cigarettes."

In the preparation of smoking tobacco several different processes of cutting the leaf are employed, and the product is designated by the term which describes the particular process which it has undergone, such as straight cut, curly cut, long cut, and fine cut. "Straight cut" designates that particular product in which the plant has been so cut and treated at the time of cutting as to preserve the fibers long, even, straight and parallel when prepared for sale or use. It is stated also that the choicer varieties of the plant are usually selected for this mode of treatment, and the product is especially desirable for cigarettes. In view of these facts it is evident that when the term is applied to cigarettes it implies that they are made of straight cut tobacco.

The complainant advertises his tobacco as straight cut, curly cut, etc., but always adds some further appellation, such as Twin-Pet straight cut, Perfection curly cut, etc. In a circular of May 1, 1881, he states that his "straight cut tobaccos are cut from the choicest varieties of Virginia gold and sun-cured leaf, and are cut to lie straight in the boxes, and are very desirable for making cigarettes." He now insists that the term was selected and has been employed by his business predecessors and himself as an arbitrary designation of his particular article, and that neither his cigarette nor the defendants' are made of straight cut tobacco. All this, if true, does not help the complainant's case, but to the contrary furnishes an additional reason why he should be denied the assistance of a Court of Equity. Not only has he employed a name to which he could not acquire an exclusive right, but he has used it in a manner calculated to mislead the public, although, perhaps, not intentionally on his part. A purchaser cognizant of the differences in the preparation of smoking tobacco would legitimately infer that the complainant's cigarettes were in fact made of straight cut tobacco.

2. No principles are better settled in the law of trade-marks than that a generic term, or a name merely descriptive of the ingredients, quality, or characteristics of an article of trade, cannot be the subject of a trade-mark, and that the use of a name or term which is likely to deceive the public in reference to the components or nature of the article to which it is applied will not be tolerated.

The motion for a preliminary injunction is denied.

See *Burton v. Stratton*, *ante*, 696, and note, 704; *Shaw Stocking Co. v. Mack*, *ante*, 707, and note, 717,

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COURT OF COMMON PLEAS OF NEW YORK.
IN EQUITY.

ELISHU G. SELCHOW, ET AL.*vs.*JAMES S. BAKER, ET AL.

DECIDED OCTOBER, 1882.

REPORTED 64 HOW'S PR., 212.

*"Sliced Animals" Case.*TRADE-MARK—ARBITRARY FANCY NAMES, SUBJECT OF—
INJUNCTION.

Plaintiffs invented a name for certain puzzles or games, and applied thereto the names of "sliced animals," "sliced birds," and "sliced objects." HELD:

Upon motion to continue injunction, that these names were arbitrary fancy names and the proper subject of a trade-mark.

MOTION FOR INJUNCTION.

Malcolm R. Lawrence, for motion.*Blatchford, Seward, Griswold & Da Coste*, opposed.

J. F. DALY, J.:

The plaintiffs are inventors of certain games or puzzles for children, to which they have given the name "sliced animals," "sliced birds," and "sliced objects," according to the pictures used in the play. The puzzles are constructed as follows: strips of cardboard, six and three-quarter inches long by an inch and a quarter wide, have a portion of the picture of an animal, a bird, or any object printed on them, with a single letter of the name of the thing represented in the left-hand corner of the strip. The puzzle is to find the strips containing the other portions of the picture and the other letters of the name, and to place such strips above or below each other so that the whole picture and the whole name are formed. The plaintiffs manufacture the picture strips as follows: the whole picture and the names are printed in colors on a single sheet of cardboard, which is then cut into strips of the sizes above mentioned.

I am satisfied that the names given by plaintiffs to these games, viz.: "Sliced animals," "sliced birds," and "sliced objects," must be considered fanciful and arbitrary designations which do not describe the thing manufactured nor its character. They convey no correct idea whatever of the game, or the things used in it or the proceeds by which it is manufactured.

The true designation of the thing and of the game is "divided picture cards," and no other description will convey even a faint idea of them. Neither the card nor the picture on it is sliced, as the term is commonly and properly understood. The name "sliced animals" conveys no intimation that the pictures of animals printed on cards have been cut in strips, and does not truly or in any manner describe the character, game or puzzle. A significant fact in support of this view is that, as appears by defendants' own affidavits, games and puzzles made of divided boards or blocks, on which maps, pictures, words, &c., were printed, have been manufactured and sold for over twenty years past under the names of "dissected maps," "spelling games," and under other names; but in no instance has the name "sliced" been applied until plaintiffs chose it to distinguish their articles.

If the name were the natural and proper designation of the goods it would have been naturally applied to them long before.

Motion for injunction granted so far as the use of the names complained of is concerned, with ten dollars costs.

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COURT OF COMMON PLEAS OF NEW YORK.

SPECIAL TERM. IN EQUITY.*

EMANUEL LAUFERTY

.vs.

THOMAS WHEELER, ET AL.

DECIDED OCTOBER, 1882.

REPORTED 63 HOW'S PR., 488.

"Alderney Manufacturing Co." Case.

TRADE-MARK—LAW OF.—The use of the words "Alderney Manufacturing Company;" not a violation of the Statute of 1833, forbidding the use of the words & Co., unless representing an actual partner.

1. Where the plaintiff had used the words "Alderney Manufacturing Company," as a trade-mark in relation to the oleomargarine manufactured by him, and had originated and first adopted the word "Alderney" in that connection, and it formed an integral part of the label stamped upon all the goods manufactured by him, and defendants, by being incorporated under a like name, claim the right to deprive him of the exclusive use of that word in the new connection in which he had placed it. HELD:

That an injunction lies restraining defendant from the use in any way of the word "Alderney" in connection with the manufacture and sale of oleomargarine.

2. The use of the words "Alderney Manufacturing Company" is not a violation of the Statute of 1833, forbidding the use of the words "& Co.," or "and Company," unless representing an actual partner.

Coudert Bros., for plaintiff.

William H. De Wolf and *Theodore Fitch*, for defendant.

VAN BRUNT, J.:

The defendants in this action claim the injunction should be dissolved upon the following grounds: 1st. That the words Alderney Manufacturing Company never was the trade-mark of the plaintiff. 2d. That his use of these words was a violation of the statute and an attempt to mislead the public. 3d. That the plaintiff is carrying on his business in violation of the laws of this State in respect to the coloring of the oleomargarine manufactured by him. 4th. That he is violating the United States statute in having the word "patent, Sept.," upon the goods sold by him, when he has no patent. 5th. That the plaintiff could not acquire a trade-mark in the words "Alderney Manufacturing Company."

We will very briefly consider these propositions in their reverse order.

It is to be observed that the plaintiff in this action does not claim any right to the exclusive use of the words "Manufacturing Co." as any part of his trade-mark, but limits his claim to the exclusive use of the word Alderney in connection with oleomargarine. The papers in this case seem to show that the plaintiff has used this word in connection with the oleomargarine manufactured by him; that he originated; that he first adopted it, and that it forms an integral part of the label stamped on all goods manufactured by him, different grades being marked by additional symbols. In respect to oleomargarine, the use of the word "Alderney" is entirely arbitrary, and in no respect descriptive of the article, and the case of *Hier agt. Abrahams* (82 N. Y., 519), sustains as a trade-mark the application of such arbitrary words, even if used in connection with others. The plaintiff does not make a trade-mark of his name, but he has adopted a word as part of his trade-mark and the defendants, by being incorporated under a

like name, claim the right to deprive him of the exclusive use of that word in the new connection in which he had placed it.

The fourth ground is that the plaintiff is violating the United States statute in having the words "patent, Sept." upon the goods sold by him. It is to be observed that it is not claimed that the use of the word "patent" has been resorted to by the plaintiff until very recently. It appears that application had been made on the 9th of June, 1882, for a patent for an improvement in process of manufacturing of oleomargarine butter, by Henry Lauferty, and that on the thirty-first of August notice was received from the United States Patent Office that the application had been examined and allowed, and that under this process the plaintiff has been manufacturing. It further appears that Mr. Lauferty was informed that his letters patent would be forwarded to him in September. This motion being heard in that month, and there is no evidence that prior to that time the word "patent" was used. Although perhaps not strictly entitled to use the word until the actual receipt of the letters patent, the case differs from that of the *Consolidated Fruit Jar Company agt. Berrell*, in that in the latter case there was not the slightest pretence that there was any patent applied for or about to be issued.

The third objection does not seem to be well taken. I cannot see but that the application for a patent being allowed, and the right of a patent complete, the mere formality of delivering a patent only remaining to be performed, brings the manufacturer certainly within the spirit of the exception contained in the laws of 1882.

1. The second ground for a dissolution of the injunction is that the use of the words Alderney Manufacturing Company is a violation of the statute. I have read the statute in vain to find any prohibition therein contained which is applicable to the case at bar. The statute of 1833 merely prohibits the use of the name of a partner not interested in the business, and the use of the words "and company" or "& Co." unless representing an actual partner. The plaintiff in this action does not use the name of a partner not interested in the business, neither does he use the words "and company" "or & Co." in any form. Therefore there does not seem to be any violation whatever of any statute. The

case of *Crawford agt. Collins*, (45 Barb., 270) expressly holds that the giving to a firm the name of a company is no violation of law, and that the parties to a co-partnership may give it just such names as they please (except, of course, as prohibited by statute). The case of *McNair, et al. agt. Cleare, et al.*, (1 Phil., 155), differs materially from the case at law. In the case of *Galaxy Publishing Company*, upon the billheads, envelopes, letter-heads, &c., appeared the name of a president and secretary. the Court holding that this was an attempt to hold out to the world that the firm was a corporation, and that this was a fraud. But even if the case was entirely in point, I should follow the law as laid down by our Courts. I cannot see possibly how any fraud can be perpetrated upon the public by parties engaged in business assuming as a firm-name words which might be equally applicable to a corporation. The creditors of a firm cannot suffer if instead of dealing with a corporation they are dealing with a firm, because if they were dealing with a corporation they can reach only the property of the corporation, but if they are dealing with a firm they can reach not only the property of a firm but also the individual property of its members.

The first objection seems to have been already discussed. I think that it clearly appeared that the plaintiff has used the word "Alderney," together with others, in connection with his business for a considerable period of time prior to the organization of the defendant.

Perhaps the undertaking upon the injunction should be increased in amount.

2. An injunction will be issued restraining the defendants from the use in any way of the word "Alderney" in connection with the manufacture and sale of oleomargarine, upon the plaintiffs giving an undertaking in \$2,500.

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SUPREME COURT, STATE OF NEW JERSEY.
IN EQUITY.

“THE MRS. G. B. MILLER & CO. TOBACCO MANU-
FACTORY”

vs.

MATTHIAS COMMERCE.

DECIDED NOVEMBER, 1882.

REPORTED 45 N. J. L., 18.

“The Mrs. G. B. Miller & Co. Best Smoking Tobacco” Case.

A declaration charging defendants with fraudulently and falsely selling goods of his own fabrication, as the manufacture of the plaintiff, by which the plaintiff was deprived of sales in the market, sets forth an actionable injury.

ON DEMURRER TO DECLARATION.

The following is the declaration filed by the plaintiff:

The Mrs. G. B. Miller & Co. Tobacco Manufactory complaint of Matthias Commerce, being in the custody of the sheriff of the County of Hudson, of a plea of trespass on the case.

For that whereas they, the said plaintiffs, for divers years before, and at the time of the committing of the grievances hereinafter next mentioned, did manufacture, vend and sell, and still do continue to manufacture, vend and sell for profit, divers large quantities of a certain smoking tobacco, called "Mrs. G. B. Miller & Co. Best Smoking Tobacco," which said smoking tobacco the said plaintiffs were then and still are, used and accustomed to manufacture, put up, and sell in packages respectively wrapped up in blue paper wrappers, having the following, amongst other words, printed thereon, that is to say, "Mrs. G. B. Miller & Co. Best Smoking Tobacco, 97 Columbia Street, New York," to wit: at Hoboken, to wit: at Jersey City, in the County of Hudson.

And whereas the said plaintiffs, before and at the time of committing the grievances hereinafter next mentioned, had gained and acquired great fame and reputation with the public on account of the excellent quality of the said smoking tobacco so by them manufactured, vended and sold, and continued to be manufactured, vended and sold as aforesaid whereby the said plaintiff, daily acquired and obtained great gain and profit, to wit: at, &c., aforesaid. Yet the said Matthias Commerce, well knowing, the premises, but wickedly and wrongfully, subtly and unjustly intending to injure the said plaintiffs in their said sale of the smoking tobacco and to deprive them of the great gain and profits which they, the said plaintiffs, would otherwise have acquired by manufacturing, vending and selling the said smoking tobacco as aforesaid, to wit: on the eighteenth day of January, one thousand eight hundred and seventy-eight, and on divers other days and times between that day and the day of the commencement of this suit, to wit: at Jersey City in the County of Hudson, aforesaid, did wrongfully, knowingly, injuriously, deceitfully and fraudulently, against the will and without the license or consent of the said plaintiffs, manufacture and make and cause to be manufactured and made, divers, to wit: ten thousand packages of smoking tobacco of the size, shape, color and general appearance of and in imitation of the said smoking tobacco manufactured and sold by the said plaintiffs as aforesaid, and did wrap

and cause to be wrapped up the said last-mentioned packages of smoking tobacco in blue paper, having the following amongst other words printed thereon, that is to say: "The Mrs. C. B. Müller & Co. Best Smoking Tobacco, 437½ Grove Street, Jersey City," in order to denote that such smoking tobacco was the genuine Mrs. G. B. Miller & Co. Best Smoking Tobacco, manufactured, vended and sold by the said plaintiffs, and did knowingly, wrongfully, injuriously, deceitfully and fraudulently vend and sell, for his own lucre and gain, the said last-mentioned packages of smoking tobacco, by the name and description of the Mrs. G. B. Miller & Co. Best Smoking Tobacco, which had been manufactured, vended and sold by the said plaintiffs, whereas in truth and in fact the said plaintiffs had never been the manufacturers, venders or sellers thereof, or any part thereof.

By reason of which said premises, the said plaintiffs have been fraudulently, deceitfully, wrongfully and injuriously hindered and prevented by the said Matthias Commerce from selling, vending and disposing of divers large quantities, to wit, ten thousand packages of the said Mrs. G. B. Miller & Co. Best Smoking Tobacco, which the said plaintiffs would otherwise have sold, vended and disposed of, and the said plaintiffs have also been deprived of divers great gains and profits, which would otherwise have accrued to them, the said plaintiffs, from the sale thereof, and have been otherwise greatly injured in the selling and vending of the said Mrs. G. B. Miller & Co. Best Smoking Tobacco, to wit: at, &c., aforesaid to the damage of the said Mrs. G. B. Miller & Co. Tobacco Manufactory of five thousand dollars, and therefore they bring their suit, &c.

Argued at November Term, 1882, before BEASLEY, Chief Justice, and Justices KNAPP and DIXON.

E. D. Deacon, for the demurrer.

S. A. Besson, *contra*.

KNAPP, J., delivered the opinion of the Court.

The foregoing declaration, to which the defendant has filed a demurrer, avers that the plaintiffs prepared, vended and sold, for

profit, a certain kind of smoking tobacco called and well-known to the public as "Mrs. G. B. Miller & Co. Best Smoking Tobacco," which they were accustomed to sell in packages wrapped in blue paper, with the words "Mrs. G. B. Miller & Co. Best Smoking Tobacco, 97 Columbia Street, New York," printed thereon; and that the defendant, intending to injure them in their sales and deprive them of their profits, deceitfully and fraudulently prepared and made smoking tobacco in packages of the same size, shape, color and appearance, with the words "The Mrs. C. B. Müller & Co. Best Smoking Tobacco, 437½ Grove Street, Jersey City," in imitation of the goods of the plaintiffs, and fraudulently represented and sold the same as the article manufactured, vended and sold by the plaintiffs, when, in truth, the plaintiffs had not manufactured the same; by reason of which the plaintiffs were deprived of the sale of their goods and the consequent profits.

The question is whether this state of facts presents an actionable injury.

It is not called for in this case to follow the demurrant in his discussion of the rules specially applicable to suits for the appropriation of others' trade-marks. The case here presents a grievance analogous to that in some, but not all its features.

Trade-marks are protected as such, as a species of property; not that one can have an exclusive right in the signs, words or symbols used *per se*; because one may stamp his cloth with the same mark or sign that another has acquired the exclusive right to use on his manufacture of iron. But when one has caused a particular species of manufacture to be characterized by certain marks or symbols, and given the article such currency in trade that it is identified with the mark, the law holds him to be possessed of a property right in such mark in connection with that species of manufacture, which it protects by action or injunction against any unlicensed use of it by others. Intentional fraud in such use is not essential to entitle the owner to protection. The injury is complete if the same label or mark is used which recommends the article to the public by the established reputation of another. *Coffeen v. Bunton*, 4 *McLean*, 516; *Dale v. Smithson*, 12 *Abb.*

Pr., 257; *Ainsworth v. Walmsly*, *L. R.*, 1 *Eq.*, 518. To violate such right is a legal fraud.

But there is another type of injury to the same substantial right, distinguished mainly by the essential feature presented, of actual fraudulent intent in its perpetration. This wrong the Courts have ever been equally swift to redress. It is said that the markets are free and open to make and sell any lawful commodity which one has sufficient skill and energy to fabricate and vend, unless there exist in some other the protection which the law of patents affords, and this is doubtless true; but every one should be and is required to depend for his success upon his own character and fame, and the quality of his own productions. He may not sail under false colors and sell his productions for those of others. To do so is to impose upon the public, and specially to defraud him whose right place in the market is filled with spurious goods. That is not fair competition; it is closer akin to piracy. The inventor of an unpatented article has no exclusive right to make and vend it; but if others make and sell it, they have no right to put it upon the public as the manufacture of the inventor, nor to adopt his label or trade-mark, nor one so like his as to lead the public to suppose that the article to which it is affixed is the manufacture of the inventor. *Davis v. Kendall*, 2 *R. I.*, 366.

The legal wrong is in fraudulently supplanting the maker of the genuine article by a false one sold as his own; whether it be by the adoption of his mark or by any deceit and false representation likely to deceive the public and accomplish that end, is material only in form. The injurious result is the same if the wrong be committed in either way. The cases differ only in their requirements of proof.

In *Wotherspoon v. Currie*, 5 *L. R.*, (*H. L. Cas.*), 508, it is said by Lord Chelmsford that where a trade-mark is not actually copied, fraud is a necessary element in the consideration of every question of this description—that is, that the party accused must have done the act complained of with the fraudulent design of passing off his own goods as those of the party entitled to the exclusive use of the trade-mark.

108 Mrs. G. B. Miller & Co. Tobacco Manu'y vs. Commerce.

Crawshaw v. Thompson, 4 M. & G., 357, is a case in pointed illustration of the legal rule in frauds of this character. The declaration there alleged that the defendants fraudulently sold certain bars of iron as and for, and under the false color and pretence that the same were bars of iron of the genuine manufacture of the plaintiff. The right of recovery on proof of the averment was not questioned. The earlier English cases bearing on the subject are there referred to and need no citation here.

The declaration here does not count upon the unlawful adoption by defendant of plaintiff's trade-mark, but charges that the defendant sold his goods under the representation and pretence that they were the genuine goods manufactured by the plaintiff, which representations and pretences were false and fraudulent: whereby they were to an extent injurious to them—shut out of the market: and that as devices in aid of their fraud, they fabricated deceptive imitations of the plaintiff's labels and packing. The cases upon this subject all hold this to be an actionable injury. The underlying principle is that one who, by making representations, knowingly false, causing injury to another, is liable for the consequences of his falsehood. The following are cases bearing on upon this subject: *Sykes v. Sykes*, 3 B. & C., 541; *Archbold v. Sweet*, 5 C. & P., 219; *Blofeld v. Payne*, 4 B. & Ad., 410; *Thompson v. Winchester*, 19 Pick., 214; *Lemoine v. Santon*, 2 E. D. Smith, 343; *Marsh, et al. v. Billings, et al.*, 7 Cush., 322; *Holmes v. Holmes, et al.*, 37 Conn., 278; *Morison v. Talman*, 2 M. & G., 385.

In the case last cited the declaration used was in form and in all its essential averments like the one before us, and was brought under criticism on motion in arrest of judgment. The point principally made against it was that action would not lie for such fraud, but on the sufficiency of the averment of a false representation by the defendant that the goods sold by him had been prepared by the plaintiff. It was held sufficient by all the Judges, and judgment passed for the plaintiff.

A precedent is found for this declaration in *Sykes v. Sykes*, above referred to. Also in 2 *Chitty Pl.*, 697, 698.

The case of *Marsh, et al. v. Bilings, et al., supra*, was an action grounded upon the same character of injury as that counted upon by the plaintiff in this suit. The defendant there was charged with holding himself out as, and falsely representing himself to be, authorized by the proprietor of a large hotel to convey guests between the hotel and the principal railway station, and using upon his coaches the signs and devices with which the plaintiff marked his carriages, thus obtaining passengers in fraud of the plaintiff, who, by agreement with the proprietor of the hotel, had the exclusive patronage of the house and the sole right to place the hotel name upon his vehicles. The same principle was there applied, and the right of action maintained—not on the ground that the defendant might not rightfully carry passengers between the hotel and railway, nor on the ground that he might not put the name of the hotel on his coaches as indicating where he would carry persons to whom he might honestly engage his services, but on the ground that he could not fraudulently take away the plaintiff's passengers by passing himself off upon the public as possessed of patronage and privilege which the plaintiff held exclusively, or designedly use in aid of his fraud the signs which the plaintiff had rightfully adopted.

Indeed, the cases are in entire harmony in maintaining the principles upon which the plaintiff's action proceeds.

The demurrer should be overruled, with costs.

109 Humphreys' Specific Homeop. Medicine Co. *vs.* Wenz.

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CIRCUIT COURT UNITED STATES, DISTRICT
OF NEW JERSEY. IN EQUITY.

HUMPHREYS' SPECIFIC HOMEOPATHIC MEDICINE CO.

vs.

WENZ.

DECIDED 24 NOVEMBER, 1882.

REPORTED 14 FEDERAL REP., 250.

Numbers of Homeopathic Specifics.

1. TRADE-MARK—NUMBERS.—Numbers constitute a lawful trade-mark when they indicate origin or proprietorship, and are used in combination with words and other numerals.
2. SAME—WORDS.—The words “homeopathic specifics,” standing alone, cannot be appropriated as a trade-mark; but can be when used in connection with serial numbers.
3. NUMBER ALONE MAY BE EMPLOYED.—The complainant was the first to adopt such a method of putting up homeopathic medicines, and by reason thereof certain specific remedies have come to be known in the trade by numbers alone.
4. SAME—VIOLATION BY IMITATION OF.—The use of another name, such as “Reeves' improved,” in place of “Humphreys',” before the words

"homeopathic specifics," does not take the defendant out of the class of imitators; such prefix does not meet the difficulty, as the remedies are purchased by the public by the numbers alone, and the defendant has made use of such numbers.

5. RESEMBLANCE—INTENT TO DECEIVE AND MISLEAD.—If the resemblance is such as not only to plainly suggest an intention to deceive, but is calculated to mislead the public, who are purchasers of the article, and thus to injure the sale of the goods of the proprietor of the original device, the injured party is entitled to redress.

A. J. Todd, and *A. Q. Keasbey*, for complainant.

J. Frank Fort, for defendant.

NIXON, D. J.:

The bill of complaint filed in the above case alleges that the complainant is a corporation, organized under the laws of the State of New York, by the name and title of "The Humphreys' Specific Homeopathic Medicine Company;" that for upwards of 20 years past it has manufactured and sold a series of 35 homeopathic specific medicines or remedies, which have been put up in bottles containing thereon labels and wrappers having printed thereon the words "homeopathic specific," in connection with numbers in a series, and particular reference to diseases or infirmities for which the medicines in the bottles are intended as specifics; that the complainant's designation of said series of homeopathic specific medicines is by the words "homeopathic specific," and by numbers in a series as follows: No. 1, fever, congestion, inflammations; No. 2, worm fever or worm disease; No. 3, colic, crying, and wakefulness of infants; No. 4, diarrhoea of children and adults; No. 5, dysentery, gripings, bilious colic; No. 6, cholera, cholera morbus, and vomiting; No. 7, coughs, colds, hoarseness, bronchitis; No. 8, toothache, face-ache, neuralgia; No. 9, headache, sick headache, vertigo; No. 10, dyspepsia, biliousness, costiveness; and so on, upwards, in the same serial order, to 35; that by reason of the use of numbers in serial order, in connection with the words "homeopathic specific," the books and pamphlets of the complainant, descriptive of its homeopathic specifics, and the directions therein contained relating to their use,

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could be referred to by the defendant in the sale of his "homeopathic specifics," and such books could be used with the defendant's medicines to a large extent in the treatment of diseases, with the serial order of specifics put up and sold by him, equally as well as with the serial order of specifics put up and sold by the complainant.

The bill further claims that the complainant was the first to use specifics in homeopathy, and the first to adopt the "homeopathic specifics," and to use in connection with these words numbers to designate the medicines and the diseases for which such medicines are intended as specific; that such adoption is not descriptive, but denotes origin and ownership; that the use of said numbers in connection with these words is wholly arbitrary, as symbols to denote origin and ownership; that such use has become so acknowledged and acquiesced in by the public that the specifics are now known by numbers only, and are ordered and called as such, instead of by the names of the particular complaints or diseases or remedies therefor; and that its medicines thus put up in bottles labeled as "homeopathic specifics," and numbered in series, have acquired a high reputation throughout the United States and have commanded and still command an extensive sale and have become a great source of profit to the complainant.

The charge is that the defendant has infringed the complainant's trade-mark by taking bottles of about the size of complainant's, putting labels thereon, and printing in conspicuous letters the words "homeopathic specifics," and numbering the series from 1 to 40, as the complainant's are numbered from 1 to 35; that in regard to the most usual remedies for the most common complaints or diseases he has adopted the same numbers for the same diseases, that complainant has used for many years; and that the effect of such imitations is to deceive the public by making purchasers believe, when buying the specific of the defendant, that they are obtaining the complainant's remedies.

An application is now made for an injunction to restrain the defendant, *pendente lite*, from the continued use of such labels in connection with numbers.

The case presents an interesting question. A trade-mark is any proper mark by which goods and wares of the owner or manufacturer are known in the trade. Courts of Equity have two objects in view in granting injunctions against their imitation: (1) To secure to the individual adopting one the profits of his skill, industry, and enterprise; (2) to protect the public against fraud. There are limitations upon the devices or symbols that may be adopted. To be lawful they must have reference to origin or ownership, and not to quality. They must not be of such a character that their use will give a monopoly in the sale of any goods other than those produced by the person who invokes the protection of the Court?

1. Mere numbers are never the objects of a trade-mark, where they are employed to indicate quality, but they may be where they may stand for origin or proprietorship, in combination with words and other numerals. These principles are elementary, and have been stated in order to test the case by them.

2. It cannot be successfully maintained that the words "homeopathic specifics," standing alone, can be appropriated by any one as a trade-mark; they are too broad, and if allowed would give the taker a monopoly in a school of medicine which Hahnemann, its founder, threw open to all disciples. *Canal Co. v. Clark*, 13 Wall., 311.

A "specific" in medicine, says Dunglison, is a substance to which is attributed the property of removing directly one disease rather than any other. A "homeopathic specific," therefore, is a remedy pertaining to homeopathy which exerts a special action in the prevention or cure of a disease. The name can no more be appropriated, and is no more the property of Humphreys, than any other practitioner of the homeopathic system of therapeutics. But I do not understand that the complainant's solicitor claims this. What is contended for is the right to use these words in connection with serial numbers.

3. Humphreys was the first to adopt such a method of putting up homeopathic medicines, and the proof is that certain remedies for particular complaints or diseases have come to be known in the trade by the number which he adopted to designate them;

that the defendant has in several instances applied the same numbers to the same remedy; and that such an imitation is calculated to impose upon unwary purchasers, who are in the habit of buying Humphreys' specifics by the numbers with which he indicates them.

4. The defendant insists that the use of the words "Reeves' Improved" before "homeopathic specifics," takes him out of the class of imitators or infringers, as they sufficiently reveal to purchasers that they are not getting Humphreys' remedies; but that prefix to "specifics" does not meet the difficulty, which is that some of these remedies are purchased by the public by numbers, and that he has copied the complainant's numbers for the same specifics. Besides, it is now well settled that to entitle the proprietor of a trade-mark to relief, or to establish a case of infringement, it is not necessary to show that the imitation is exact in all particulars.

5. If the resemblance is such as not only to plainly suggest an intention to deceive, but is calculated to mislead the public, who are purchasers of the article, and thus to injure the sale of the goods of the proprietor of the original device, the injured party is entitled to redress. *Walton v. Crowley*, 3 *Blatchf.*, 440.

It is difficult to believe that there was no intention to deceive in this case, although the defendant swears that adopting the same numbers which Humphreys has used was purely accidental. He states in his affidavit "that the names of diseases claimed to be cured by the remedies of the defendant are different by the numbers from those of the complainant, and that whatever similarity there may be in diseases and numbers arises from accident and not intention.

Humphreys' specifics for fevers, diarrhœa, colds, dyspepsia, rheumatism, whooping-cough, gravel, nervous debility, urinary difficulties, painful menses, and epilepsy, are respectively numbered, 1, 4, 7, 10, 15, 20, 27, 28, 30, 31, and 33. The defendant has printed his list with the same diseases or complaints designated by precisely the same numbers. If this was an accident and not intention it is one of the most remarkable coincidences that ever occurred, and is a serious tax upon human credulity.

A preliminary injunction must issue against the defendant, restraining him from using the above numbers, in connection with the remedies for the above diseases or complaints, until the further order of the Court.

See *Burton v. Stratton*, 12 *Fed. Rep.*, 696, and note, 704; *Shaw Stocking Co. v. Mack*, *Id.*, 707, and note 715; *Ginter v. Kinney Tobacco Co.*, *Id.*, 782; *Wm. Rogers Manuf'g Co. v. Rogers Manuf'g Co.*, 11 *Fed. Rep.*, 495; *Singer Manuf'g Co. v. Riley*, *Id.*, 706; *Hostetter v. Adams*, 10 *Fed. Rep.*, 838.

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COURT OF APPEALS, STATE OF NEW YORK.
IN EQUITY.

ALFRED LOW, ET AL., RESPONDENTS,

*vs.*FRANCIS X. HART, APPELLANT.

DECIDED 12 DECEMBER, 1882.

REPORTED 90 N. Y., 457.

“Brown Windsor Soap” Case.

1. Where, in an action to restrain the infringement of a trade-mark, it is shown that defendant has in his store, and offers for sale, a spurious article, with an imitation of plaintiffs' trade-mark thereon, although but a single sale is proved, it is sufficient to sustain an injunction against a continuance of the wrong.
2. An action for such injunction will not be defeated solely on the ground that on the day it was brought defendant happened not to have any of the article on hand.
3. Declarations of the clerk, made at the time of the sale and in connection therewith, are competent evidence.
4. Costs in such an action are in the discretion of the Court.

APPEAL from judgment of the General Term of the Supreme Court, in the First Judicial Department; entered upon an order made January 28, 1881, which affirmed a judgment in favor of plaintiffs, entered upon a decision of the Court on trial at Special Term. The nature of the action and the material facts are stated in the opinion.

Charles H. Smith, for appellant.

It was error to receive in evidence the declaration of the defendant's clerk, made on the sale of the soap, for no clerk is an agent to admit that his employer is committing or about to perpetrate a trespass or a tort. (*Clark v. Met. Bk.*, 3 *Duer*, 241; *Terry v. Fargo*, 10 *Johns.*, 114; *Brisbane v. Adams*, 3 *N. Y.*, 129). The complaint for injunction should have separately alleged the use of the label was with wrongful intent. (*Hostetter's Bitters Case*, *Daily Reg.*, Feb. 21, 1882). To sell an article in imitation of another's is not actionable in the State Court, for injunction. (*Comstock v. White*, 18 *How.*, 421; *Southern v. How*, *Popham*, 144; *Taylor v. Carpenter*, 2 *W. & M.*, 1; *Hart v. Mayor of Albany*, 9 *Wend.*, 571; *Jerome v. Ross*, 7 *Johns. Ch.*, 315). The plaintiffs' remedy is not this bill in equity for injunction, but at law for damages. (*Coulter v. Murray*, 4 *Daly*, 506; *Hudson Co. v. N. Y. & E. R. R. Co.*, 9 *Paige*, 323; *Marshal v. Peters*, 12 *How.*, 218; *People, ex rel. Floyd v. Conklin*, 5 *Hun*, 452; *Savage v. Allen*, 54 *N. Y.*, 463; *Code*, secs. 603-4; *Spooner v. McCornell*, *McLean*, 388). The accidental sale of a package of three cakes of spurious soap on one occasion is not evidence of a habit or intention of making sale of spurious soap time after time for five years. (*Sauder v. Hoffman*, 62 *N. Y.*, 248). One sale, four months before this suit, to plaintiffs' agent, who knew what he was buying and was not deceived, does not authorize the wholesale inference that the defendant was and is selling the soap and is amenable to injunction. (*Mason v. Lord*, 40 *N. Y.*, 484; *Moet v. Canston*, 10 *L. T. (N. S.)*, 395).

H. G. Batcheller, for respondents.

The general rule, in equity, is to allow costs to the prevailing party. (*Hovey v. Stevens*, 3 *W. & M. [U. S.]* 17, 18). The

right to an injunction usually carries with it the right to costs. (*Moet v. Canston*, 10 *L. T. [N. S.]*, 391; *S. C.*, 33 *Beav.*, 578; *Sevres v. O'Sullivan*, 1 *Month. Law Bul.*, 43; *Burgess v. Hotley*, 26 *Beav.*, 249; *Burgess v. Hill*, 25 *Id.*, 244). It was of no consequence whether witness O'Sullivan was employed by plaintiffs or whether he was deceived. The question to be decided was, whether the bogus label "D" was calculated to deceive the incautious and unwary. It was immaterial when plaintiffs first notified defendant of the existence of the bogus label and imitation of their soap, or whether he was notified at all. Ignorance is no excuse. (*Coleman v. Crump*, 70 *N. Y.*, 573).

RAPALLO, J.:

This action was brought to restrain the infringement by the defendants of the plaintiffs' trade-mark.

It was admitted by the pleadings that the plaintiffs were the manufacturers, in England, of an article of soap, and the proprietors of a trade-mark, under which they sold it, and which consisted of the name of "Low's Highly Perfumed Brown Windsor Soap," and a wrapper illuminated with colors and type. The complaint further alleged that the defendant, during five years preceding the commencement of the action, wrongfully offered for sale in the City of New York and elsewhere, an article in imitation of plaintiffs' article, put up in similar packages, with precisely similar labels; that the imitation was calculated to, and did deceive the public, and the plaintiffs sustained damage thereby. These latter allegations were denied: and the defendant set up, in his answer, that the plaintiffs' label was not within the terms of the Act of Congress concerning trade-marks. (*U. S. Rev. Stat.*, *secs.* 4937-4947), and was not a trade-mark within the limits of the United States.

1. On the trial the plaintiffs proved a single sale of the spurious article at defendant's store, by defendant's clerk in charge thereof, on the 19th of July, 1878. The sale was made to a detective in the employ of plaintiffs. The detective testified that he asked the clerk whether he had any of Low's Brown Windsor Soap, and he said he had the article. The defendant's counsel objected to this

evidence on the ground that the defendant was not present, but the Court overruled the objection, and exception was taken. The witness then testified that the clerk said the article was genuine, and he could give witness any complement of it he wanted. Witness then produced the package, and marked it for identification. That he was familiar with the genuine article and the imitation of it, and that the article he purchased was an imitation, and had upon it the false label attached to the complaint, and which was proved by plaintiffs' agent to be an imitation of plaintiffs' label.

2. This action was commenced on the 5th of October, 1878, and the Court found as a fact that at that time the defendant did not have on hand for sale, or otherwise, any of the imitation soap or labels.

The testimony of the defendant shows that his dealings in the article were very trifling, and he denied knowledge that the article sold by him was not genuine. It was proved, however, that the difference in price between the genuine article and the imitation was very great, but the defendant, although he recollected purchasing the soap from various parties, failed to recollect any of the prices paid.

No damages were asked for, and the Court awarded a perpetual injunction, with costs. The imposition of these costs is the principal subject of the appeal, and the defendant contends that the evidence was not sufficient to authorize the awarding of the injunction.

1. Although the proof does not establish an infringement by the defendant to any great extent, yet we think that where it is shown that a dealer has the imitated article in his store, and offers it for sale as genuine, even though but a single sale is proved, that is sufficient to sustain an injunction against a continuance of the wrong, and that an action for such injunction will not be defeated solely on the ground that on the day it is brought, the dealer happens not to have any of the article on hand.

3. The declarations of the clerk in charge at the time of the sale, made in connection therewith, were we think competent. It was his business to sell, and offer for sale, the merchandise in the store, and what he said and did in these respects must be taken to

have been authorized by his employer. Though the case is comparatively a slight one, we think it is sufficient to sustain the judgment for an injunction. As to the question of costs, these were in the discretion of the Court. It is apparent, from the opinion of the Court, that the consideration which influenced it in awarding costs, was that the defendant, though conceding the proprietorship of the plaintiffs, contested their right to protect their trade-mark in this country, on the ground that they had not brought themselves within the provisions of the Act of Congress (a position entirely untenable), and thus put the plaintiffs to unnecessary litigation and expense.

4. The judgment should be affirmed, with costs.

All concur.

Judgment affirmed.

Ex Parte Ames.111

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IN THE UNITED STATES PATENT OFFICE.

EX PARTE AMES.

DECIDED 19 DECEMBER, 1882.

REPORTED 23 O. G., 344.

"Albany Beef" Case.

TRADE-MARK—"ALBANY BEEF."

The fact that the applicant has devised for the first time a practicable method of canning sturgeon would not entitle him to the exclusive use of the words "Albany Beef," as a trade-mark for such canned sturgeon, it appearing that such words have gone into use as a name for sturgeon.

TRADE-MARK.—Canned Sturgeon.

APPEAL from the Primary Examiner.

APPLICATION filed November 1, 1882.

Mr. F. V. Briesen, for the appellant.

MARBLE, *Commissioner*.

Appeal is taken from the decision of the Examiner refusing to register the words "Albany Beef" as a trade-mark for canned sturgeon. In his letters respecting the application the Examiner states, on information, that these words have long been in use in Albany and its vicinity to designate sturgeon, a food fish which is very common in that market.

The applicant, without denying the statements of the Examiner, states that he seeks to register these words as a trade-mark solely for use upon canned or preserved sturgeon. He claims that he has discovered a method of preserving and canning sturgeon for which he has a pending application in this office, and that he is the first and only person who has succeeded in preserving sturgeon, and is therefore entitled to the exclusive use of the words "Albany Beef" upon the commodity invented by him. The applicant relies upon the case of *Societe la Anonyme, et al. v. Baxter, et al.*, (14 O. G., 679). There does not seem to have been any question in that case as to the validity of the trade-mark. The decision, in fact, does not state what the trade-mark was. The only question seems to have been whether the mark was applied by the parties to the same class of goods. The mark was applied by the plaintiffs to dry white oxide of zinc, while the defendants applied the mark to that article when ground in oil, and the decision was that the defendants were entitled to use the mark upon the goods manufactured by them, notwithstanding they contained as an ingredient an article made by the plaintiffs. The Court said:

It is true that the oxide is intended to be ground with oil for a paint. So flour is intended to be made into bread. But if a baker should falsely stamp his bread with the mark of a particular brand of flour, the maker of such brand, if having a trade-mark therefor, could not claim that the baker had violated his trade-mark, and so of any other raw material which enters as an ingredient into a compound or article of manufacture.

The question in the present case is not whether the sturgeon as prepared by the applicant differs essentially or in its ingredients from fresh sturgeon as offered in the markets, but whether the descriptive or the proper name of one of these commodities can be

appropriated as a trade-mark for the other. Canned sturgeon is no less sturgeon, and if the words "Albany Beef" are recognized in the trade as a proper designation for sturgeon, the applicant has as little claim to the exclusive right to use the words "Albany Beef" upon canned sturgeon as the word "sturgeon" itself. If by reason of his invention or discovery the applicant has been able to produce a new article of manufacture, and shall secure to himself an exclusive monopoly in the manufacture and sale of the same by duly obtaining a patent therefor, he will of course be entitled to the use of such apt and descriptive terms as he shall see fit to adopt as the name of such article. Thus, if it shall appear that he was the first to can sturgeon, he might, perhaps, be entitled to the exclusive use of the words "canned sturgeon," since no one else would be entitled to make or offer for sale such goods while his patent was outstanding. It does not appear as a matter of fact, however, that the appellant has the exclusive right to manufacture and sell preserved sturgeon, no patent having been thus far issued for such invention. Even should such a patent be granted for preserved sturgeon as a new article of manufacture, the applicant would not be entitled to appropriate for his exclusive use as the name thereof the words "Albany Beef," which had already gained currency as the name of the fish itself without reference to its state or manner of treatment. Thus the inventor who was the first to preserve and can corn, beef, or other commodities would not by that fact be entitled to the exclusive use of the proper names "corn" and "beef" as a trade-mark for those commodities. The very purpose of applicant's process, as I understand, is to preserve and extend the market for sturgeon, and whatever may be the applicant's mode of treatment the fish itself, of course, forms the basis and largest ingredient of the article, and the word "sturgeon," or the equivalent phrase "Albany Beef," would be descriptive of that fact when applied to the goods.

The applicant notes a formal objection to the reception of the Examiner's statement unsupported by affidavit as evidence of the facts in relation to the use of the words "Albany Beef." I do not understand the applicant to deny, however, the substantial

truth of the Examiner's allegations. The argument of the brief proceeds upon the assumption that the Examiner is correct in his statement of the facts. In view of these facts, I see no reason for enforcing in this case the provisions of Rule 65 relating to the conduct of proceedings in the matter of applications for patents. That rule does not apply to applications for registration of trademarks, and applicants have no rights thereunder.

The decision of the Examiner is affirmed.

Jacoby, *et al.* vs. Lopez, *et al.*112

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IN THE UNITED STATES PATENT OFFICE.

S. JACOBY & CO.*vs.*

LOPEZ, FERNANDEZ Y CA.

DECIDED 21 DECEMBER, 1882.

REPORTED 23 O. G., 342.

“*Puck*” Cigar Case.

1. TRADE-MARK—EVIDENCE OF TITLE—REGISTRATION UNDER LAW OF 1874.—A registration of a trade-mark effected under the law of 1874, is evidence of the fact that the persons named therein at that time claimed the right, and were allowed to register the trade-mark, and depended for its legal effect upon the provisions of the law under which it was effected.
2. SAME—SAME.—When introduced in evidence in a contested case to support an applicant's right to a registration under the new law, it should be accompanied with evidence identifying the applicant as the person therein named, and showing that the right has been maintained by the continued use of the trade-mark, and that it has not in the meantime passed by assignment or by changes in the composition of the firm to other persons.

TRADE-MARK.—Cigars.

APPEAL from the Examiner of Interferences.

APPLICATION of S. Jacoby & Co., filed May 12, 1882. Trade-Mark of Lopez, Fernandez y Ca., registered March 21, 1882.

Messrs. V. Briesen & Betts, for Jacoby & Co.

G. H. Wilcox, for Lopez, Fernandez y Ca.

MARBLE, *Commissioner*.

This is an interference instituted to try the question of right to the use of the word "Puck" as a trade-mark for cigars, cigarettes, &c., between Jacoby & Co., applicants for registration, and Lopez, Fernandez y Ca., registrants. The applications of the respective parties were pending at the same time, and it was clearly an inadvertence under the rules that the certificate of registration issued to one of the parties without notice to the other, and the applicants should not be prejudiced thereby in this proceeding. The case will be considered, therefore, as though both parties were still applicants for registration.

Lopez, Fernandez y Ca. have submitted no evidence which is admissible under the rules of this office. They filed in the case, without notice to the other side, a certificate of an officer of the general government of the Island of Cuba, to the effect that the word "Puck" was registered at a certain office in Cuba, in 1876, in the name of Martin Bengoechea & Co., under the law then in force; that said trade-mark became the property of Lopez, Fernandez y Ca. on the 18th of July, 1881, and that said mark was registered on the 29th of May, 1882, in accordance with the new law, then in force, by said parties, Messrs. Lopez, Fernandez y Ca. The certificate cannot be considered as proper evidence in this case, for the reason that no notice was given to the other side of any intention to read and rely upon the same at the hearing and the office has, moreover, no means of ascertaining the conditions upon which registration may be effected in the Island of Cuba, nor of the duties and powers of the officer purporting to make the certificate. The parties offering this certificate themselves admit the inadmissibility of the same for the purpose of

proving their rights in this case, and rely entirely upon their having been the first to file an application in this office.

In behalf of Jacoby & Co. notice was duly given to the other side that they would at the hearing read and rely upon the trade-mark certificate No. 5,366, dated November 27, 1877, and the papers pertaining thereto now on file in this office. It is necessary, therefore, to consider what effect is to be given to this certificate as evidence of title to the trade-mark in the present applicants.

It may be observed, in the first place, that this certificate and the papers relating thereto stand as a solitary piece of evidence, unaccompanied by any testimony identifying the registrants therein named with the present applicants. While documentary evidence speaks for itself as to the facts contained therein, it is ordinarily introduced to the cognizance of the tribunal through human testimony. This record in the office, while evidence of the fact that certain proceedings were had under the laws then in force by certain applicants bearing the name of Jacoby & Co., furnishes no evidence that the present applicants, or other persons or firms bearing the same name, are the parties named in such record. The law does not presume identity of persons from an identity of names, but the fact must be established in every case affirmatively by proper evidence. Thus it has been repeatedly held in this office that a foreign patent granted to a person of the same name as the applicant, is not evidence of itself that a foreign patent has been granted to such applicant in a contested proceeding. Aside from this technical defect, however, there is a more serious objection to this certificate when considered as evidence of the present right of the applicants to the trade-mark claimed by them. While public documents are entitled to an extraordinary degree of confidence, and while it is true that it is not necessary that they should be confirmed by the ordinary tests of truth, it is not true that the contents of such documents are admissible as evidence for every purpose. Their legal effect as evidence depends largely upon the provisions and purpose of the law in accordance with which they were called into existence.

It is to be remembered that the trade-mark law under which this registration was effected, has since been declared unconstitutional and void. All registrations, therefore, effected under the provisions of that law have lost their *status* as *prima facie* evidence of present ownership of the trade-mark therein named. That is the immediate result of vacating the certificate. Thus, if a patent were revoked or annulled, it would cease to import the existence of the conditions necessary to constitute the patentee the first and lawful inventor. The record made in the Patent Office in the course of applying for and obtaining the certificate of the patent is evidence of the existence of what was supposed at the time to be the applicant's right, depending for its force and effect upon the nature of the right and the provisions of the law then in force.

7. This record, therefore, is evidence that Jacoby & Co. at that time claimed the right and were allowed to register a certain trade-mark under the provisions of the law then in force.

The question now before the office is whether Jacoby & Co. have since maintained that right, so that they have at the present time the exclusive right to the trade-mark in question, and are entitled to register the same under the provisions of the present law. Under the present law an applicant is only entitled to registration where it appears that he is the lawful owner of a legal trade-mark actually used in commerce with foreign nations or with Indian tribes. Under the former statute an applicant was entitled to register his mark, although it had never been in actual use, provided he announced his intention to use the same, and although it had never been used nor was intended to be used in commerce with foreign nations or with Indian tribes.

Referring to the application upon which the certificate of 1877 was granted, I find that the applicants there stated that the "said trade-mark has just been adopted and its use just commenced." Accepting this statement as true, it might not be considered sufficient to show a legal title to the trade-mark at common law, such as would justify a registration under the present Act. It is well understood that the right to the exclusive use of a word or symbol, as a trade-mark at common law depends upon the fact that it is

actually used in commerce, and has become associated in the public mind with the origin and ownership of the goods to which it is attached.

2. Assuming, however, that the trade-mark was actually in use, and that the registrants had completed a legal title thereto, at the time of the said registration, there is still no evidence that this right has since been maintained by the continued use of the trade-mark, and that it has not in the meantime passed by assignment or by changes in the composition of the firm to other persons. It is not sufficient in the case of a trade-mark, as in the case of an invention, to show that it has once been recognized and used, but the right thereto can only be maintained by constant use of the same upon a particular class of goods. The owner of a trade-mark may forfeit or abandon his right by discontinuing its use, and it may then fall into the public domain, or be appropriated by another manufacturer as his trade-mark. The evidence, therefore, afforded by this certificate is radically defective, in that it fails to show a present legal title to the trade-mark. The question whether, in a contest of priority, under the present law the parties can only be permitted to trace back their title to the time when they first began to use the trade-mark in commerce with foreign nations or Indian tribes, and whether, therefore, a trade-mark registration effected under the old law, which did not require that the trade-mark should have been used in commerce with foreign nations or with Indian tribes, is evidence of an applicant's right to register the mark under the present law, I do not now decide. In the absence of all other evidence, then, I think that the date of filing the respective applications must be taken as the decisive fact. Lopez, Fernandez y Ca., having been the first to file their application, are hereby adjudged to have the prior right and title to the use of the trade-mark in controversy.

The decision of the Examiner of Interferences is overruled.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

LA CROIX

vs.

MAY, AND OTHERS.

DECIDED JANUARY, 1883.

REPORTED 15 FEDERAL REP., 236.

1. TRADE-MARKS—RIGHTS OF ALIENS—PROPERTY IN, AS AFFECTED BY ACTS OF CONGRESS.—The fact that one is an alien does not affect his right of property in a trade-mark; but that fact is a necessary allegation to establish the requisite diversity of citizenship to confer jurisdiction upon a Federal Court. The Acts of Congress fortify the common law right to a trade-mark by conferring a statutory title upon the owner, but “property in trade-marks does not derive its existence from an Act of Congress.” 100 U. S., 82. By the express terms of section 10 of the present Act of Congress the common law right in trade-marks is preserved intact.
2. SAME—DEMURRER.—Where the demurrer was to the whole bill, and the bill was in itself sufficient, aside from the allegations contained in it, upon which the demurrer was taken, the demurrer was overruled.

S. W. Weiss, for complainant.

Briesen & Betts, for defendants.

WALLACE, J.:

1. The facts alleged in the complainant's bill entitle him to an injunction restraining defendants from the use of his trade-mark, irrespective of the rights which he acquired by the registration of his trade-mark under the Act of Congress of March 3rd, 1881. *Taylor v. Carpenter*, 3 *Story*, 458; 2 *Wood & M.*, 1; *Taylor v. Carpenter*, 11 *Paige*, 296. The fact that complainant is an alien does not affect his right of property in a trade-mark; but that fact, as it establishes the requisite diversity of citizenship between the parties to confer jurisdiction upon this Court, is indispensable to the cause of action alleged.

The Act of Congress fortifies the common law right to a trade-mark by conferring a statutory title upon the owner; but, as was said of a former Act, (See *Trade-Mark Cases*, 100 *U. S.*, 82,) „property in trade-marks does not derive its existence from an Act of Congress.” The present Act does not abridge or qualify the common law right, but, by the express term of section 10, preserves it intact.

2. The theory of the demurrer is that the complainant's statutory title upon the allegations of the bill is invalid. It is not necessary to decide the questions raised, because, as the demurrer is to the whole bill, the bill is sufficient if all the allegations concerning a registration of the trade-mark were eliminated.

Demurrer is overruled.

See *Burton v. Stratton*, 12 *Fed. Rep.*, 696, and note, 704; and *Shaw Stocking Co. v. Mack*, *Id.*, 707, and note, 717.

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UNITED STATES CIRCUIT COURT, NORTHERN
DISTRICT OF ILLINOIS. IN EQUITY.

CLEMENS

vs.

BELFORD, CLARK & CO.

DECIDED 8 JANUARY, 1883.

REPORTED 14 FEDERAL REP., 728.

The "Mark Twain" Case.

1. AUTHOR AND WRITER—RIGHT TO USE OF ASSUMED NAME.—An author or writer has no better or higher right in a *nom de plume* or assumed name, than he has in his baptismal name.
2. SAME—COPYRIGHT THE SOLE PROTECTION.—A person becoming an author can secure to himself the exclusive right to his productions only by a copyright under the laws of the United States; and if he publishes anything without so protecting it, it becomes public property, and any person may republish it, and state the name of the author in such form in the book as he may choose, either upon the title-page or otherwise, as to show who was the author.
3. SAME—PROTECTION OF UNPUBLISHED WORKS.—An author has the right to restrain the publication of any of his literary work which he has never published or dedicated to the public.

4. SAME—FALSE IMPUTATION OF AUTHORSHIP.—An author may restrain the publication of literary matter purporting to have been written by him, but which in fact he never did write; and this rule applies in favor of persons known to the public under an assumed name.
5. SAME—TRADE NAME OR TRADE-MARK—NOT A SUBSTITUTE FOR COPYRIGHT.—An author cannot acquire a right to the protection of his writings under an assumed name as a trade name or trade-mark, and no pseudonym, however ingenious, novel or quaint, can give one any more rights than he would have under his own name, or defeat the policy of the law that the publication of literary matter without protection by copyright has dedicated such matter to the public.

Thos. W. Clark, for complainant.

Hutchinson & Partridge, for defendant.

BLODGETT, D. J.:

The bill in this case states that complainant has, for about 20 years last past, been an author and writer by profession; that he has been in the habit for said time of publishing articles, sketches, books, and other literary matters, composed by him for publication under the name, assumed by him to designate himself as the author and writer of such sketches, articles, books, and other literary matter, of "Mark Twain;" that the said designation of "Mark Twain" has been used by him during the last 20 years as his *nom de plume* or trade-mark as an author; that his said writings, under the designation of "Mark Twain," have acquired great popularity, and met with a ready and continuous sale, and that no other person has been licensed or permitted by him to use said designation of "Mark Twain" as a *nom de plume* or designation of authorship; that the exclusive right of selecting for publication and of publishing in any collective form the sketches, articles, or other writings written and originally published by him under the said name of "Mark Twain," so as to make a book or collection of durable form for publication, by right ought to belong exclusively to him, and is of great value to him in his reputation, and a great security to the public as purchasers of the works purporting to have been written by complainant; that the said defendants have made, printed, put out, and sold, in great

quantities, a certain book—called upon its title page “Sketches by Mark Twain, now first published in complete form. Belford, Clark & Co., 1880”—containing about 369 pages, many or most of which, in one form or another, are substantially like sketches published prior to the year 1880 by complainant; and that said Belford, Clark & Co. had no authority, leave, or license from complainant, or derived from him, to make publication of the said book or any part thereof; that the defendants in their said book, so published by them, placed upon the page next succeeding the leaf whereon the title-page is printed, a preface in these words.

“I have scattered through this volume a mass of matter which has never been in print before, (such as ‘Learned Fables for Good Old Boys and Girls,’ the ‘Jumping Frog Restored to the English Tongue after Martyrdom in the French,’ the ‘Membraneous Croup’ sketch, and many others which I need not specify;) not doing this in order to make an advertisement of it, but because these things seemed instructive.

MARK TWAIN.”

That complainant never gave any authority, leave, or license to the defendants to print or publish any such preface, or any of the representations therein contained, or substantially the same; that complainant has, by the said wrongful acts of the defendants, been greatly injured, and his property in the said *nom de plume* or trade-mark of “Mark Twain” as a commercial designation of authorship has been deteriorated and lessened in value; wherefore he prays damages and profits, and writ of injunction restraining the further publication of said work, and that the plates of such book may be delivered up and destroyed. •

To this bill defendants have filed a special and general demurrer.

The position assumed by the complainant in this bill is that he has the exclusive right to the use of the *nom de plume* or trade-mark of “Mark Twain,” assumed by him, and that defendants can be enjoined by a Court of Equity from using such name without the complainant’s consent.

1. It does not seem to me that an author or writer has or can acquire any better or higher right in a *nom de plume* or assumed name than he has in his Christian or baptismal name.

2. When a person enters the field of authorship he can secure to himself the exclusive right to his writings by a copyright under the laws of the United States. If he publishes anything of which he is the author or compiler, either under his own proper name or an assumed name, without protecting it by copyright, it becomes public property, and any person who chooses to do so has the right to republish it, and to state the name of the author in such form in the book, either upon the title page or otherwise, as to show who was the writer or author thereof. "In this country an author has no exclusive property in his published works except when he has secured and protected it by compliance with the copyright laws of the United States." *Wheaton v. Peters*, 8 *Pet.*, 591; *Clayton v. Stowe*, 2 *Paine*, 382; *Bartlett v. Crittenden*, 5 *McLean*, 33; *Pulte v. Derby, Id.*, 328. "If an author would secure to himself the sole right of printing, publishing, and selling his literary compositions, he must do so under the copyright laws." *Stowe v. Thomas*, 2 *Wall., Jr.*, 549.

The seventh paragraph of this bill charges that many or most of the sketches contained in the book complained of, "in one form or another, are substantially like sketches published prior to the year 1880 by your orator;" but it does not aver that they are or ever were protected by copyright, and by implication concedes their publication without copyright. If they were published without such protection they become public property, and may be republished by any one who chooses to do so.

3. Undoubtedly an author has the right to restrain the publication of any of his literary work which he has never published or given to the public. *Little v. Hall*, 18 *How.*, 165; *Keen v. Wheatly*, 9 *Amer. Law. Rep.*, 3; *Bartlett v. Crittenden*, 5 *McLean*, 32. So, too an author of acquired reputation, and, perhaps, a person who has not obtained any standing before the public as a writer, may restrain another from the publication of literary matter purporting to have been written by him, but which, in fact, was never so written.

4. In other words, no person has the right to hold another out to the world as the author of literary matter which he never wrote; and the same rule would undoubtedly apply in favor of a person known to the public under a *nom de plume*, because no one has the right, either expressly or by implication, falsely or untruly to charge another with the composition or authorship of a literary production which he did not write. Any other rule would permit writers of inferior merit to put their compositions before the public under the names of writers of high standing and authority, thereby perpetrating a fraud not only on the writer whose name is used, but also on the public.

The complainant, however, does not charge in this bill that the book in question, either by the title, preface, or any other matter contained in it, attributes to him the authorship of anything which he in fact did not write.

The bill rests, then, upon the single proposition, is the complainant entitled to invoke the aid of this Court to prevent the defendants from using the complainant's assumed name of "Mark Twain" in connection with the publication of sketches and writings which complainant has heretofore published under that name, and which have not been copyrighted by him? That he could not have done this if these sketches had been published under complainant's proper name is clear from the authorities I have cited, but the complainant seems to assume that he has acquired a right to the protection of his writings under his assumed name as a trade name or trade-mark.

This is the first attempt which has ever come under my notice to protect a writer's exclusive right to a literary property under the law applicable to trade-marks. Literary property is the right which the author or publisher of a literary work has to prevent its multiplication by copies or duplication, and is from its very nature an incorporeal right. William Cobbett could have no greater right to protect a literary production which he gave to the world under the fictitious name of "Peter Porcupine" than that which was published under his own proper name. The invention of a *nom de plume* gives the writer no increase of right over another who uses his own name. Trade-marks are the means by which

the manufacturers of vendible merchandise designate or state to the public the quality of such goods, and the fact that they are the manufacturers of them; and one person may have several trade-marks, designating different kinds of goods or different qualities of the same kind: but another cannot, by the adoption of a *nom de plume*, he allowed to defeat the well-settled rules of the common law in force in this country, that the "publication of a literary work without copyright is a dedication to the public, after which any one may republish it."

5. No pseudonym, however ingenious, novel, or quaint, can give an author any more rights than he would have under his own name. The policy of the law in this country has been settled too long to be now considered doubtful, that the publication of literary matter without protection by copyright has dedicated such matter to the public, and the public are entitled to use it in such form as they may thereafter choose, and to quote, compile, or publish it as the writing of its author. That is, any person who choose to do so, can republish any uncopyrighted literary production, and give the name of the author, either upon the title-page, or otherwise; as best suits the interest or taste of the person so republishing.

Complainant does not say by his bill that the preface to the book in question was not written by him, and that by the publication of this preface, in connection with the sketches, defendants have attributed to him the authorship of something which he never wrote. If he had so charged perhaps he would have made a case entitling him to some relief.

The demurrer is sustained.

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CIRCUIT COURT UNITED STATES, DISTRICT
OF MARYLAND. IN EQUITY.

LORILLARD, AND OTHERS,*vs.*WIGHT.

DECIDED 21 FEBRUARY, 1883.

REPORTED 15 FEDERAL REP., 383.

“Colored Tin Tag” Case.

1. TRADE-MARK—COLORED TIN DEVICES.—Where complainants were the first to adopt and use as a mark for their product tin tags variously colored, with the name of their brand and their own name stamped thereon and fastened upon the outside of their plugs of tobacco, although their patent therefor was declared void after surrender and reissue, they had the right to the device as a trade-mark, the public having come to know their tobacco by the tags of their peculiar color, shape and size.
2. SAME—INFRINGEMENT.—Where defendants use tin tags which are a close imitation of the tags of complainant, so close an imitation that they are calculated to mislead the retail purchaser, whether so intended or not, it is an infringement of complainants' trade-mark, and such use may be enjoined.

MOTION FOR INJUNCTION.

Cowen & Cross, for complainants.

Charles Marshall, for respondent.

Before BOND and MORRIS, JJ.

BOND, J.;

This bill alleges that the complainants are largely engaged in the manufacture and sale of plug tobacco; that it frequently occurred, after a box of tobacco sold by them was emptied, the dealer would refill it with other tobacco not of complainants' manufacture, and by means of the labels and trade-marks on the box, sell it for tobacco of complainants. That to prevent this fraudulent practice the complainants invented a disk of tin, upon which was stamped their name and the names of the brand of tobacco, placed it upon each plug of tobacco in a box, and varied the colors of the disk so as further to distinguish to the eye the brands, and sold their product and advertised it as red tin tag or blue tin tag tobacco. The device in the present suit complainants allege they first adopted about August, 1879. At one time they placed the tag beneath the last covering or skin of the tobacco, where it would be held firmly and show through the surface. For this process they obtained a patent, which afterwards they surrendered and obtained a reissue, which was subsequently declared void, because it embraced more than the original patent. But the bill alleges that they had constantly used the device of a colored tin tag, with their name and the brand of the tobacco stamped upon it, placed upon the outside of the plug as a trade-mark in order to show a purchaser at retail that each plug of tobacco purchased by him was of the Lorillard manufacture. The complainants allege further that having advertised their tobacco largely as "red tin tag," "blue tin tag," "green tin tag" tobacco, it is known generally by those names to consumers, who ask for it at the shops by those appellations, and know that they get Lorillard tobacco when they see the "red tin tag" or "blue tin tag" upon each plug. The defendant, who alleges himself to

be a broker and not a manufacturer of tobacco, denies that complainants have any trade-mark, but alleges that the use of tags to distinguish the grade and quality of many manufactured articles has long been practiced, and that even if the complainants had such a trade-mark defendant has not infringed it, because those whom he represents as broker make tobacco of such different sizes and colors, and use tags with names of brands so different from complainants', that no one would mistake the one for the other.

We think the evidence shows that the Lorillards were the first to adopt and use as a mark for their product the tin tags variously colored, with the name of the brand and their own name stamped thereon and fastened upon the outside of tobacco; that while their patent for fastening these tags on the tobacco was declared void after surrender and reissue, they clearly had the right to the device as a trade-mark, the public having come to know their tobacco by its having on it tin tags of a peculiar color, shape, and size.

This being so, a glance at the device used by the defendant, or those whom he represents as broker, is clearly an imitation of the Lorillard device, or the Lorillards' is an imitation of it. To be sure, the little disk of tin upon the tobacco sold by defendant has upon it different names for the brand, and has not Lorillard's name. But the words are in such small letters that no one without the closest inspection would distinguish the difference. But they are of the same size and shape, of precisely the same color and enamel finish, and the minute letters on them are made with same colored ink.

The proof shows that the complainants have for a long time, and very extensively, advertised their tobacco as "red tin tag" or "blue tin tag" plug tobacco. It may not be sold to jobbers always as such, but it is so inquired for by and sold to the consumer.

The purchasing public, notwithstanding the size of the plugs of tobacco sold by defendant, and their color and flavor, may differ from the size and color and flavor of Lorillard's plug tobacco, would be deceived by the color of the tag and its resemblance to that of complainants; and think the red-tag tobacco of the one is the red-tag tobacco of the other. The defendant contends that

the shape and flavor of the plug sold by him will advise the retail purchaser of the manufacturer. But one seldom determines the manufacture by the size of the piece the dealer gives him for his money, and he cannot taste the tobacco till after he has bought it. Besides, if the size and flavor of the plugs will show the purchasing public they are buying the defendant's or his principal's tobacco, why should he use a tag of any color to distinguish it. For some reason the tags closely resembling those in use by complainants are placed upon the article sold by him, when, as he claims, the public would know his manufacture by the label on the box, the size and shape of the plug, and its flavor.

1. We think the Lorillards were the first to adopt this method of distinguishing the grade and quality of manufactured plug tobacco; that they have a trade-mark; that the defendant's tin tags are a close imitation of it—so close that they are highly calculated to mislead and do mislead the retail purchaser, whether it is so intended or not; and that he should be restrained from selling tobacco having such imitated devices.

2. The defendant has the right to use tin tags, but they must be of such size, shape, and color as will not mislead the public.

An order will be passed in accordance with this opinion.

MORRIS, J., concurred.

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SUPREME COURT, STATE OF NEW YORK.
IN EQUITY.

THE ELECTRO-SILICON COMPANY, APPELLANTS,

vs.

EDWARD C. HAZARD & FRANK GREEN, RESPONDENTS.

DECIDED MARCH, 1883.

REPORTED 89 HUN, N. Y., 292.

“Electro-Silicon” Case.

TRADE-MARK—WHAT WORDS MAY BE ADOPTED AND
USED AS.

1. The plaintiff and its predecessors had for the past twenty years been engaged in preparing and selling a finely pulverized white powder, which they called “*Electro-Silicon*,” and which was used for polishing gold, silver and other metals. It appeared that the preparation, which was made from an infusorial earth, was first prepared by the plaintiff’s predecessors, and sold by them under the name of Electro-Silicon, and also of Silicon, these words being coined for and adopted by them as a trade-mark, a declaration to that effect being filed in the office of the Secretary of State of California, and in the Patent Office at Washing-

ton. The powder was sold for many years, and became valuable for the purpose for which it was designed.

2. The words Electro-Silicon or Silicon, are not descriptive of the article, although it contains some silicon in the form of silica or silicic acid; silicon itself is not, and from its nature cannot be an article of commerce; it exists in very minute quantities, and is an elementary body closely allied to carbon, existing as a dark brown powder or steel grey mass, according to circumstances; it is never found in an uncombined state, but only as a component part of compounds resembling it in some respects, from which it has been separated in very small quantities to furnish specimens for cabinets. **HELD:**

That the plaintiff had by its adoption and use of the words as a trade-mark, acquired a right so to use them, and that it was entitled to restrain their unauthorized use by the defendants.

APPEAL from an order of the Special Term denying a motion to continue an injunction.

Philo Chase, for the appellant.

Hugh Porter, for the respondent.

BRADY, J.:

1. It appears from the papers submitted upon this appeal that about twenty years ago a company in California, called the Electro-Silicon Company, began to put up for sale the article now sold by the plaintiffs under the name of Electro-Silicon.

The company, for the purpose of designating and distinguishing and, indeed, identifying its article with itself as the manufacturer and proprietor, gave to it its own name, electro-silicon, with the two words united so as to form a compound word, and determined to use this word as its trade-mark.

The original proprietor caused the term thus coined to be registered as such in the office of the Secretary of State of California and in the Patent Office at Washington. There was a change of ownership, but the successors of the company, Coffin, Reddington & Co., and the plaintiffs, who became the owner, put up the article with the compound title printed upon its boxes and labels.

It also appears that the article thus designated has acquired a high reputation, and is extensively sold throughout this country

and to a considerable extent in Europe, and that the plaintiff and its predecessors expended large sums of money in advertising and creating the business which is done in the article under the name mentioned, and further that when the original proprietor adopted the compound name mentioned as a trade-mark for its article, no other article of trade had ever been called by the name adopted, or by the designation "Silicon," and that no article of polishing powder besides the plaintiffs' had been sold in the market by the name of "Electro-Silicon" or of "Silicon" except the defendants', which has recently been put upon the market, save an article which was sold under the same name by two persons named Trask and Levy, both of whom were enjoined soon after the infringement was discovered and alleged. It also appears that the plaintiffs' article has been heretofore sold by the defendants, and further that it is not only known by the name of "Electro-Silicon" but by "silicon" alone, by which term it is often called for by consumers. The article itself is a white finely pulverized powder composed of *infusoria*, i. e., deposits of minute animals found in the State of Nevada and in some other places, and showing when analysed, the chemical element silicic acid, or silicon, *plus* oxygen in a large proportion.

It is said by Prof. Chandler, who subjected some of it to chemical analysis and microscopical examination, to be what is called infusorial silica; that it is composed of silicon skeletons, or shells of microscopic organisms, called "*infusoria*," chemically consisting chiefly of silica, with a certain quantity of water and a little oxide of iron, its proper name in the language of science being "infusorial earth" or "infusorial silica" or speaking chemically without any reference to its origin, "silica;" and he says that the name "silicon" is entirely improper as a scientific name for the substance or as giving a true idea of its chemical composition, for the reason that silicon is an element most nearly resembling in its chemical character the element carbon.

2. He further says that this silicon is not a commercial article, it is only known as a chemical curiosity in the laboratory, and is never sold except as a chemical curiosity in very small quantities, for teachers of chemistry to exhibit to their pupils, and it appears

either as a dark brown powder, as black lustrous plates, or in dark needle shaped crystals, and never resembles in any way, the substance known as silica; and further, that silica is never found as a natural material. It occurs in nature only in chemical combination with other substances as a constituent of various minerals, such as the emerald, the topaz, the garnet, etc., and that it has no commercial value, and is not, properly speaking, an article of commerce.

And Mr. Morton, who is President of the Stevens Institute of Technology, in Hoboken, New Jersey, and who formerly occupied the chair of chemistry in the University of Pennsylvania, at Philadelphia, and who for more than twenty years has devoted himself to the study and practice of chemistry, states that he received a lump of infusorial earth, of which he made an analysis, and which he also examined with a microscope, and found that it was in fact a material known as infusorial earth, consisting of minute fragments of the silicon skeletons of *infusoria*, and that its composition was essentially silica, containing also a little water and some oxide of iron. And he further said, to designate this article in its natural or manufactured state, silicon would be, in a scientific sense, entirely improper and indeed absurd, and would be in no wise descriptive of the material here in question, which would certainly not be recognized by that, because silicon is the proper name and designation of one of the elementary bodies closely allied to carbon, and existing as a dark brown powder, or steel gray mass, according to circumstances. The proper name of the article examined by me as above and herewith produced is infusorial earth, and in chemical composition it is essentially silica.

And in a second affidavit he said that for the fuller exposition of the subject he desired to add that the "silicon" described by him in his first affidavit is never found in nature in an uncombined state, but only exists as a component part of compounds resembling it in no respect. It has been separated from such compounds so as to exist by itself, only in a very small way, so as to make specimens for exhibition in chemical cabinets, and has never been so produced in any quantity, and is entirely unknown as an article

of commerce. The entire amount of silicon existing in all the cabinets of all the world would not probably exceed a few pounds.

The only professional chemist examined on behalf of the defendants, in response to the facts thus detailed by Professors Chandler and Morton, was Professor Doremus, who is a known authority in matters of chemistry; but the learned professor does not controvert these allegations. He says that the article under consideration is known to science under various names, such as infusorial earth, infusorial silica; that it is also known to science as an oxide of silicon, *i. e.*, silicon in combination with oxygen, and that while not pure silicon, yet, in view of the large quantity of silicon it contains, he regards the word "silicon" as reasonably descriptive of the same in a commercial sense; that it is a matter of common occurrence to find in the market an article of merchandise the popular name of which is not scientifically accurate, and as an example of this he said: "We find that the white oxide of arsenic known to the public as arsenic, and sold under and by that name, whereas arsenic is an element like silicon," and further, that "the candles known in the market as stearine candles, and commonly sold under and by that name are not made from stearine but from stearic acid; and candles known in the market as wax candles, and commonly sold under and by that name, are made of paraffine and contain no wax."

The Professor, however, so far as he may be considered as dissenting from the conclusions at which Professors Chandler and Morton arrived, must be said to be presenting his views in an argumentative form, and they have not for that reason the force of the depositions made by these experts. It is quite apparent from the statements of both these gentlemen, and particularly from that of Professor Morton, that *silicon* is not a word descriptive of the article which is put up by the plaintiffs. He says: "As we have seen that the amount of silicon existing in all the cabinets of the world would probably not exceed a few pounds; and, of course, obtainable in such limited quantities and being the result of chemical combinations and the product of the laboratory, it would be impossible for it to become an article of commercial use."

The words "Electro-silicon" cannot, therefore, be regarded as descriptive of the article sold by the plaintiff.

In confirmation of this opinion we find that in Webster's Dictionary the word "silicon" is defined to be a dark, nut-brown elementary substance, destitute of metallic lustre and a non-conductor of electricity; it is the base of silax or silica.

And the definition of "*silica*," according to the same authority, is a silicic acid in a state of purity. Indeed, in the action brought by the *Electro-Silicon Company v. Trask*, (59 *How. Pr.*, 189), Justice Van Vorst has stated in his opinion, as appears in this case, that the words "*electro-silicon*" are a combination wholly arbitrary, and coined for the purpose of creating a trade-mark. And it is stated in the affidavit of Mr. Levy, which was read on behalf of the defence, that in the action brought against him by the "Electro-Silicon Company," and decided by Justice Van Vorst, the learned Justice found that the article "*electro-silicon*" was a white, finely pulverized powder, as already stated, and further, that the name given to it was an arbitrary one coined for the article and not expressive of the nature or quality thereof, except that silicon is one of the principal chemical elements, and he suggested that the word electro was probably assigned to express the rapidity with which the polish was attained by its use.

It thus conclusively appears that a preparation made from infusorial earth for commercial purposes was first introduced by the plaintiffs' predecessors and called "*Electro-Silicon*," that these words were adopted as a trade-mark and a declaration thereof filed in the office of the Secretary of State of California and in the Patent Office of the United States at Washington; that for many years it was sold and became valuable for the purposes for which it was designed; that it was known as "*Electro-Silicon*," and also as "*Silicon*" only; that the words "Electro-Silicon" were coined for the purpose of creating and establishing a trade-mark; that they are not descriptive of the article although it contains some silicon; that silicon is not and from its nature cannot be, a commercial article because it exists in such minute quantities, and is, as we have seen, an elementary body closely allied to carbon and existing as a dark-brown powder or steel-gray mass, ac-

according to circumstances, and is never found in nature in an uncombined state, but only exists as a component part of compounds, resembling it in no respect, from which it has been separated, so as to exist by itself only in very small quantity and to furnish only specimens for cabinets. The question presented upon this state of facts is whether the plaintiff has acquired any right of property in the trade-mark mentioned, namely "*Electro-Silicon*."

There are a great many cases illustrative of the rules of law governing the rights acquired by trade-marks, and it may be said that in some respects they are conflicting, but the ultimate object of the Courts has been, in all of them, not only to protect and encourage honest competition, as a matter of public policy, but to condemn anything like dishonest traffic, or fraudulent or unjust attempts to invade existing rights. In the case of *Messerole v. Tynberg*, (decided in the Court of Common Pleas in 1868, and reported in 4 *Abbott*, (*N. S.*), 419), the question was whether the plaintiffs' trade-mark, which consisted of the word "Bismark," was one that could be used by others, though it was a popular term and was in general use. In that case the subject was examined at some length, and it was held that whilst the word used might not be the subject of special right or property, it might become so when the application of it identified a particular article. The case of *McAndrews v. Bassett*, 10 *Jur.*, (*N. S.*, 550), was cited in that case, in which Lord Westbury said that "property in the word for all purposes cannot exist, but property in that word as applied by way of stamp upon a stick of licorice, does exist the moment the licorice once gets into the market so stamped; and obtains acceptance and reputation in the market, whereby the stamp gets currency as an indication of superior quality, or of some other circumstance that renders the article so stamped acceptable to the public."

And in the case of *Matsul v. Flanagan*, (2 *Abb.* (*N. S.*), 459), it was held that a Court of Equity would protect a person in the use of a trade-mark, *e. g.*, the name of a newspaper, although the name adopted was one that belonged to the language of the

country, and might be employed in any way or for any purpose which would not defraud individuals or deceive the public.

But the case of *Hier v. Abrahams*, (82 N. Y., 519), is regarded as conclusive upon the right of the plaintiff herein to an injunction. In that case the action was brought to restrain the defendants from infringing upon the plaintiff's alleged right to the use of the word "pride" as a trade-mark, another Court declared that there were trade-marks of two kinds—pictures or symbols, or a peculiar form and fashion of label, or simply a word or words, which in whatever form printed or represented, continued to be the distinguishing mark of the manufacturer who has appropriated it or them, and the name by which his products were known and dealt in, and that this distinction was recognized in the statutes for the protection of trade-marks as well as in the cases.

It was said that where the trade-mark consisted of a picture or a symbol, or in any peculiarity in the appearance of the label, the imitation must be such as to amount to a false representation, liable to deceive the public and enable the imitator to pass off his goods as those of the person whose trade-mark was imitated. But where the trade-mark consisted of a word, it might be used by the manufacturer who has appropriated it, in any style of print, or in any form of label, and its use by another in any form was unlawful; the goods became known by the name or word by which they had been designated, and not merely by the manner or fashion in which the word is written or printed, or the accessories surrounding it, and the unlawful use of the name or word in any form might be restrained. The learned Judge in delivering the opinion refers to the several cases in which the right of trade-mark was preserved where it consisted of a word, and declared that it was not necessary to the preservation of the plaintiffs' rights by injunction that an actual intent to defraud should be established; that the violation of their rights in the conversion of the trade-mark in legal contemplation was a fraud, and if the defendants, with a knowledge of those rights invaded them and caused damage, that would justify an intendment, if one were necessary, that they did so with intent to defraud. The learned Justice in the Court below denied the motion to continue the injunction

upon the authority of the case of *Morgan's Sons v. Troxell*, (11 *Abbott, C. H.*); but the question discussed herein was not in issue in that case. The gravamen of the plaintiffs' complaint there was a simulation of the form of package and the color of the labels used in connection with the article, and the Court held, substantially upon an inspection of the different packages, that there was such difference in them that the plaintiffs' charge could not be sustained.

The plaintiff in this case does not depend upon the charge of simulation, but upon the right of property acquired in words designating the article sold and which were adopted as a trade-mark, and therefore the element of intent to defraud does not necessarily enter into the consideration of the case. It might be, under various authorities, that if the words used were merely descriptive of the article sold, the plaintiff could not successfully assert and maintain an exclusive right to use them, such for example as "Dr. Johnson's Yellow Liniment," (*Singleton v. Bolton*, 3 *Douglas*, 293). "Thompsonian Medicines," (*Thompson v. Winchester*, 19 *Pick.*, 214). "Schiedam Schnapps," (*Wolf v. Goulard*, 18 *How. Pr.*, 64). "Desiccated Codfish," (*Town v. Stetson*, 3 *Daly*, 53). "Julienne Soups," (*Godillot v. Harris*, 81 *N. Y.*, 263), where the right asserted was not maintained because the names were not new and distinctive, but were old and appropriate of a certain class of goods, or had been previously sold by other dealers, the names being generic and therefore descriptive. The plaintiffs' claim might be disregarded also if the designation merely described the material or composition of the article sold, such as "Paraffine Oil," (*Young v. Macrae*, 9 *Jur.*, *N. Y.*, 322), or "Ferro-Phosphorated Elixir of Calisaya Bark," (*Caswell v. Davis*, 58 *N. Y.*, 223), or if the trade-mark merely indicated the place of manufacture, as for example, "Lackawanna Coal," (*Canal Co. v. Clark*, 13 *Wall.*, 311), or "Glendon Iron," (*Glendon Iron Co. v. Uhler*, 75 *Penn. Stat.*, 467), or "Durham Tobacco," (*Blackwell v. Wright*, 73 *Sup. Ct.*, *North Car.*, 310). But as we have seen, it conclusively appears that neither the words in combination nor singly employed, describe the article which they are intended to designate. It is a substance for polishing,

composed of infusorial earth, the proper description of which is not "silicon," which exists in small quantities and is not an article of commerce. The words, therefore, are arbitrary and coined for the purpose of distinguishing an article which the plaintiffs' predecessor first introduced into the commerce of the nation of which it has become part. In conclusion it may be said, as suggested, by the counsel for the appellant, with great propriety, that "Silicon" or "Electro-Silicon" is not, as already stated, descriptive of the plaintiff's article.

It is not a descriptive name of a class of polishing powder, or the appropriate descriptive name of the material of which it is composed, or its place of manufacture or production, or of the name of the thing itself, or the quality of the thing itself, or of the mode of its use, or of the mode of its construction, but is new, arbitrary and distinctive, and under the authorities referred to, it is quite clear, therefore, that the plaintiff is entitled to the exclusive use of the trade-mark for the purpose designated, having acquired by its use a property in it.

For these reasons the order appealed from should be reversed, and the motion granted, with ten dollars costs of the appeal, besides disbursements, and ten dollars costs of the motion below.

DAVIS, P. J., concurs.

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COURT OF APPEALS, STATE OF KENTUCKY.
IN EQUITY.

AVERY & SONS

*vs.*MEIKLE & CO.

DECIDED 27 MARCH, 1883.

REPORTED 81 Ky., 73.

“Avery Plow” Case.

1. A trade-mark is a sign or symbol primarily confined exclusively to the indication of the origin or ownership of the goods to which it is attached, and it may be composed of any name, device, line, figure, mark, word, letter, numeral or combination or arrangement of any or all of these which will serve the sole purpose of a trade-mark, and which no other person can adopt or use with equal truth.
2. Terms which designate merely the name, quality, kind, size, number or elements of an article, or have become its proper appellation, or that merely describe it or direct the mode of its use, or purely generic or geographical terms, and the necessary and common uses in which the English language and Arabic numerals are employed by the people to express the truth, their ideas and feelings, are common property which all may use but which none can appropriate exclusively to himself as a trade-mark.

3. A trade-mark becomes the exclusive property of one only when he has, prior to any one else, appropriated and used it to indicate the origin, ownership and quality of an article to which it is attached. Its value rests on reputation and on its implied guaranty that the article is of a certain quality. The object is to prevent one person from selling his goods as those of another of established reputation to the injury of that other.
4. When plaintiff shows that he has adopted a legal trade-mark, that it has been infringed, and that actual probable or possible damages have or may result from its infringement, he is entitled to relief usually in the form of an injunction and an account of profits.
5. Where no patent is held by the owner of plows, any one may make plows in exact similitude, may brand the name of the manufacturer and the place of manufacture on such part of the plow as he pleases, taking care so to use the brand as not to deceive the public into the belief that the plow is the manufacture of another.
6. Although certain letters and numerals may have come to indicate to the public the origin or ownership of appellant's plows, as they did not appropriate them by adoption, use or claim as a part of their trade-mark, they cannot be treated as a part of it simply because they appear capable of serving the same purpose.
7. Courts of Equity afford a remedy against the infringement of a trade-mark or of the trade reputation of its owners, on the principle of protecting property, of promoting fair dealing, and of protecting the public. Where a trade-mark itself has been infringed, neither fraud nor the inferior quality of defendants' article need be proved. But where a property right, not amounting to a trade-mark, has been infringed, it is essential to show fraudulent intent. But Courts of Law require proof of deceit, fraudulent intent or special damage (unless damage is presumed) in both cases.
8. Where the action is brought to restrain the fraudulent usurpation of plaintiffs' trade reputation, plaintiff need not make out a legal title to an exclusive trade-mark, by the usurpation of which defendant has done the wrong. It is enough that defendant sells his goods as those of plaintiff, either by the use of plaintiffs' trade-mark or any other means, that such fraudulent sales result or are likely to result in damage to plaintiff. It is the purpose or design of the act that constitutes the wrong, and though a man may use any letters and figures (which are common property) to indicate the size, quality and description of his goods, yet he cannot do this in such way as to mislead others into the belief that goods made by himself were made by another.

9. If one, with a bad motive, exercises his rights in a lawful and proper way and injury results, there is damage without legal injury; but if with a bad motive he exercises his rights in an unlawful manner, there is both damage and legal injury.
10. As to what facts constitute infringement of a trade-mark or trade reputation, no rule can be formulated that will embrace every act of infringement, and the original and alleged imitation are of primary importance. The resemblances need not be such as would mislead an expert or could not be easily detected if the original and the spurious were seen together. It is enough if such resemblances exist as would lead an ordinary purchaser to suppose he was buying the genuine article and not an imitation. If the differences are only colorable, and there is no reason for the resemblances except the purpose of deceiving the purchaser of one article into the belief of its being the manufacture of another, the Court will presume a fraud was intended.
11. Though the particular combinations of letters and figures used by appellees were not entitled to protection as part of appellants' trade-mark, yet it appearing that appellees copied those combinations, not for the purpose of indicating the size and quality of their plows, but for the purpose of misleading the public into the belief that appellees' plows were of a kind made by appellants, having an established reputation and large sale, HELD:

That appellees are liable to appellants for damages resulting from loss of trade in consequence of such copying and to an injunction restraining the further sale of such plows.

APPEAL from Louisville Chancery Court.

Messrs. W. O. & J. L. Dodd, Mr. John Mason Brown, Mr. P. B. Muir, and Mr. John Marshall, for the appellants.

Mr. W. Lindsey, Mr. Geo. M. Davis, and Mr. James S. Pirtle, for the appellees.

HARGIS, C. J., delivered the opinion of the Court.

The appellants brought this action to restrain the infringement of their trade-mark and to prevent the fraudulent usurpation of their trade reputation by the appellees, and to compel them to account for resulting profits. The appellants are manufacturers of plows in the City of Louisville. They brand on the right side of the beam their trade-mark, which is composed of a Maltese cross,

with the letters "A V E R Y" distributed in its center and arms. Immediately above the cross are the words "Trade-Mark," and below it is the word "Copyrighted." To the left of it are the words "B. F. Avery's, Patented," and to the right "Louisville Steel, July 11, 1871." The steel series of their plows are branded on the top and near the rear of the beam "Pony," "AO," "BO," and "CO," and their cast series at the same point with " $\frac{1}{2}$," "1," "2," "3," and "8." Upon the top of the fore part of the beam of each series are stenciled the cautionary words "Keep all taps screwed up." The appellants' trade-mark, which they printed and referred to in their catalogues and described in their advertisements, is composed of the Maltese cross, with the name "A V E R Y" distributed in its arms and center, surrounded by the words "Trade-Mark" above and "Copyrighted" below it.

The appellees, who are also engaged in the manufacture of plows in the City of Louisville, dismantled plows of appellants' steel and cast series, and with great accuracy copied every important and ordinarily noticeable part of them. They then began the structure of two series of plows, one steel and the other cast, so much like appellants' that an ordinary person could not tell the one from the other. They also imitated, almost to perfection, the interchangeable metal points of appellants' plows. They branded the steel series "PO," "AO," "BO," "CO." The "PO," was followed by the word "steel," and "Louisville" was placed on top of the beam. Their cast series was branded " $\frac{1}{2}$," "1," "2," "3," "8." Upon the top of the front part of the beam of each were stenciled the cautionary words, "Keep all taps screwed up." These letters, numerals, and words of caution were of the same size and character of type, and placed in precisely the same position on their plows as on those of appellants. The plows were varnished as appellants' were varnished. The resemblance of appellees' plows to those of appellants was complete, the only substantial difference being that the appellees placed on both sides of the beam their trade-mark, which consists of an oblong figure and diamond whose angles project over the lines of the oblong with the letter "M" in the center of both, and encom-

passed by the name, "Thos. Meikle & Co." above, and "Louisville, Ky.," below. The appellees held a consultation before they attempted the imitation above described, and after due deliberation and quieting Mr. Meikle's conscience, in the rough, but significant language of one member of the firm, who seems to be its guiding spirit, they determined, "come what may, to take the bull by the horns." Then the work of dismantling and imitation began. Soon their newly dressed and formed series of cast and steel plows were thrown upon the market, and a business of thirty plows per day sprang up to nearly one hundred per day. These increased sales were made to a considerable extent to jobbers, whose names were substituted for appellees' trade-mark and its surroundings, and stenciled on the beams where their trade-mark and name had stood. These jobbers did not pretend to be originators or manufacturers of the plows, and it appears that many persons have been deceived, and unable to distinguish the imitation from appellants' plows.

In order to make the imitation series the appellees abandoned their brands, "A," "B," "C," "D," and "F," on their cast, and the numerals "0," "1," "2," "3," "4," "5," and "6," on their steel plows, which they have been using, and substituted appellants' brands in their stead, placing the letters on the steel, and numerals on the cast series, so as to correspond precisely with appellants' mode of using them.

Whether the conduct of the appellees amounts to an infringement of appellants' trade-mark, or any injury to their legal or equitable rights, is the question to be considered. The object of trade-mark law is to prevent one person from selling his goods as those of another, to the injury of the latter and of the public. It grew out of the philosophy of the general rule that every man should use his own property and rights as not to injure the property or rights of another, unless some priority of right or emergency exists to justify a necessarily different manner of use. The intermediate instrument of prevention, which the law protects in its office, is called a "trade-mark," which an owner of goods may adopt and use to indicate their origin or ownership, and to distinguish them from goods of a similar nature belonging to some-

body else. This right of adoption and use is subject to various limitations and qualifications.

1. A trade-mark is a sign or symbol primarily confined exclusively to the indication of the origin or ownership of the goods to which it may be attached, and it may be composed of any name, device, line, figure, mark, word, letter, numeral or combination or arrangement of any or all of these, which will serve the sole purpose of a trade-mark, and which no other person can adopt or use with equal truth. Fancy names, whether invented or arbitrary, the names of places, words, where applied to a new process by the inventor; the name of an article, which alone designates its origin or ownership; letters and numerals combined in unusual and peculiar forms, or with other parts composing trade-marks, have been held, under the particular circumstances of the various cases where their exclusive appropriation and use were in question, to be trade-marks or component elements thereof. See *Congress Spring Co. v. High Rock Spring Co.*, (45 N. Y., 290); *Burnett v. Phalon*, (3 Keys, 594); *Marsh v. Billings*, (7 Cushing, 322); *Woodward v. Lazar*, (21 California, 444); *Ford v. Foster*, (L. R., 7 Ch., 611); *Taylor v. Carpenter*, (3 Story, 458); *Davis v. Kendall*, (2 R. I., 566), in which the words "Eureka Shirt," "Persian Thread," "Vegetable Painkiller," "Congress Spring," "Cocaine," "New Era," "Revere House," "What Cheer House," were held subject to exclusive appropriation as trade-marks.

In the cases of *Wotherspoon v. Currie*, (5 H. L., 508); *McAndrew v. Bassett*, (10 Jur., N. S., 550); *Seixo v. Provezende*, (L. R., 1 Ch. Ap., 192); *Newman v. Alword*, (49 Barb., 588), the words "Glenfield Starch," "Anatolia Liquorice," "Seixo Wine," "Akron Cement," were protected as trade-marks. For the word "original" as a trade-mark, see *Cocks v. Chandler*, (L. R., 11 Eq., 446). Numerals in the cases of *Boardman v. The Meridian Britannia Co.*, (35 Conn., 402); *Gillott v. Esterbrook*, (47 Barb., 455), were held to be, in connection with the manufacturer's name, a lawful trade-mark.

Browne on Trade-Marks, section 87, says: "The mark may consist of the name of the manufacturer or merchant, (provided it be

written, printed, branded, or stamped in a mode peculiar to itself) in a seal, a letter, a cipher, a monogram, or any other sign or symbol that can serve to distinguish the products of one man from those of another. It may be any symbol or emblem, however unmeaning in itself."

2. Terms which designate merely the name, quality, kind, size, number, or elements of an article or have become its proper appellation, or that merely describe it, or direct the mode of its use, purely generic and geographical terms, and the necessary and common uses in which the English language and Arabic numerals are employed by the people to express their ideas and feelings and to tell the truth, are common property which all may use, but which none may exclusively appropriate as a trade-mark or acquire as absolute individual property. Many authorities have been examined, and might be here cited, to establish each clause of this general statement of the law, but it is not necessary to do so.

3. It must not be overlooked, however, in these exclusions, that a trade-mark is indirectly the guaranty of the quality of an article to which it is attached, as well as of its origin and ownership, for in all cases the trade-mark, indicating the origin by necessary implication, represents the quality of the article, which is the true source of its reputation in the market. There is no abstract right in a trade-mark. It is property only when appropriated and used to indicate the origin or ownership of the article or goods. And its real value consists in the confidence and patronage of the public, secured through its instrumentality in acquainting them with the origin and ownership of an article which thus gains reputation for its superior qualities. Of this reputation its owner cannot be deprived without his consent, either by the use of forbidden means or the illegal employment of things otherwise lawful. When a workman or manufacturer has, by skill, care, and fidelity, manufactured a good article, it becomes of the utmost importance to him that its origin and ownership should be known, and the law points out to him the means and how he may appropriate them to indicate this important fact, and when he adopts and uses them, and his reputation is thereby built

up, it is to him the most valuable of property rights. Sound policy which dictates the protection of the public from imposition, the security of the fruits of labor, the encouragement of skillful industry, and, above everything, the inculcation of truth and honor in the conduct of trade and commerce, and the requirement that all the contractual relations of life—natural, abstract, and relative—shall be honestly observed, demands that such reputation, so gained, shall be free from the grasp of piracy and its infringement accorded the safest and best remedy for redress known to the Courts of Equity.

4. And this is the law of both principle and authority. Therefore the lawful adoption and use of a trade-mark is the invocation of the law applicable to it by the originator or owner of an article for the protection of his reputation as such. When this essential state of facts is shown by a complainant, and that his trade-mark has been infringed, and actual, probable, or possible injurious consequences are or may be the result of the infringement, he is entitled to relief, which is usually granted by injunction and an account of profits.

Having premised these general rules of the law of trade-mark, the field of investigation we shall first explore is, whether the appellants' trade-mark embraces either the word "Pony," the letters "AO," "BO," "CO," or the numerals " $\frac{1}{2}$," "1," "2," "3," "8," or the shape and construction of their plows. We will dispose of the last point first.

5. The shape and construction of the plow do not form any part of the trade-mark of the appellants further than their subjection to the use of the mark to indicate their origin and make it necessary to render the trade-mark property, for, as held in *Candee, Swann & Co. v. Deer & Co.*, (54 Ill., 461), where no patent is held by the owner of plows, "any one, therefore, has a perfect right to make in their exact similitude, even to the 'curve of the mold-board' and 'the tip of the handles'—in the minutest as well as in the most important points—all have a right to manufacture them, no matter where the maker may reside, and has the right to put the name of the place where manufactured, as well as his own name, on such part of the plows as he pleases,

taking care, however, so to use the brand as not to deceive the public, so as not to create a belief that the plow is the manufacture of another." Other cases, which express it differently, are to the same effect. *Fairbanks v. Jacobus*, 14 *Blatch.*, 339. The evidence shows that as early as the year 1868 the word "Pony" was adopted and used by Kelly, of Texas, on a small one-horse plow, which he was then engaged in the manufacture of, and that the appellants did not adopt or use it prior to 1871. Hence they have not the merit of first appropriation, which is necessary to the exclusive right to the word "Pony," even as a trade-mark. But where the evidence, as in this case, establishes that the word "Pony," is used to indicate the quality and size—to wit: a small steel plow—it cannot for such use become a trade-mark. And it does not matter that "Pony" is not in itself the sign of the idea of size or quality, for if it was substituted for the words which would convey such meaning, and used by appellants for that purpose, they could not have acquired, even by prior adoption, an exclusive right to the use of the word "Pony." *Amoskeag Manufacturing Co. v. Spear, Cox's T.-M. C.*, 102. Many years before the appellants adopted "AO," "BO," "CO," it was customary to use letters and combinations of letters to indicate quality, size, and series of plows. "CO" was in use before appellants used it, but whether they used the combination of these letters first or not, the evidence shows that they used it to indicate the size and quality of the steel series. As to the numerals " $\frac{1}{2}$," "1," "2," "3," "8," they were used by appellants to denote the size and quality of their cast series.

6. This is the evidence; and although the letters and numerals on both series may have come to indicate to the public the origin or ownership of the appellants' plows, as they did not appropriate them by adoption, use, or claim as a part of their trade-mark, they cannot be treated as part of it simply because they appear capable of serving the same purpose.

The printed catalogues and advertisements of the appellants do not claim that these letters or numerals form any part of their trade-mark, yet all through them attention is called to the Maltese cross, and the words in and immediately around it as their trade-

mark. Had "AO," "BO," "CO," and " $\frac{1}{2}$," "1," "2," "3," and "8," or any of them, formed a part of appellants' trade-mark, it is unreasonable and contrary to human experience to suppose that the fact would have been ignored for years and excluded from their carefully prepared and printed annual catalogues and advertisements. The cautionary words "Keep all taps screwed up" are not the subject of a claim to exclusive use, as has been held and well settled in the cases of *Falkinburg v. Lucy*, (*Cox, T.-M. C.*, 465-6), *Gillott v. Esterbrook*, (*Id.*, 350), *Gilman, &c. v. Hunnewell, &c.*, (122 *Mass.*, 149), and because they are words of caution which the appellees may use with equal truth, sincerity, and from a necessity common to the use and handling of plows. The alphabet, English vocabulary, and Arabic numerals are to man, in conveying his thoughts, feelings, and the truth, what air, light and water are to him in the enjoyment of his physical being. Neither can be taken from him. They are the common property of mankind in which all have an equal share and character of interest. From these fountains whosoever will may drink, but an exclusive right to do so cannot be acquired by any. And the appellants having drawn from the common fountain, the letters and numerals named cannot claim exclusive right to them or their use.

Having disposed of the appellants' alleged title to the exclusive use of the letters "AO," "BO," "CO," the word "Pony" and the numerals " $\frac{1}{2}$," "1," "2," "3," "8," we are brought face to face with an exceedingly important question, whose solution will settle the merits of this controversy. It is whether Courts of Equity will afford a remedy against the invasion of and injury to the trade-mark, or the trade reputation of its owner, which he has acquired through the trade-mark itself, or its accompanying *indicia*, which represents only the quality, size, character, description, or caution in the use of the article to which the trade-mark is attached. The ground of jurisdiction is one thing, and the evidence or fact of infringement is another. Courts of Equity proceed "on the principle of protecting property alone" and the promotion of honesty and fair dealing. The protection of the public alone is not sufficient ground for the jurisdiction. How-

ever, it is an element which enters and ought to enter, into every case. The property really consists in the exclusive right of a manufacturer or owner to sell his products or goods as his own, and in being protected in the exercise of that right by the exclusion of all others from its enjoyment, either by selling theirs for his, or causing others to do so.

7. It is not necessary to a recovery in equity where the trade-mark itself, in whole or part, has been appropriated, to prove fraud or an inferiority of quality of the article of the defendant. This principle is based on the ground that a trade-mark when in use is property itself. *Edelston v. Edelston*, 1 *DeG., J. & S.*, 185. But when the infringement of the property right has been committed by other means than the appropriation of the trade-mark itself, it is essential, even in equity, to show a fraudulent intent, otherwise there could be no safety in the use of those things which are common to all, and which cannot be exclusively appropriated, as to them no legal injury can flow from their innocent, ordinary, or proper use.

At law special damage, unless damage is presumed, deceit, or fraudulent intent must be proved in all cases to warrant a recovery. This is not, as we have stated, universally so in equity, but it is common both in law and equity where the infringement is perpetrated by other modes and means than the use of any part of a trade-mark itself. The remedy at law is not adequate in all cases to the protection of this species of property commonly known "as trade reputation," because no injunction can be had against a continuation of the injury, and nothing but nominal recovery unless special damages are shown. *Blofield v. Payne*, 4 *B. & Ad.*, 410. The deficiency of the remedy at law has caused the Courts of Equity to take jurisdiction of this class of cases and extend protection to this great right of property in whose exercise the public are deeply interested, and in whose maintenance the commercial honor and trade integrity of our fair State are profoundly concerned. The ascertainment and explanation of that jurisdiction will be followed by the discussion of the law of infringement and the analysis and application thereto of the facts of this record.

In the rather noted case of the *Leather Cloth Co. v. American Leather Cloth Co.*, (*House of Lords*, reported in *Cox, T.-M. C.*, 688), on which the appellees rely for the remarkable doctrine that no protection can be given unless the appellants show that they have a technical trade-mark, all or some part of which has been appropriated and used by the appellees to their injury, the Lord Chancellor reversed the Vice-Chancellor because the plaintiff's alleged trade-mark, was not a trade-mark, and it contained misrepresentations amounting to a fraud upon the public. In criticising the views of the lower Court the Lord Chancellor stated the doctrine to be—

“*First.* The goods of one may be sold as the goods of another without giving that other person a right to complain, unless he sustains, or is likely to sustain, from the wrongful act some pecuniary loss or damage. * * * *Second.* It is not requisite for the exercise of the jurisdiction there should be fraud or imposition practiced by the defendant at all.”

The last proposition was laid down with reference to a trade-mark proper, and is undoubtedly the law. The first proposition is equally sound, and is applicable, and whether there is a trade-mark shown to have been dismembered or not, if the goods of one have been intentionally and fraudulently sold as the goods of another, and he has sustained damage, or the former threatens to continue his acts, which the Court is bound to conclude will result in damage. This extension of the Lord Chancellor's unnecessary restricted views is justified by what was said in the House of Lords on appeal in the same case, by Lords Cranworth, Kingsdown, and the Lord Chancellor himself.

Lord Kingsdown declared it to be the law, and no one disputed it, that the defendants—

“Had no right, directly or indirectly, to represent that the article which they sold was manufactured by Crocketts, or by any person to whom Crocketts had assigned their business or their rights. They had no right to do this either by positive statement or by adopting the trade-mark, * * * or by using a trade-mark so nearly resembling that of plaintiffs as to be calculated to mislead incautious purchasers.”

He makes a manifest distinction between making a positive statement and usurping a trade-mark as a means of infringement.

Lord Cranworth said that "the Lord Chancellor observes that the ground on which Courts of Law and Courts of Equity have interfered in the case of trade-marks has not been well defined, and has not been made to rest on any satisfactory principle;" that he did not think it necessary to go into the question whether the trade-mark, if it could be one, of appellants, as used by them, was entitled to protection, as it was a question of some nicety, for he thought "it clear that there was in this case no infringement." The Lord Chancellor concluded by saying he was satisfied "that I assigned for my decision in the Court below a ground narrower than I might have taken as the basis of that judgment," and admitted that he did not "enter into the consideration of the wider view of the subject, which has been so forcibly urged by my noble and learned friends," and concluded that the appellant had no trade-mark at all; that it was nothing more than an advertisement, which had not been substantially imitated by the appellees.

It results from these observations that the grounds of jurisdiction were laid down too narrowly by the Lord Chancellor, and in a manner not necessary to the decision of the case, and that so far from that case contracting the jurisdiction of the Courts of Equity to the narrow limits of an action at law, or within the bounds prescribed by the instruments with which the wrong may be done, it virtually conceded the jurisdiction to protect the complainants, had they come with clean hands, and shown that the defendants, either directly or indirectly, by positive statement or adoption of a known or rightfully possessed and used trade-mark, represented the article they sold as manufactured by the complainants, and that they had sustained or were likely to sustain damage by reason of the wrongful act.

After repeating the principle that no man has a right to sell his own goods as the goods of another, nor to dress himself in colors and symbols to which he has no right, and thereby personate another, or represent that he is selling the manufacture of

such other, while in reality he is selling his own, the Master of the Rolls, in *Croft v. Day*, (*Cox T.-M. C.*, 657), said:

“The right which any person may have to the protection of this Court does not depend upon any exclusive right which he may be supposed to have to a particular name or to a particular form of words. His right is to be protected against fraud, and fraud may be practiced against him by means of a name, though the person practicing it may have a perfect right to use that name, provided he does not accompany the use of it with such other circumstances as to effect a fraud upon others.”

This doctrine was quoted and approved in *Stone v. Carlan*, (13 *L. R.*, 360; *Cox T.-M. C.*, 116), where the false pretences of the defendant are made the basis of the relief, and the badges, symbols, and similar carriages, all of which might have been properly used, as they were not exclusively the property of the complainant, were held to have been so used, under the circumstances of that case, as to amount to fraud, although it is clear that the name of the hotel, “Irving Hotel” or “Irving House,” was the only thing among the complainant’s signs and symbols that could be treated as exclusively appropriated by him as a trade-mark within the meaning of the law.

So, in the case of *Knott v. Morgan*, (2 *Keen*, 213), the words “Conveyance Company” and “London Conveyance Company,” and other words used by complainants were held to be common property, and therefore not the subject of exclusive right, yet the Court said:

“They have a right to call upon this Court to restrain the defendant from fraudulently using precisely the same words and devices which they have taken for the purpose of distinguishing their property, and thereby depriving them of the fair profits of their business by attracting custom on the false representation that carriages really the defendant’s belong to and are under the management of plaintiff.”

What were those words and devices? They were not trade-marks, just as “AO,” “BO,” “CO,” “Pony,” and “ $\frac{1}{2}$,” “1,” “2,” “3,” and “8,” are not trade-marks, yet their combination and use, not to designate the defendant’s omnibuses and business,

but to imitate the plaintiff's, and thereby attract his custom and take his profits, were held to be illegal.

The case of *Lemoine v. Ganton*, (2 *E. D. Smith*, 343), was where the complainant had abandoned one trade-mark and adopted another, and a verdict for nominal damages was sustained in his favor against the defendant, who had assumed the discarded trade-mark, and thereby sold his calf-skins as the manufacture of the complainant, the Court saying:

"It makes no difference whether that object was effected by counterfeiting the trade-mark which he uses at present or one that he formerly used."

In that case, certainly, titles to the trade-mark by which the fraud was committed was not shown, and it was not necessary to show it.

The Supreme Court of the United States used this language in *McLean v. Fleming*, (96 *U. S.*, 254):

"Nor is it necessary, in order to give a right to an injunction, that a specific trade-mark should be infringed; but it is sufficient that the Court is satisfied that there was an intent on the part of the respondent to palm off his goods as the goods of the complainant, and that he persists in so doing after being requested to desist."

The Court, with approval, cites the case of *Woolam v. Ratcliff*, (1 *Hen. & M.*, 259), in support of their opinion.

Such is the ruling of the Supreme Judicial Court of Massachusetts in the case of *Thompson v. Winchester*, (19 *Pick.*, 214). Thompson invented certain medicines, which is designated "Thompsonian Medicines," and the evidence offered by him to make out his case was to the effect that the defendant had prepared medicines of an inferior quality, and had sold the same as pure Thompsonian medicines, and as and for medicines prepared by plaintiff himself. The Court rejected this evidence, and the jury, under instructions, in accord with that ruling, found for defendant; but the Supreme Court reversed the case, and said "that if the defendant made and sold medicines, calling them 'Thompsonian Medicines,' and sold them, or placed them in the hands of others to sell as and for medicines made and prepared by the

plaintiff, so that persons purchasing the same supposed and believed that they were purchasing the medicines made and prepared by the plaintiff, it was a fraud upon the plaintiff and an injury to his rights, from which the law will presume some damage," citing *Sykes v. Sykes*, (3 B. & C., 541), which is to the same effect. The words "Thompsonian Medicine" had become their proper appellation, and therefore not subject to exclusive appropriation, and the defendant had the right to prepare medicines of inferior quality and call them by that name, yet he was held responsible for selling his medicines as those of the plaintiff. This case illustrates the rule suggested in the beginning of this opinion—that at law the plaintiff, who has an exclusive right to a trade-mark, has no right to recover where the trade-mark alone has been taken, unless special damages be shown—and that, whether he has a trade-mark proper or not, if, by fraudulent means and with fraudulent intent, the defendant sells his goods as and for those of the plaintiff, the law will presume some damages, and he "will be entitled to recover nominal damages at least, and something more, if he can make it appear that he has sustained more than nominal damages." It is plain, from these authorities, that the damage at law does not grow out of the mere adoption of a trade-mark, but it arises from the fact that sales have been made by defendant of his goods as and for the plaintiff's goods. This results in damages, either by curtailing the amount of plaintiff's sales or substituting inferior goods for his, which injures his reputation. For this damage he has his remedy, because it grows out of a legal injury.

In *Singleton v. Balton*, (3 Doug., 293), Lord Mansfield said "that if the defendant had sold a medicine of his own under the plaintiff's name or mark, that would be a fraud for which an action would lie;" but he non-suited the plaintiff because he and defendant used the name of the original inventor, which had become evidently the proper appellation of the ointment, and because "no evidence was given of the defendant having sold it as if prepared by the plaintiff."

The case of *Morgan's Sons' Co. v. Troxell*, (Cox Man. T.-M. Cas., 414), is important because no trade-mark was there dis-

membered and the parts appropriated for the accomplishment of the fraud, yet the Court granted relief, saying:

“We deem it then, to be well settled that, to justify the interference by injunction of a Court of Equity, it is sufficient, that there is a fraudulent intention of ‘palming off’ the defendant’s goods as those of the plaintiffs, and that such intention is being carried into execution.”

In *Perry v. Truefitt*, (6 *Beaven*, 66), Lord Langdale said:

“I think that the principle on which both the Courts of law and equity proceed in granting relief and protection in cases of this sort is very well understood. A man is not to sell his own goods under the pretence that they are the goods of another man. He cannot be permitted to practice such a deception nor to use the means which contribute to that end.”

In *Singer Manufacturing Co. v. Brill*, (*Superior Court, Cincinnati, Cox Man. T.-M. Cas.*, 409), the Judge delivering the opinion said:

“It is competent for one engaged in business to protect that business and the reputation he may acquire by more ways than one, and the law will not allow a man, when called to account for an infringement of an adopted means of protection, to defend by answering that the complainant has still other marks or means whereby to protect himself that he has not interfered with. And accordingly it has been held that “it will make no difference that the plaintiff has also a trade-mark which has not been taken by the defendant.” (*Braham v. Bustard*, 1 *Hen. & M.*, 447).

The Supreme Court of New York, 1872, in *Cook v. Starkweather*, (*Cox M. T.-M.*, 221), held—

“That whether the plaintiffs were or were not entitled to the exclusive use of the words ‘Valley Whisky’ or ‘Old Valley Whisky,’ which was not clearly established, the course of conduct adopted by the defendants was intended and calculated to deceive, and the plaintiffs were therefore entitled to an injunction.”

Kinney v. Basch is analyzed by *Cox M. T.-M.*, 304, where it is said:

“The plaintiff being a manufacturer of cigarettes, on which he used a label containing a device of sun’s rays, the words ‘St.

James,' and symbol ' $\frac{1}{2}$,' the defendants sold other cigarettes with a label containing the words 'St. James Parish Perique Cigarettes,' (of which the words 'St. James' were much more conspicuous,) and the symbol ' $\frac{1}{2}$,' in the same style as the plaintiff's but the labels were in other respects different. Injunction granted to restrain the defendants from using the device of the sun's rays and also the symbol ' $\frac{1}{2}$,' and words 'St. James,' alleged to be the plaintiff's trade-marks, on the ground that, whether the plaintiff had or had not an exclusive right in the marks, the defendant had so acted to deceive."

Judge Van Brunt places the jurisdiction on the ground of fraud upon the public, even at the suit of a plaintiff who has not the exclusive right to the use of the words, numerals, or symbols, While we think fraud upon the public may enter into the ground of jurisdiction, it, of itself, in our judgment, is not sufficient, unless some probable or possible injury to the plaintiff is shown. If the plaintiff cannot show that his rights or interest are injured or taken from him, he can have no standing in Court, for strictly he represents the public no more than any one else.

8. The confusion which prevails in the argument against the jurisdiction in this case results from assuming that in all cases the complainant must make out a legal title to an exclusive trade-mark by means of which, or some part of which, the defendant has done the wrong and injury to his rights. The authorities do not sustain this assumption, but, on the contrary, are numerous and strong that the wrong consists in one person fraudulently selling his goods as and for those of another, either by the use of the other's trade-mark or *indicia*, or by any means whatever, if such fraudulent practices result or are likely to result in damage to the complainant. In fact, none of the cases at law which we have examined require the plaintiff to prove the existence of a trade-mark strictly and his title thereto, in order to recover for the fraudulent sale by another of his goods as those of the plaintiff. There is good reason in support of this principle. Suppose A has earned a great reputation for making and selling plows, which he does not mark at all, but which are known in the market by their perfection in shape and finish, and B makes a plow precisely like it in

appearance, but not one-fourth so valuable intrinsically, could B go about, with impunity, for his own gain, to injure A and deceive the public, selling his plows as and for those of A by orally misrepresenting them as A's plows? We are inclined to the view that A would have his action for this deceit and fraud, which would, if not checked, finally break down his reputation for making a good article. This view is not, however, in its full breadth, necessary to the decision of this case, but it illustrates the reason which underlies the well-understood jurisdiction of Courts of Equity, which they now exercise in preventing the unjust work of deceit, misrepresentation and fraud, by intercepting their gains and restraining the use of their chosen weapons. As the object of the Courts of Equity is to prevent one man injuring another's rights by selling his goods as those of the other, why not prevent all fraudulent misrepresentations, whether oral, by signs, symbols, trade-marks, labels, words, or figures, by which that wrong is accomplished? The injury is the same, no matter how or by what means it may be done, and the responsibility should attach when that injury is deliberately and fraudulently committed. This limitation must be observed, that if the means used are such as are common to all or not exclusively appropriated by another, and injury follows which is not the result of design and improper use of those means, no remedy exists. There may be a design in adopting lawful means to absorb another's trade reputation, yet if those means are the common property of all and are used in a lawful manner, and damages ensue, it would be *damnum absque injuria*.

9. But where such means are perverted and so combined and used as to represent the goods of one as the manufacture of another, and for the purpose of selling them as such, there is no room to doubt the power of a Court of Equity to grant relief. Care should be taken not to interfere with the freedom of trade or to foster monopolies on the one hand, nor to refuse relief in a proper case where the cry of monopoly and interference with trade is deceptive on the other. The fraud is most frequently accomplished by the illegal use of names, forms, words, and numerals which ordinarily belong to the common stock and are the subject of exclu-

sive appropriation. Instead of employing them in their proper sphere to designate number, size, elements, quality, description, or give directions or caution, they are selected because of the known innocent purposes they generally serve, and combined so as not to represent quality or other particles within the scope of their lawfully prescribed functions, but to cause the goods or articles to which they are attached to be purchased by the public as the make or manufacture of another, thus violating that great generic rule, which lies at the foundation of all law, that a man must so use his own property as not to injure the property of another. The logic of this position would be conclusive even were it without the support of authority.

Mr. Justice Gray, in *Gilman v. Hunnewell*, (12 Mass., 150), and the Master of the Rolls, in *Croft v. Day*, (7 Beavan, 84), said that each case of trade-mark, and what is proper to be done in each, depends upon its own circumstances. These observations of those learned Judges belong to the necessity of such cases, for were the rules of law applicable to trade-marks so fixed and invariable as to try all future cases by the past alone, the wary and cunning would by evasion soon abrogate their efficiency. This suggestion is aptly sustained by the present case, where each particle simulated is the common fund of all the attainment of the ends they commonly subserve.

The law says you may use anything which is the common property of all, or that cannot be exclusively appropriated, but you must use it to convey the ideas which it commonly expresses and of which it is the accepted sign. You must use it to tell the truth, the whole truth, and nothing but the truth. You cannot, under pretence of exercising common right of use, and by reason of the fact that the means represent the quality and size of your goods, so use them that while they perform this simple and innocent purpose apparently of representing quality and size, caution and description, you cause them to do more, to represent your goods as those of another, and, by the seeming fairness which follows the selection of a legal or innocent instrument or means; escape the consequences of an illegal use thereof. This would be stealing the livery of heaven to serve the devil in. This would

be perverting the privileges and uses of our language under the pretence of describing one's own to take another's from him. Can such illegal use be made of written or oral language, because it is no harm to use that language about matters not foreign to its objects? Quality, size, description, caution, elements, &c., may be indicated or named by the use of the words, letters, and numerals described above. This is the appellee's right, but it is not because the words, letters, and figures do that, that he is complained of, for he has the right to use them for those purposes. But the complaint is that these letters and figures have been used not to do this alone, which was rightful, but they have been used for an ulterior purpose. The appellees selected the same letters, the same words, the same numerals, and put them in the same colors and upon the same places on their plows as were used by appellants on their plows, For what? To represent quality and size alone! Who could believe it! Why not take type from a different font? Why not take other numerals that would serve the same purpose better? Why adopt as a number " $\frac{1}{2}$," "1," "2," "3," "8?" Why "AC," "BO," "CO," "PO?" No answer can be given except that a man intends the natural consequences of his own act, and the consequences of his own act, and the consequences of this act are to take appellant's trade, built up on his reputation, and transfer it to appellees' plows. This departure from the easy and common way of using those letters and figures, and the adoption of a troublesome, costly, and painfully prepared imitation, both of plows and letters, is attempted to be excused on the alleged ground that appellees were making better plows than appellants. This excuse is so transparent a subterfuge to escape the effects of their conduct that it deserves to be mentioned because of its boldness only, and as an illustration of the intent of appellees. Would they take to pieces one of the appellants' plows, then make theirs like it, brand them at the same point and in the same way, paint them alike, make the same interchangeable metal points, abandon their old letters and adopt the letters and numerals of appellant, if they were making a better plow, and thus run the risk of confusion with inferior? Who would thus dig a ditch to fall into himself? The eyes of

capital, trade, and commerce are too keen not to see and avoid such folly. No man in his senses would commit it, and we cannot believe the appellees did so. If they did not, then the reason assigned by them for this elaborate imitation is false, and we must look for another and true reason, which may be easily found, for it lies upon the surface; it is pointed out by the experience of the race. Those letters and figures on the skillful imitations, unless we deny the evidence of our senses, the plows having been exhibited to us, were used to enable appellees to sell their plows as and for those of the appellants, and thereby injure their trade reputation, lessen their sales, and share their profits and customers. The question must not be confined to what the appellees used, but how and for what purpose they used the *indicia* copied from appellants' plows. If so restricted, the case is plain, for what they used they had a right to use, but the manner in which they used these letters and figures constitutes the wrong. They have used lawful things in an illegal way. Instead of using to designate quality and size merely, which is allowable, they did not content themselves, but under the pretence of designating quality and size, which the letters and figures really do, they "pressed them into another service" by placing them at points and in positions on their plows that correspond with the manner of their use by appellants. For this reason the appellants' trade-mark could not perform its legitimate functions; its power of designating their make of plows was lessened, and to that extent their trade, coming to them from their reputation, as evidenced by their trade-mark, was destroyed, and the way opened for appellees to claim that loss as their gain, thus usurping the trade reputation of appellants by the artful manner of using and combining artificial signs common to all as signifying quality and number generally.

Appellees' counsel cite the following text in support of their view: "If through the lawful and proper exercise by one man of his own rights a damage results to another, even though he might have anticipated the result and avoided it," it is *damnum absque injuria*. (*Cooley on Torts*, 31.) This is sound law; but if he uses his lawful rights and property in an unlawful or improper manner, then, if damage follow, it is damage with injury

where he so uses his own as intentionally to injure another. This no man has a right to do, and this is the distinction which appellees' counsel fail to recognize. It is also said that a bad motive may render a bad act worse, but it cannot render a lawful act unlawful. This is also true; for if a man with a bad motive exercises his rights in an unlawful and improper way, and injury ensues, it is damage without legal injury; but if he, with a bad motive, exercises his rights in an unlawful manner, and injury is thereby done to another, there is damage and a legal injury. For, instead of exercising his rights in order to their legitimate and full enjoyment, which he may do although it injures another, if he so exercises his rights as not only to enjoy them himself, but to do more, to go beyond and use them in such a manner as to intentionally and fraudulently injure another man's right, it is wrong in principle, condemned by authority, and unsupported by a single analogy, fairly logically applied. The whole argument of appellees' counsel is based upon the false assumption that a legal injury cannot be done by the improper use of lawful means, and that the very act in question is legal. There is a difference between lawful means and the unlawful use of those means. A bad intent, it is indubitably true, cannot render a legal act worse, but this rule must not be misapplied. A bad intent cannot render legal means or things illegal, nor can it render a legal act worse, but a bad intent does make an illegal act done by the use of legal things a good deal worse. This position of the appellees illustrates the difficulty which Courts of Equity meet in the enforcement of justice in cases of this character. While the limitation to the exclusive use of the language confines the selfish monopolist to those words, letters, numerals, and symbols which indicate the origin and ownership of his goods, and which no other person can use with like truth, there is a qualification to the manner in which the residue or common stock may be used. No part of it can be diverted from its ordinary functions and perverted to the work of piracy. Though innocent in itself to communicate ideas and represent the product of all labor, its quality, kind, and most minute and general description, they are the most dangerous means with which to misrepresent the goods of one as and for

those of another, for it is hard to see the difference at first blush between the lawful and unlawful use of that common stock which it is conceded belongs equally to mankind.

Confounding the legality of the means used with the charge alleged in the bill, we are met with the skillful excuse that a bad motive never renders a legal act worse, and particles which, when properly used for lawful purposes would be harmless, are piled up one after another in such a disconnected way as obscures the effect of their combined power until the innocent instruments, having done the work of invading appellants' trade reputation, are made the defence to their own misuse. But whether arising from the common stock or that which is exclusively appropriated, the use must not be fraudulently abused and the rights of others wrongfully taken from them; hence we say that Courts of Equity have jurisdiction, no matter what the means may be, if perverted from their true objects, by which one manufacturer represents and sells his goods as and for those of another.

10. The general rule as to what constitutes infringement is attempted to be laid down in various cases; but it will be found that no rule can be formulated that will anticipate and embrace every act of infringement. So each case must depend mainly upon itself for the rule and proof of this essential pre-requisite to recovery. It is not necessary that the resemblance produced should be such as would mislead an expert, or such as would not be easily detected if the original and the spurious were seen together. It is enough that such similitude exists as would lead an ordinary purchaser to suppose that he was buying the genuine article, and not an imitation. *S. C.*, 129 *Mass.*, 325.

"Although the mark might not deceive if placed side by side with the plaintiffs' mark, it was calculated to obtain for the defendants' goods the same name as that by which the plaintiffs' were known and to deceive an ordinary purchaser who had not an opportunity of comparing the marks." *Mores v. Salgood, Ewen & Co., Cox, T.-M.*, 636.)

"It is a mistake to suppose that the resemblance must be such as would deceive persons seeing the two trade-marks placed

side by side," as was said by Judge Clifford. *Manufacturing Co. v. Trainer*, 101 U. S., 64.

In the case of *McAndrews v. Bassett* much importance was attached to the fact that the defendant had laid aside the mark he had previously used and took up that of the complainant. The Lord Chancellor said:

"The fact of its adoption by the defendants is itself pregnant with proof that they regarded it as a thing desirable to be done. They thenceforth use it in preference to what they previously used, and the reason is clearly to be collected from the letter which was the occasion of the first introduction to them of the mark and the occasion of their adopting it." 10 *Jur.*, N. S., 550; *Cox's M. T.-M. Cases*, 673.

In every case (says Vice-Chancellor Wood in the *Taylor Persian Thread Case*) the Court must ascertain whether the differences are *bona fide*, in order to distinguish the one article from the other; whether the resemblances and the differences are such as naturally arise from the necessities of the case, or whether, on the other hand, the differences are simply colorable, and the resemblances are such as are obviously intended to deceive the purchaser of the one article into the belief of its being the manufacture of another person. Resemblance is a circumstance which is of primary importance for the Court to consider, because if the Court finds, as it does almost invariably find in such cases as this, that there is no reason for the resemblance, except for the purpose of misleading, it will infer that the resemblance was adopted for the purpose of misleading." *Taylor v. Taylor*, 2 *Eq. Rep.*, 290; *Cox's M. T.-M. Cases*, 70.

In *Seixo v. Provezende* it was said:

"If a purchaser, looking at the article offered to him, would naturally be led, from the mark impressed on it, to suppose it to be the production of the rival manufacturer, and would purchase in that belief, the Court considers the use of such mark to be fraudulent. But I go further. I do not consider the actual physical resemblance of the two marks to be the sole question for consideration. If the goods of a manufacturer have, from a mark or device he has used, become known in the market by a particular

name, I think the adoption by a rival trader of any mark which will cause the goods to bear the same name in the market may be as much a violation of the right of that rival as the actual copy of his device." *L. R.*, 1 *Chy.*, 192; *Cox's M. T.-M. Cases*, 146.

Vice-Chancellor Malins said :

"The rule of the Court is, that a man who has adopted a distinguishing mark has a right to be protected against any other person adopting one sufficiently like it to mislead an unwary public."

In the same case, upon appeal, the Lord Chancellor, in 1872, said :

"Though no one particular mark is imitated, the combination is very similar, and likely to deceive. It is true that there is no proof that any one has been deceived, or that the plaintiffs have incurred any loss; but where the similarity is obvious, that is not of importance." *Abbott v. Bakers' and Confectioners' Tea Association, Cox, M. T.-M. C.*, 213.

In the justly celebrated opinion of Judge Duer, in the *Amoskeag Man. Co. v. Spear*, he said :

"In an imitation of the original mark upon an article or goods of the same description, the name of the proprietor may be omitted, another name, that of the imitator himself, may be substituted; but if the peculiar device is copied, and so copied as to manifest a design of misleading the public, the omission or variation ought to be wholly disregarded. Its object, we may be certain, was not to communicate the truth, but to escape the penalty of falsehood. A fraud is intended, an unlawful gain is meant to be realized; but it is believed or hoped that an injunction may be avoided and claim for profits or damages be repelled. The fraud, however, if a Court of Equity is true to its principles, will be suppressed and its fruits be intercepted or restored. My conclusions on this branch of the subject are that an injunction ought to be granted whenever the design of a person who imitates a trade-mark, be his design apparent or proved, is to impose his own goods upon the public as those of the owner of the mark, and the imitation is such that the success of the design is a prob-

able or even possible consequence." *Amoskeag Manufacturing Co. v. Spear*, 2 Sand., S. C., 599; *Cox T.-M. Cases*, 95.

"Even if the wholesale buyer is not misled, but the small retailer or the consumer is, the right of action exists," was the language used in *Dixon Crucible Co. v. Guggenheim*, (2 Brewster, Penn., 335). See also *Clark v. Clark*, (25 Barb., 76), and *Brooklyn White Lead Co. v. Masaury*, (*Ibid.*, 416).

In the case of *Coats v. Holbrook*, Vice-Chancellor Sanford said :

"A man is not to sell the goods or manufacture of B under the show of pretence that they are the goods or manufactures of A, who, by superior skill or industry, has established the reputation of his articles in the market. The law will permit no person to practice a deception of that kind, or to use the means which contribute to effect it. He has no right and he will not be allowed to use the names, letters, marks, and other symbols by which he may palm off upon buyers as the manufacture of another the article he is selling, and thereby attract to himself the patronage that, without such deceptive use of such names, &c., would have enured to the benefit of that other person who first got up or was alone accustomed to use such names, marks, letters, or symbols." *Coats v. Holbrook*, 2 Sand. Chy. R., 504; *Cox's T.-M. Cases*, 221.

The Court said in *Gillott v. Esterbrook*, *supra* :

"The design to defraud by manufacturing and packing pens in all respects similar to the plaintiff's excepting only in the use of the name, appears very plainly. I cannot reason so artificially as to disguise this conclusion from myself."

The language of Lott, Senator, in *Taylor v. Carpenter*, shall close our quotations on the manner infringements have been made and the means and acts which have been declared to be infringements. He said:

"Honest competition relies only on the intrinsic merits of the article brought into market, and does not require a resort to a false or fraudulent device or token. That certainly cannot deserve the appellation which studiously gives to the product of pretended superior skill the name and exact resemblance and imita-

tion of the article with which it professes to compete. A disguise is not usually assumed for an honest object. It is a mark more characteristic of deception and fraud. It defeats the very end and object contemplated by legitimate competition, the choice to the public to select between the articles sold, and operates as a deception and imposition on the dealer." 2 *Sand. Ch. Rep.*, 613; *S. C. Cox T.-M. Cases*, 45.

What is lacking in authority to reach every case of infringement may be easily supplied from the never-failing fountain of justice, where principle finds universal application. What are the facts of this case? The appellees have not used a single letter, figure, or word that belongs to appellants' trade-mark proper, yet by the exact simulation of the plow in every perceivable point exposed to an ordinary observer and purchaser, and the use of the same coloring and staining, the same relative position of the letters and figures as employed and used by the appellants, avoiding the literal appropriation of any part of their trade-mark, the appellees have obscured their own and appellants' trade-mark, but at the same time sought to avoid detection and responsibility in doing so; and to cause their plows to be taken for and purchased as those of appellants. Thus by skillful combination of legal particles, taken one at a time and in the aggregate, leaving the mere trade-mark untouched, they have so confused its force and effect as to destroy its office and real efficiency to distinguish the appellants' plows from all others.

1. The appellees laid aside their own letters and numerals, which they commonly used to indicate the size, series, and quality of their plows, and literally took up those of the appellants.

2. They quit lettering cast and figuring steel plows; and reversed that order and adopted the order of use by appellants.

3. They consulted and deliberated before adopting the letters and numerals or imitating the construction of appellants' plows.

4. After the deliberation they so imitated the construction, numerals, and lettering of appellants' plows, that nothing but the reading of their trade-mark and close inspection could distinguish the difference.

5. They made large quantities of plows, leaving off their own trade-mark and name, and substituted therefor the names of jobbers, who were well known in the market to be vendors and not makers of plows, making it in their hands therefore impossible, without the aid of expert knowledge, to tell the difference between a Meikle and Avery plow, as they both had the same *indicia* and were constructed alike, the maker's name being altogether suppressed.

6. They have employed small salesmen to sell their plows, who place them on the market one-half dollar cheaper than the Avery plow, and so advertise them as to be taken for those of the appellants.

The combined force of this evidence is irresistible. It shows an intentional infringement, and not only possible injury, but such facts from which the law presumes some injury at least to be the necessary consequence. If such infringement as this be not enjoined and the profits resulting from it returned, then trade-mark law will never accomplish its prime object, named in the first sentence of this opinion on that branch of the subject we have discussed. The trade-mark and trade reputation pirate always undertakes the difficult task of sailing between the Charybdis and Scylla of the law, but he should never be allowed a successful voyage. If, on the one hand, he escapes the rock by not infringing through instrumentality of the trade-mark itself, he will not, on the other, if Courts of Equity are true to the principles of their own existence, be allowed a safe passage by the use of any means of deceit or false representations known to the inventive brain of man. Courts of law and equity have finally become possessed of jurisdiction, through the unfolding process of adjudication, ample to protect a trade-mark, which may be used by all to distinguish their goods from others; to prevent the sales of the goods of one as being those of another by means of fraud and misrepresentation in the use of marks, signs, words, numerals; or symbols; to afford redress for such sales of goods which are a misleading imitation of those of another, for whose manufacture they may be sold, where intentional false representations or fraud, from which damage the sales are made by the use

of a trade-mark, or direct or indirect, is presumed and its extent may be proven. In all cases, however, the conduct or adopted means of the imitator must be such as does or would probably deceive the ordinary mass of purchasers.

In conclusion, we repeat that this law grows out of the common principle of justice that the rights of each should be so used as not unnecessarily to injure those of others, whose skill has made their goods valuable in their reputation, that finally compensates them for their enterprise, industry, and fidelity. We are, therefore, of the opinion that the relief prayed for should have been granted.

The thanks of the Court are tendered to the able counsel on both sides of this case, for the great assistance they have rendered us in our efforts to arrive at a conclusion in strict obedience to authority and principle.

Wherefore the judgment is reversed and cause remanded for further proceedings consistent with this opinion.

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SUPREME COURT OF THE UNITED STATES.
IN EQUITY.

MANHATTAN MEDICINE COMPANY*vs.*

WOOD, AND ANOTHER.

DECIDED 2 APRIL, 1883.

REPORTED 108 U. S., 218.

“*Atwood's Vegetable Bitters.*”

1. A Court of Equity will extend no aid to sustain a claim to a trade-mark of an article which is put forth with a misrepresentation to the public as to the manufacturer of the article, and as to the place where it is manufactured, both being originally circumstances to guide the purchaser of the medicine.
2. When it is the object of a trade-mark to indicate the origin of manufactured goods, and a person affixes to goods of his own manufacture a trade-mark which declares that they are goods of the manufacture of some other person, it is a fraud upon the public which no Court of Equity will countenance.
3. The plaintiff claimed to be the owner of a patent medicine and of a trade-mark to distinguish it. The medicine was manufactured by the

plaintiff in New York; the trade-mark declared that it was manufactured by another party in Massachusetts. **HELD:**

That he was entitled to no relief against a person using the same trade-mark in Maine.

APPEAL from the Circuit Court of the United States for the District of Maine.

Bill in equity to restrain the defendants from using an alleged trade-mark of the complainant, upon certain medicines prepared by them, and to compel an accounting for the profits made from its use in their sale of the medicines; also, the payment of damages for their infringement of the complainant's rights.

The complainant, a corporation formed under the laws of New York, manufactured in that State medicines designated as "Atwood's Vegetable Physical Jaundice Bitters;" and claimed as its trade-mark this designation, with the accompanying labels. Whatever right it possessed, it derived by various *mesne* assignments from one Moses Atwood, of Georgetown, Massachusetts. The bill alleged that the complainant was, and for a long time previous to the grievances complained of had been the manufacturer and vendor of the medicine mentioned; that it was put up and sold in glass bottles with twelve panel-shaped sides, on five of which in raised words and letters "Atwood's Genuine Physical Jaundice Bitters, Georgetown, Mass." were blown in the glass, each bottle containing about a pint, with a light yellow printed label pasted on the outside designating the many virtues of the medicine, and the manner in which it was to be taken; and stating that it was manufactured by Moses Atwood, Georgetown, Mass., and sold by his agents throughout the United States.

The bill also alleged that the bottles thus filled and labeled were put up in half dozen packages with the same label on each package; that the medicine was first invented and put up for sale about twenty-five years ago by one Dr. Moses Atwood, formerly of Georgetown, Massachusetts, by whom and his assigns and successors, it had been ever since sold "by the name, and in the manner, and with the trade-marks, label, and description substantially the same as aforesaid;" that the complainant was the

exclusive owner of the formula and recipe for making the medicine, and of the right of using the said name or designation, together with the trade-marks, labels, and good-will of the business of making and selling the same; that large sales of the medicine under that name and designation were made, amounting annually to twelve thousand bottles; that the defendants were manufacturing and selling at Portland, Me., and at other places within the United States unknown to the complainant, an imitation of the medicine, with the same designation and labels, and put up in similar bottles, with the same, or nearly the same, words raised on their sides, in fraud of the rights of the complainant and to its serious injury; that this imitation article was calculated and was intended to deceive purchasers, and to mislead them to use it instead of the genuine article manufactured by the complainant, and had had, and continued to have that effect. The bill, therefore, prayed for an injunction to restrain the defendants from affixing or applying the words "Atwood's Vegetable Physical Jaundice Bitters," or either of them, or any imitation thereof, to any medicine sold by them, or to place them on any bottles in which it was put up, and also, from using any labels in imitation of those of the complainant. It also prayed for an accounting of profits and for damages.

Among the defences interposed were these: That Moses Atwood never claimed any trade-mark of the words used in connection with the medicine manufactured and sold by him; and assuming that he had claimed the words used as a trade-mark, and that the right to use them had been transferred to the assignors of the complainant, it was forfeited by the representation as to the manufacture of the medicine on the labels accompanying it; a misrepresentation continued by the complainant.

The cause was heard before CLIFFORD, J., and the bill was dismissed with costs. From this decree the plaintiffs appealed.

Mr. Philo Chase, for appellant.

The main part of this brief was occupied with a discussion of the facts. The following points of law were taken: The name adopted was a good trade-mark, assignable, and entitled to pro-

tection in the hands of the assignee. *McLean v. Fleming*, 96 U. S., 245; *Kidd v. Johnson*, 100 U. S., 617; *Hall v. Barrows*, 4 DeG., J. & S., 150; 33 L. J. (N. S.), 204; 10 *Jurist* (N. S.), 55; *Fulton v. Sellers*, Penn. Sup. Ct., 4 *Brewster*, 42; *Field v. Lewis, Seten*, 4th Ed. 237. The law will not allow one man to sell his goods as those of another by the use of similar labels. *Perry v. Truefitt*, 6 *Beavan*, 66; *Croft v. Day*, *Id.*, 84; *Taylor v. Carpenter*, 11 *Paige*, 292; *Coffeen v. Brinton*, 5 *McLean*, 256; *Taylor v. Taylor*, 2 *Eq. Rep.*, 290; *Farina v. Silverlock*, 2 *Jurist* (N. S.), 1008; *Brooklyn White Lead Co. v. Masaury*, 25 *Barb.*, 416; *Edelston v. Edelston*, 9 *Jurist*, (N. S.), 479; *Boardman v. The Meriden Britannia Co.*, 35 *Conn.*, 402; *Cohan v. Crump*, 70 *N. Y.*, 573. A transfer and succession of business of an article carries with it its trade-marks by implication. *Shipwright v. Clements*, 19 *W. R.*, 599; *The Congress and Empire Spring Co. v. The High Rock Spring Co.*, 45 *N. Y.*, 291. The law presumes when one intentionally uses or closely imitates another's trade-marks, merchandise, or manufactures, that he does it for the fraudulent purpose of inducing the public or those dealing in the article to believe that the goods are those made or sold by the latter, and of supplanting him in the good-will of his trade or business. *Taylor v. Carpenter*, 11 *Paige*, 292. The rule is that the Court will enjoin any imitation calculated to deceive ordinary purchasers. *Crawshaw v. Thompson*, 4 *Man. & G.*, 385; *Davis v. Kendall*, 2 *R. I.*, 556; *Holmes v. Holmes, &c., Company*, 37 *Conn.*, 278; *Wotherspoon v. Currie*, 22 *L. T. R.*, (N. S.), 260; *Hookman v. Pottage*, 26 *L. T. R.*, (N. S.), 755. To be enjoined it is not necessary that the imitation should be complete; the imitation may be limited and partial, and still be enjoined. *Lockwood v. Bostwick*, 2 *Daly* (N. Y.), 521; *Franks v. Weaver*, 10 *Beavan*, 297; *Coffeen v. Brinton*, 4 *McLean*, 516; *Shrimpton v. Laight*, 18 *Beavan*, 164; *Walton v. Crowley*, *supra*; *Clark v. Clark*, 25 *Barbour*, (N. Y.), 76; *Brooklyn White Lead Company v. Masaury*, *Id.*, 416; *Hostetter v. Bowinkle*, 1 *Dillon*, 329. To be enjoined it is not requisite that the imitation should be intentionally deceptive. *Willington v. Fox*, 3 *Mylne & Cr.*, 338; *Dale v. Smithson*, 12 *Abb. Pr. R.*, (N. Y.). It is no defence that the imitator in-

forms purchasers of the imitation. It is no answer for the defendants to say that they sold the bitters as theirs. *Coats v. Holbrook*, 2 *Sandf. Ch.*, 586; *Chappel v. Davidson*, 2 *Kay & J.*, 123. It is sufficient to establish a case for relief to show that the imitation has led or is likely to lead to mistakes. *Clement v. Maddick*, 5 *Jurist*, (*N. S.*), 592. The plaintiff, in trade-mark cases, is entitled to relief, though the respondent did not know that the mark used was a trade-mark. *Kindham v. Bolton*, 15 *Irish Ch.*, 75; *Harrison v. Taylor*, 11 *Jurist*, (*N. S.*), 408; *Hall v. Barrows*, 10 *Id.*, (*N. S.*), 55; *Ainsworth v. Wormsley*, 12 *Id.*, 205. The fact that the trade-marks were used in common by the several owners thereof, did not make them common property as to the world. *Condy v. Mitchell*, 26 *W. R.*, 269; *Motley v. Dowman*, 3 *Mj. & Cr.*, 1; *Robinson v. Finlay*, 27 *W. R.* 294; *Weston v. Ketcham*, 39 *N. Y. Superior Court*, 54; *Rogers v. Taintor*, 97 *Mass.*, 291; *Sohl v. Geisendorf*, 1 *Wilson*, (*Ind.*), 60. No Statute of Limitations bars the plaintiff of protection of its trade-marks. *Taylor v. Carpenter*, 3 *Story*, 458; *Taylor v. Carpenter*, 2 *Wood & M.*, 1.

Mr. Thorndike Saunders, also for appellant.

Mr. William Henry Clifford, for appellees.

MR. JUSTICE FIELD delivered the opinion of the Court.

After reciting the facts as stated above, he said:

In the view we take of the case, it will not be necessary to consider the first defence mentioned, nor the second, so far as to determine whether the right to use the words mentioned as a trade-mark was forfeited absolutely by the assignor's misrepresentations as to the manufacture of the article. It is sufficient for the disposition of the case, that the misrepresentation has been continued by the complainant.

1. A Court of Equity will extend no aid to sustain a claim to a trade-mark of an article which is put forth with a misrepresentation to the public as to the manufacturer of the article, and as to the place where it is manufactured, both of which particulars were original circumstances to guide the purchaser of the medicine.

It is admitted that whatever value the medicine possesses was given to it by its original manufacturer, Moses Atwood. He lived in Georgetown, Massachusetts. He manufactured the medicine there. He sold it with the designation that it was his preparation, "Atwood's Vegetable Physical Jaundice Bitters," and was manufactured there by him. As the medicine was tried and proved to be useful, it was sought for under that designation, and that purchasers might not be misled, it was always accompanied with a label, showing by whom and at what place it was prepared. These statements were deemed important in promoting the use of the article and its sale, or they would not have been continued by the assignees of the original inventor. And yet they could not be used with any honest purpose when both statements had ceased to be true. It is not honest to state that a medicine is manufactured by Moses Atwood, of Georgetown, Massachusetts, when it is manufactured by the Manhattan Medicine Company in the City of New York.

Any one has an unquestionable right to affix to articles manufactured by him a mark or device not previously appropriated, to distinguish them from articles of the same general character manufactured and sold by others. He may thus notify the public of the origin of the article and secure to himself the benefits of any particular excellence it may possess from the manner or materials of its manufacture. His trade-mark is both a sign of the quality of the article and an assurance to the public that it is the genuine product of his manufacture. It thus often becomes of great value to him, and in its exclusive use the Court will protect him against attempts of others to pass off their products upon the public as his. This protection is afforded not only as a matter of justice to him, but to prevent imposition upon the public. *Manufac. Co. v. Trainer*, 101 U. S., 51.

2. The object of the trade-mark being to indicate, by its meaning or association, the origin or ownership of the article, it would seem that when a right in its use is transferred to others, either by act of the original manufacturer or by operation of law, the fact of transfer should be stated in connection with its use; otherwise a deception would be practiced upon the public, and the very fraud

accomplished, to prevent which Courts of Equity interfere to protect the exclusive right of the original manufacturer. If one affix to goods of his own manufacture signs or marks which indicate that they are the manufacture of others, he is deceiving the public and attempting to pass upon them goods as possessing a quality and merit which another's skill has given to similar articles, and which his own manufacture does not possess in the estimation of purchasers. To put forth a statement, therefore, in the form of a circular or label attached to an article, that it is manufactured in a particular place, by a person whose manufacture there had acquired a great reputation, when, in fact, it is manufactured by a different person at a different place, is a fraud upon the public which no Court of Equity will countenance.

This doctrine is illustrated and asserted in the case of *The Leather Cloth Company, (limited) v. The American Leather Cloth Company, (limited)*, which was elaborately considered by Lord Chancellor Westbury, and afterwards in the House of Lords on appeal from his decree. 4 *DeG., J. & S.*, 137, and 11 *House of Lords' Cases*, 523.

In that case, an injunction was asked to restrain the defendant from using a trade-mark to designate leather cloth manufactured by it, which trade-mark the complainant claimed to own. The article known as leather cloth was an American invention, and was originally manufactured by J. R. & C. P. Crockett, at Newark, New Jersey. Agents of theirs sold the article in England as "Crockett's Leather Cloth." Afterwards a company was formed entitled "The Crockett International Leather Cloth Company," and the business previously carried on by the Crocketts was transferred to this company, which carried on business at Newark, in America, as a chartered company, and at West Ham, in England, as a partnership. In 1856, one Dodge took out a patent in England for tanning leather cloth and transferred it to this company. In 1857 the complainant company was incorporated, and the International Company sold and assigned to it the business carried on at West Ham, together with the letters patent, and full authority to use the trade-mark which had been previously used by it in England. A small part of the leather cloth manufactured by the

complainant company was tanned or patented. It, however, used a label which represented that the articles stamped with it were the goods of the Crockett International Leather Cloth Company; that they were manufactured by J. R. & C. P. Crockett; that they were tanned leather cloth; that they were patented by a patent obtained in 1856, and were made either in the United States or at West Ham, in England. Each of these statements or representations was untrue so far as they applied to the goods made and sold by the complainant.

The defendant having used on goods manufactured by it a mark having some resemblance to that used by the complainant, the latter brought suit to enjoin the use. Vice-Chancellor Wood granted the injunction, but on appeal to the Lord Chancellor the decree was reversed and the bill dismissed. In giving his decision the Lord Chancellor said that the exclusive right to use a trade-mark with respect to a vendible commodity is rightly called property; that the jurisdiction of the Court in the protection of trade-marks rests upon property, and that the Court interferes by injunction because that is the only mode by which property of that description can be effectually protected. But he added:

“When the owner of the trade-mark applies for an injunction to restrain the defendant from injuring his property by making false representations to the public, it is essential that the plaintiff should not in his trade-mark, or in the business connected with it, be himself guilty of any false or misleading representation; for if the plaintiff makes any material false statement in connection with the property he seeks to protect, he loses, and very justly, his right to claim the assistance of a Court of Equity.”

And again:

“Where a symbol or label, claimed as a trade-mark, is so constructed or worded as to make or contain a distinct assertion which is false, I think no property can be claimed in it, or, in other words, the right to the exclusive use of it cannot be maintained.”

When the case reached the House of Lords the correctness of this doctrine was recognized by Lord Cranworth, who said that of the justness of the principle no one could doubt; that it is founded in honesty and good sense, and rests on authority as well

as on principle, although the decision of the House was placed on another ground.

The soundness of the doctrine declared by the Lord Chancellor has been recognized in numerous cases. Indeed, it is but an application of the common maxim that he who seeks equity must present himself in Court with clean hands. If his case discloses fraud or deception or misrepresentation on his part, relief there will be denied.

Long before the case cited was before the Courts, this doctrine was applied when protection was sought in the use of trade-marks. In *Pidding v. How*, 8 *Simons*, 477, which was before Vice-Chancellor Shadwell in 1837, it appeared that the complainant was engaged in selling a mixed tea, composed of different kinds of black tea, under the name of "Howqua's Mixture," in packages having on three of their sides a printed label with those words. The defendant having sold tea under the same name, and in packages with similar labels, the complainant applied for an injunction to restrain him from so doing.

An *ex parte* injunction, granted in the first instance, was dissolved, it appearing that the complainant had made false statements to the public as to the teas of which his mixture was composed, and as to the mode in which they were procured. "It is a clear rule," said the Vice-Chancellor, "laid down by Courts of Equity, not to extend their protection to persons whose case is not founded in truth."

In *Perry v. Truefitt*, 6 *Beav.*, 66, which was before Lord Langdale, Master of the Rolls, in 1842, a similar ruling was had. There it appeared that one Leathart had invented a mixture for the hair, the secret and recipe for mixing which he had conveyed to the plaintiff, a hair-dresser and perfumer, who gave to the composition the name of "Medicated Mexican Balm," and sold it as "Perry's Medicated Mexican Balm." The defendant, one Truefitt, a rival hair-dresser and perfumer, commenced selling a composition similar to that of plaintiff, in bottles with labels closely resembling those used by him. He designated his composition and sold it as "Truefitt's Medicated Mexican Balm." The plaintiff thereupon filed his bill, alleging that the name or designation

of "Medicated Mexican Balm" had become of great value to him as his trade-mark, and seeking to restrain the defendant from its use. It appeared, however, that the plaintiff, in his advertisements to the public, had falsely set forth that the composition was "a highly concentrated extract from vegetable balsamic productions" of Mexico, and was prepared from "an original recipe of the learned J. F. Von Blumenbach, and was recently presented to the proprietor by a very near relation of that illustrious physiologist;" and the Court, therefore, refused the injunction, the Master of the Rolls holding that, in the face of such a misrepresentation, the Court would not interpose in the first instance, citing with approval the decision in the case of *Pidding v. How*.

In a case in the Superior Court in the City of New York—*Fetridge v. Wells*, 4 *Abbott*, (*N. Y.*), 144—this subject was very elaborately and ably treated by Chief Justice Duer. The plaintiff there had purchased a recipe for making a certain cosmetic, which he sold under the name of "The Balm of a Thousand Flowers." The defendants commenced the manufacture and sale of a similar article, which they called "The Balm of Ten Thousand Flowers." The complainant, claiming the name used by him as a trade-mark, brought suit to enjoin the defendants in the alleged infringement upon his rights. A temporary injunction was granted; but afterwards, upon the coming in of the proofs, it was dissolved. It appeared that the main ingredients of the compound were oil, ashes and alcohol, and not an extract or distillation from flowers. Instead of being a balm, the compound was a soap. The Court said it was evident that the name was given to it and used to deceive the public, to attract and impose upon purchasers, that no representation could be more material than that of the ingredients of a compound recommended and sold as a medicine; that there was none so likely to induce confidence in its use, and none, when false, that would more probably be attended with injurious consequences. And, it also said:

"Those who come into a Court of Equity, seeking equity, must come with pure hands and a pure conscience. If they claim relief against the frauds of others, they must themselves be

free from the imputation. If the sales made by the plaintiff and his firm are effected, or sought to be, by misrepresentation and falsehood, they cannot be listened to when they complain that, by the fraudulent rivalry of others, their own fraudulent profits are diminished. An exclusive privilege for deceiving the public is assuredly not one that a Court of Equity can be required to aid or sanction. To do so would be to forfeit its name and character."

See also *Seabury v. Grosvenor*, 14 *Blatchford*, 262; *Hobbs v. Francais*, 19 *How.*, (*N. Y.*) 567; *Connell v. Reed*, 128 *Mass.*, 477; *Palmer v. Harris*, 60 *Penn. St.*, 156. The doctrine enunciated in all these cases is founded in honesty and good sense; it rebukes fraud and encourages fair dealing with the public. In conformity with it, this case has no standing before a Court of Equity.

3. The decree of the Court below dismissing the bill must therefore be affirmed; and it is so ordered.

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SUPREME COURT, STATE OF PENNSYLVANIA.
IN EQUITY.

DESMOND'S APPEAL.

DECIDED 9 APRIL, 1883.

REPORTED 103 PENN. ST. REP., 126.

"Samaritan" Case.

1. A bill filed to restrain an alleged infringement of a trade-mark based upon labels or wrappers, which does not aver a similarity or imitation in the appearance of the labels or wrappers, is insufficient and will be held bad on demurrer.
2. The appropriation as a trade-mark of the word "Samaritan" in one combination of words, does not prevent its being used as a trade-mark in any other combination.

March 27th, 1883. Before MERCER, C., J., GORDON, PAXSON, TRUNKEY, and GREEN, JJ., STERRETT and CLARK, JJ., absent.

APPEAL from the Court of Common Pleas, No. 2 of Philadelphia County. In equity of January Term, 1883, No. 240.

This was an appeal by Thomas Desmond, trading as Desmond & Co., from a decree of the said Court, sustaining a demurrer to

and dismissing a bill in equity, filed by said Desmond & Co. against Mahlon K. Smith, Mahlon N. Kline, Washington J. Sellers and Silas W. Hellerman, trading as Smith, Kline & Co., to restrain the defendants from alleged infringement of certain registered trade-marks, which were used in course of plaintiff's business.

The plaintiff averred in his bill that he had engaged in the manufacture of certain compound medicines since 1863, that during that period he had used in their sale and advertisement certain trade-marks, which were duly registered in the office of the clerk of the United States District Court; that the said medicines have been and are distinguished by the names of "Samaritan's Gift," and "Samaritan's Root and Herb Juices," which names are the aforesaid trade-mark and are of great value to the plaintiff in designating the said medicine; that one Dr. S. A. Richmond, trading under the name of Dr. S. A. Richmond & Co., and doing business in the City of St. Joseph, in the State of Missouri, intending to invade the rights of complainant, has commenced to manufacture a compound medicine of a character similar to one of the said medicines manufactured and sold by complainant, and has sold and advertised the same under the trade-marks of complainant, saving a slight alteration in the same, to wit: By substituting the word "Nervine" in the trade-mark of the said Dr. S. A. Richmond & Co., for the words "Gift" and "Root and Herb Juices" in complainant's trade-mark, and the said Dr. S. A. Richmond & Co. have recently largely advertised the same in various parts of the United States, and particularly in State of Pennsylvania, where complainant's medicines are well-known and highly valued. And complainant further complains that by the use of his trade-mark, altered as aforesaid, the said Dr. S. A. Richmond & Co. well knew that they would be able to invade the rights of complainant, and that the public would be readily deceived in mistaking the medicines so vended by complainant as aforesaid. Further, that the use of his trade-marks so altered as aforesaid has deceived many persons who were willing and anxious to purchase the medicines of complainant; that the said firm of Smith, Kline & Co. are now en-

gaged in offering for sale the said medicines of the said Dr. S. A. Richmond & Co., under the name of "Samaritan Nervine," at their place of business, Nos. 309 and 311 North Third Street, in the City of Philadelphia; that the said Smith, Kline & Co. have sold and attempted to sell the said medicine with the trade-marks, labels and wrappers of complainant, so altered as aforesaid, to the great diminution of complainants' profits and business.

The plaintiff therefore prayed for a perpetual injunction and an account. An amended bill was subsequently filed, joining S. A. Richmond as co-defendant, and charging further that the said S. A. Richmond "did willfully and knowingly and with intent and design to imitate the same, use the word 'Samaritan;'" * * * that by reason of the imitation and copying of the label thereof by the said Richmond, the public are deceived and led to believe it is the complainants' article they are buying and that complainant is a great loser thereby."

The defendants demurred, assigning the following reasons, *inter alia*: Third. Because the name "Samaritan's Gift" and "Samaritan's Root and Herb Juices," do not constitute trade-marks within the meaning and protection of the law in such cases. Seventh. Because it is not alleged that there is any imitation or similarity between the appearance of the labels and wrappers alleged to be used by the defendants. Eighth. Because it appears by said bill that the only similarity in the names or words used by the defendants is in the use of the name "Samaritan," and that the name "Samaritan," being the name of a place, and, further, having a well understood, and popular use, derived from the parable of the Good Samaritan, whereby it is popularly used to signify or describe an act, matter, or thing of a charitable or benevolent nature for the purpose of relieving the wounded, sick, or afflicted, no trade-mark can be taken in such a word, it belonging in this use to the general popular vocabulary.

The Court after argument, sustained the demurrer and entered a decree dismissing the bill. The plaintiff thereupon took this appeal, assigning for error the said decree of the Court.

Pierce Archer (*R. P. Deckert* with him), for the appellant.

To make out a case of infringement of a trade-mark exact similarity is not required, as that would always enable the wrongdoer to evade responsibility for his wrongful acts. Where the similarity is sufficient to convey a false impression to the public mind and is of a character to mislead and deceive the ordinary purchaser, it is sufficient: *McLean v. Fleming*, 6 *Otto*, 245; *Sheppard v. Stuart*, 7 *W. N. C.*, 498. Any words, phrase, symbols, figure, name, letter, form or device may be used as a trade-mark, and will be protected as such. Thus "Eureka" was upheld as a good trade-mark in *Allegheny Fert. Co. v. Woodside*, 1 *Hughes*, 115; "Charter Oak" in *Filley v. Hassett*, 44 *Mo.*, 173; "Excelsior" in *Sheppard v. Stuart*, *supra*; "Anatolia" in *McAndrew v. Bassett*, 10 *Jurist*, (*N. S.*), 550; "Hero" in *Rowley v. Houghton*, 2 *Brews.*, 303; "Keystone Line" in *Winsor v. Clyde*, 9 *Phila.*, 513. That the defendants intended to imitate our trade-mark and did imitate it to our injury is admitted by them, when they entered a general demurrer. *Ins. Co. v. Drach*, 12 *W. N. C.*, 379.

Rowland Evans, and *R. L. Ashhurst*, for the appellee.

The demurrer admits only such facts as are well pleaded and not such as are repugnant to each other. 1 *Daniel's Chancery Practice*, 566. A mere English adjective or a word which lacks originality cannot claim protection as a trade-mark. *Raggett v. Findlater*, 17 *L. R. Eq.*, 37; *Canal Co. v. Clark*, 13 *Wall.*, 320; *Glendon Iron Co. v. Uhler*, 25 *S.*, 470. That such a word as Samaritan, in its derivative sense a synonym for philanthropic, cannot be exclusively appropriated as a trade-mark, is shown by the following cases, in which the words "Schiedam Schnapps," "Charity," "Gold Medal," "Centennial," "Mexican Balm," "Night-Blooming Cereus," "Club House," were held to lack the requisite originality. *Wolf v. Goulard*, 18 *Howard Pr.*, 64; *Isaacs v. Daly*, 39 *N. Y. Superior Ct.*, 7 *J. & S.*, 511; *Taylor v. Gillies*, 59 *N. Y.*, 331; *Hartell v. Viney*, 2 *W. N.*, 602; *Perry v. Truefitt*, 6 *Beav.*, 66; *Phalon v. Wright*, 5 *Phila.*, 464; *Corwin v. Daley*, 7 *Bos.*, 222.

The opinion of the Court was filed April 9th, 1883.

PER CURIAM.—The original bill declares “that the said medicines have been and are distinguished by the names of ‘Samaritan’s Gift,’ and ‘Samaritan’s Root and Herb Juices,’ and that the said names are the trade-marks of the same, together with certain labels and wrappers hereto annexed marked ‘Exhibit A,’ and by the said trade-marks the same are distinguished from all other compound medicines.”

1. It does not aver an imitation or similarity in the appearance of the labels and wrappers. An examination of the two shows they are quite dissimilar in names and appearance. It is true each has the word “Samaritan,” but in such different form and combination of words as to preclude one medicine being taken for the other. We do not think the amended bill removes the difficulty of the appellant.

2. The appropriation of the word “Samaritan” in one combination of words does not prevent its being used in all other combinations.

Decree affirmed and appeal dismissed at the costs of the appellant. 7 *Outerbridge*, 9.

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CIRCUIT COURT UNITED STATES, WESTERN
DISTRICT OF PENNSYLVANIA. IN EQUITY.

GRAY, AND OTHERS, doing business under the firm-
name of TAPER-SLEEVE PULLEY WORKS, Citizens
of the State of Pennsylvania,

vs.

TAPER-SLEEVE PULLEY WORKS, a Corporation of the
State of Iowa.

DECIDED MAY, 1883.

REPORTED 16 FEDERAL REP., 436.

“Taper-sleeve Pulley” Case.

- I. TRADE NAME—RIGHT TO SELL ARTICLE—INJUNCTION.—C., under the style of A. B. Cook & Co., was engaged for several years at Erie, Pennsylvania, in the manufacture and sale of sundry patented devices, to one of which he gave the name “taper-sleeve pulley,” displaying on his factory the sign “Taper-sleeve Pulley Works.” In 1876, his establishment was sold by the sheriff to W., to whom C. assigned his patents. W. soon sold the establishment to one of the complainants, with the exclusive right to said patents for the territory east of the Mississippi River, and the right also to sell the devices west of said

river upon the payment of certain royalties, W. reserving to himself and assigns the right to sell on like terms east of said river. The complainants adopted as their trade name the designation "Taper-sleeve Pulley Works," and in that name built up a large general trade throughout the United States. In 1882, W. sold to one Christian, the territorial right in said patents in certain States west of the Mississippi, with his reserved right to sell east of that river. Christian and his associates selected Dubuque, Iowa, as their place of manufacture, adopting as their firm-name "Farrar, Christian & Co.," but in December, 1882, organized themselves into an Iowa corporation, assuming the corporate name "Taper-sleeve Pulley Works," and issued catalogues, price-lists and advertisements which are almost exact *fac similes* of those of the complainants.

2. HELD, that while the Iowa corporation, having the right to make and sell the device called the "taper-sleeve pulley," had also the right to so designate the article and advertise itself as a manufacturer and vendor thereof, it had no right to assume the complainants' trade name, "Taper-sleeve Pulley Works," and the complainants were entitled to equitable protection in the exclusive use thereof.
3. FOREIGN CORPORATION—TORTS—INJUNCTION.—For a tort committed by a foreign corporation within the State of Pennsylvania, such corporation is liable to be sued therein if found in the State in the person of an officer or agent upon whom process may be served.

J. K. Hallock, for complainants.

W. F. McCook, and *Clark Olds*, for defendants.

ACHESON, J.:

For several years prior to December 16, 1876, A. B. Cook, Jr., under the business name of A. B. Cook & Co., was engaged at the City of Erie, Pennsylvania, in the manufacture and sale of wooden pulleys, pulleys with friction fastenings, dead-pulley rigs, shaft-hangers, etc., under certain letters patent of the United States of which he was then the sole owner. To the pulleys having friction fastenings Cook gave the name of "taper-sleeve pulleys," and by that appellation they became known to the trade and public.

1. On the building leased by him in which he carried on business, he displayed a sign which read "Taper-sleeve Pulley Works." Upon the date above-mentioned, on an execution against him, the

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entire machinery, stock, etc., of his said establishment were sold by the sheriff to James R. Willard, to whom Cook assigned said patents. From December 16, 1876, to May 26, 1877, Willard was the proprietor of the establishment, and for most of that time he maintained an advertisement in a newspaper of general circulation at Erie, offering the machinery, etc., for sale, in which he designated the concern as the "Taper-sleeve Pulley Works." By an article of agreement dated May 26, 1877, Willard sold to A. H. Gray, one of the complainants, the said property, describing it as "the property known as the Erie Wooden-pulley and Taper-sleeve Coupling Works," together, also, with the exclusive right to said patents for all that part of the United States lying east of the Mississippi River, (except the State of Minnesota;) the article providing that either party thereto, or his assigns, might sell goods manufactured under the patents within the territory of the other, paying for the privilege certain specified royalties; but until Willard or his assigns should engage in the manufacture within the reserved territory, Gray to have the free privilege of selling therein.

Immediately after his purchase Gray took possession of the said property and business, and forthwith adopted the designation "Taper-sleeve Pulley Works" as his trade name; and under that style and title the entire business has since been continuously conducted,—at first, by Gray alone, and then by him and H. C. Crowell, the other complainant, copartners. When Gray took the works the business was confined to a small local trade; but the complainants, by their energy and a liberal expenditure of money, have built up a very large general trade all over the United States and in foreign countries. It is especially large in the States of Ohio, Indiana, Illinois, Wisconsin, Michigan, and Minnesota. The complainants have agencies at Minneapolis, Chicago, Detroit, Saginaw, Cleveland, Toledo, Cincinnati, St. Louis, New Orleans, Baltimore, Atlanta, New York City, Rochester, and Buffalo, all of which advertise the complainants' wares as the goods of the "Taper-sleeve Pulley Works." The line of goods manufactured and sold by the complainants is much fuller and more complete than was that of A. B. Cook & Co., and while but

one of the articles made by them can be called a taper-sleeve pulley, all of whatever nature have been and are stamped or marked "Taper-sleeve Pulley Works," and by that name the complainants' business and their goods are everywhere known.

By contract dated July 14, 1882, the said Willard sold and granted to Charles E. Christian, of the said City of Erie, the right to manufacture and sell articles under the said patents in Minnesota, and nine other named States and Territories lying west of the Mississippi River, together with the right to sell such articles east of that river under the stipulations contained in the agreement with Gray of May 26, 1877. Christian soon associated with himself Charles W. Farrar, Edwin Bindley, and Clark Olds. These persons selected Dubuque, Iowa, as their place of manufacture, and adopted as their firm-name "Farrar, Christian & Co.," and used that style and title (although they had not yet begun to manufacture) until December 13, 1882, when they organized themselves as a corporation under the laws of the State of Iowa, by filing articles of incorporation with the county recorder, assuming the corporate name of "Taper-sleeve Pulley Works."

The corporation has issued and circulated catalogues, price-lists, and advertisements in the western district of Pennsylvania, and generally throughout the United States, in the name of "Taper-sleeve Pulley Works," some of which are exact *fac similes* of the complainants' catalogues, price-lists, and advertisements, except that the words "Dubuque, Iowa," are substituted for "Erie, Pennsylvania," and the words "A. H. Gray, treasurer," and "H. C. Crowell, superintendent," are omitted. The complainants, have used a green label on their taper-sleeve pulleys containing directions for their use. The defendant company has had printed at Erie, off the form used for the complainants, labels identical in color and otherwise with those of the complainants, and is using them on the article of its manufacture. It has also had printed at Erie circulars from the same type and wood cuts used for printing the complainants' circulars, with such changes only as are necessary to adopt them to its use. On all goods sold by the defendant the name "Taper-sleeve Pulley Works" is marked or branded, with the addition "of Dubuque, Iowa."

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The foregoing are the material facts of the case, and by the evidence before the Court are established clearly. There are affidavits also to show that, by reason of defendant's said acts, considerable confusion has already arisen among the complainants' customers, some supposing the complainants have moved their business to Dubuque, and others thinking they have established a branch concern there.

The complainants seek to have the defendant company restrained by injunction from using the name "Taper-sleeve Pulley Works."

Are they entitled to such relief?

It will be observed that the complainants do not claim to have the exclusive right to use the descriptive appellation, "Taper-sleeve Pulley." They freely admit that the defendant, having the right to make and sell that device, has also the right to designate it by the name it has acquired in the trade. Nor do they question the right of the defendant company to advertise itself as a manufacturer and vendor of taper-sleeve pulleys. They object not to honest rivalry. Their complaint is against what they assert is unfair competition, by reason of the unnecessary and hurtful appropriation by the defendant of their long-used and established trade name, by which their wares are everywhere favorably known, and upon which their good business reputation rests.

That a lawful trade-mark, whether consisting of words or devices, is entitled to equitable protection, is now so well understood that it is scarcely necessary to cite authorities in support of the principle. "Everywhere" (says the Supreme Court in *McLean v. Fleming*, 96 U. S., 252), "Courts of justice proceed upon the ground that a party has a valuable interest in the good-will of his trade, and in the labels or trade-mark which he adopts to enlarge and perpetuate it." Hence, one will be protected in the enjoyment of his trade name to the same extent that trade-marks are protected, and for the like reason. *Holmes, Booth & Hayden v. Holmes, Booth & Atwood Manuf'g Co.*, 37 Conn., 278; *Newby v. Ohio Cent. R. Co.*, *Deady*, 609; *Lee v. Haley*, L. R., 5 Ch. App., 155. "It is," says Giffard, L. J., "a fraud on a person who has established a trade, and carries it on under a given name,

that some other person should assume the same name, or the same name with a slight alteration, in such a way as to induce persons to deal with him in the belief that they are dealing with the person who has given a reputation to the name." *Id.*, 161.

The present case turns upon the determination of the question, had Gray the right to assume the exclusive use of the name "Taper-sleeve Pulley Works" as a business designation? And why not? True, it did not originate with him, but this of itself is an immaterial circumstance. *Canal Co. v. Clark*, 13 Wall., 311, 322. It did, however, originate with his predecessor in business, A. B. Cook, Jr., and whatever right he may have acquired therein impliedly passed, I incline to think, to Willard, the sheriff's vendee, and from him to Gray. *Kerr, Inj.*, 479. But if not, Cook having abandoned the same, Gray had the right to appropriate it (*Browne, Trade-Marks*, secs. 676, 677), if it could be lawfully selected as a trade name. Was it without the limits of rightful selection, as the defendant maintains? It is undoubtedly accepted law (as we see by reference to *Amoskeag Manuf'g Co. v. Spear*, 2 Sandf., 606), that no one has the right to the exclusive use of any words which have no relation to the origin or ownership of the goods, but are only meant to indicate their names or quality. Speaking on this point, Mr. Justice Strong, in *Canal Co. v. Clark*, *supra*, said:

"The trade-mark must, either by itself, or by association, point distinctly to the origin or ownership of the article to which it is applied."

And two rules are stated by him in restriction of the right of selection.

"No one can claim protection for the exclusive use of a trade name or trade-mark which would practically give him a monopoly in the sale of any goods other than those produced or made by himself * * * Nor can a generic name, or name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, be employed as a trade-mark, and the exclusive use of it be entitled to legal protection."

Is there anything in these rules which the defendant company can invoke to justify it in assuming the business name hitherto in

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the exclusive use of the complainants? The title when adopted by Gray was novel as a trade name—it is certainly a very peculiar trading appellation,—and by long association it has become inseparably identified with the complainants' business, pointing directly to the origin of all the wares, of every kind, of their manufacture. The title "Taper-sleeve Pulley Works" is not merely descriptive of an article of manufacture or trade, as the words "Lackawanna coal" were (in *Canal Co. v. Clark*) held to be. Nor does this name, by any means, give the complainants a monopoly in the manufacture and sale of the device called the "taper-sleeve pulley." The defendant may unrestrictedly use that name as descriptive of such pulleys of its manufacture. The distinction between such use of those words and the assumption of the complainants' trade name is of easy comprehension, and was well understood by the incorporators composing the defendant company, whose original purpose it was to carry on their operations under the firm-name of "Farrar, Christian & Co."

In *Holmes, Booth & Hayden v. Holmes, Booth & Atwood Manuf'g Co.*, *supra*, the defendants were enjoined from using in their corporate title the names of "Holmes" and "Booth," although stockholders of the company. In *Lee v. Haley*, *supra*, the plaintiff, who had carried on business for some years at No. 22 Pall Mall, under the style of "The Guinea Coal Company," had an injunction to restrain the defendant from carrying on a rival business in Pall Mall under the name "The Pall Mall Guinea Coal Company," notwithstanding it was shown that other dealers in coal calling themselves Guinea coal companies, some with prefixes and others without, were carrying on business at various places elsewhere, but in such situations that they were not likely to be mistaken for the plaintiffs. In *Brooklyn White Lead Co. v. Masaury*, 25 Barb., 416, the defendant, a white-lead manufacturer in Brooklyn, was restrained from the use of the word "Company" or "Co.," although, confessedly, he had the right to describe his white lead as Brooklyn white lead.

It is true, in each of these cases there were circumstances suggestive of fraud, or from which at least might be legitimately inferred an intention on the part of the respective defendants to

benefit themselves at the expense of the other party. But in this regard how is it with the defendant here? How comes it that the title "Farrar, Christian & Co." is discarded and the trade name of the complainants substituted? Why the close imitation by the defendant of the complainants' labels and circulars? The defendant company, indeed, in its answer, stoutly denies any fraudulent purpose or intention to injure the complainants. But the company must be judged by its acts rather than by its words. It requires a great stretch of charity to acquit the defendant of actual wrongful purpose. But, whatever the secret intent, the stubborn fact remains that the conduct of the defendant does tend to induce the public belief that its establishment is a branch of the complainants or connected therewith, and it must be taken to intend the natural consequences of its acts.

The defendant justifies under the contract of sale between Willard and Christian. But Willard did not thereby profess to pass to Christian the right to use the name "Taper-sleeve Pulley Works;" nor was it in his power to do so. What Christian did acquire, and the defendant may freely exercise, is the right to make and sell the taper-sleeve pulley, and to so designate the article, just as the Brooklyn manufacturer had the conceded right to call his product Brooklyn white lead.

It is, however, urged that it is impossible that the works at Dubuque, Iowa, should be confounded with the works at Erie, Pennsylvania, and highly improbable that any one should be misled, as the words, "of Dubuque, Iowa," are plainly added to the defendant's name on its goods, and also appear in all its advertisements, circulars, etc. But the business of the complainants and defendant, respectively, is not local; their trade is co-extensive with the whole country, and even passes beyond. The complainants' most fruitful field of operations lies nearer to Dubuque than to Erie, and into that field the defendant may enter to sell under the reservation in the contract between Willard and Gray. There is credible evidence that no little confusion has actually arisen, and I think such is the unavoidable result of the double use of the same trade name in this business.

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2. In my judgment, the complainant's right to equitable protection is as clear, and the necessity for the exercise of the restraining power of the Court is as urgent, as in any case to which my attention has been called in which the like relief was granted.

But the jurisdiction of the Court is disputed, the defendant being a foreign corporation, and a motion has been made to set aside the service of the subpoena and dismiss the bill. The return of the marshal shows a service, on its face entirely regular, upon the president of the corporation, Edwin Bindley; and as a corporation is liable to be sued in a State other than that of its creation and citizenship, if "found" therein, the only question to be settled here is whether the defendant was amenable to the process of the State Courts for the cause of action complained of and the service authorized by the State law. *Ex parte Schollenberger*, 96 U. S., 369; *Merchants' Manuf'g Co. v. Grand Trunk Ry. Co.*, 13 Fed. Rep., 358. In Pennsylvania, by the Act of March 21, 1849, in the commencement of any suit or action against a foreign corporation, process may be served upon any of its officers, agents, or engineers. *Pur. Dig.*, 287; *Lehigh Co. v. Boom Co.*, 6 Weekly Notes Cas., 222; *Coxe v. Camden & A. R. Co.*, 11 Weekly Notes Cas., 386. And suits may be instituted against a foreign corporation by service of process conformably to the Act of 1849, notwithstanding it has failed to establish a place of business in the State, and appoint an agent upon whom service may be made agreeably to the State Constitution and Act of April 22, 1874. *Hagerman v. Empire State Co.*, 97 Pa. St., 534.

The president of the defendant company was not in this State casually when served by the marshal. He is a citizen of Pennsylvania, and a permanent resident in the western district. The bill charges that he transacts "the business of president of said corporation at Pittsburg, Pennsylvania;" and although this is traversed, there is at least slight evidence tending to sustain the averment. However, it is shown that the defendant has procured labels and circulars, in infringement of the complainants' rights, to be printed within the western district of Pennsylvania, and has caused such circulars to be distributed therein. This, in connec-

tion with the president's residence therein, it seems to me, is "doing business" sufficiently to make it amenable to the Courts here. But, after all, the foundation of this suit is a continuing tort, wide-spread in its nature and results; the company's tortious acts being in part actually committed within this State and district.

3. Now, for a tort committed by a foreign corporation within this State, I have no manner of doubt the corporation may be sued here, if found within the the State in the person of an officer or agent upon whom process may be served. The defendant's motion must be denied.

A preliminary injunction will be allowed. Let counsel prepare and submit the form of decree.

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SUPREME COURT, STATE OF CALIFORNIA.
IN EQUITY.

J. F. G. EGGERS

vs.

P. H. HINK.

DECIDED 30 MAY, 1883.

REPORTED 63 CAL., 445.

“Philadelphia Beer Barrels” Case.

TRADE-MARK—BUSINESS SIGNS.

The object of a trade-mark is to indicate by its own meaning, or by association, the origin or ownership of the article to which it is applied. A sign placed over a man's place of business with a row of beer barrels painted on it, and the letters “P. B.” stamped on the head of the barrels, and the words “Depot of the Celebrated” placed above, and the words “Philadelphia Beer,” placed below the barrels, would relate only to the description of the beverage dealt in by him, and cannot be protected as a trade-mark.

.APPEAL from the judgment of the Superior Court of the City of San Francisco.

The facts are sufficiently stated in the opinion of the Court.

John H. Dickinson, for appellant,

Cited, *Shaffer v. Korbell*, 9 *Pac. C. L. J.*, 96; 8 *Derringer v. Plate*, 29 *Cal.*, 298; *Lawrence Manufacturing Co. v. Lowell Hosiery Mills*, 10 *The Reporter*, 809; *Fetridge v. Merchant, Cox's Am. Trade-Mark Cases*, 194; *Burke v. Cassin*, 45 *Cal.*, 469; *Falkinburg v. Lucy*, 35 *Cal.*, 35; *sec.* 3199, *Pol. Code*; *Hier v. Abrahams*, 82 *N. Y.*, 519; *Coddington's Digest of Trade-Marks*, *secs.* 985, 261, 1018.

William Leviston and T. D. Riordan, for respondent,

Cited, *sec.* 991 of the *Civil Code*; *sec.* 3196 *Pol. Code*; *Browne on Trade-Marks*, *sec.* 133; *Amoskeag Co. v. Spear*, 2 *Sandf.*, 605; *Amoskeag Co. v. Trainer*, *The Reporter*, *Sept.* 22, 1880; *Moorman v. Hoge*, 2 *Sawy.*, 78; *Falkinburg v. Lucy*, 35 *Cal.*, 501; *Choyinski v. Cohn*, 39 *Cal.*, 501; *Burke v. Cassin*, 45 *Cal.*, 467; *Wotherspoon v. Gray*, 36 *Scot. Jur.*, 24; *Perry v. Truefitt*, 6 *Beav.*, 72; *Kinney v. Birch*, *Codd's Digs. Tr.-M.*, 1037; *Raggett v. Findlater*, *Law R.*, 17 *Eq.*, 29; *Stokes v. Landgraff*, 17 *Barb.*, 608; *Corwin v. Daley*, 7 *Bosw.*, 222.

PER CURIAM:—The action is to recover damages for a violation of the plaintiff's alleged trade-mark, and to restrain the use of it by the defendant in the future. The deficiency of the complaint is the question for consideration.

1. According to its averments the plaintiff is engaged in conducting a saloon business in the City and County of San Francisco, particularly for the sale of a certain kind of beer known as Philadelphia Beer; and what he seeks to protect as a trade-mark, and which is used by him as a sign over the doors of his place of business, and as a label for the beer bottled by him, consists of a row of beer barrels so painted upon the sign and printed upon the labels as to show the top, head and outline of each barrel, with the letters "P. B." indicating and standing for Philadelphia Beer, stamped or printed upon the head of each barrel, together with

the words "Depot of the Celebrated" over, and the words "Philadelphia Lager Beer" below the row of barrels. The act of the defendant complained of is the erection by him over his place of business of a sign similar to that of the plaintiff, the chief difference being the insertion of the letters "F. B," indicating and standing for "Fredericksburger Beer," in lieu of the letters "P. B," and the insertion of the word "Fredericksburger" where the word "Philadelphia" appears on the sign and label of the plaintiff. The object of a trade-mark is to indicate by its own meaning, or by association, the origin or ownership of the article to which it is applied. Section 99 of our *Civil Code* provides: "One who produces or deals in a particular thing, or conducts a particular business, may appropriate to his exclusive use, as a trade-mark, any form, symbol, or name which has not been so appropriated by another, to designate the origin or ownership thereof, but he cannot exclusively appropriate any designation or part of a designation, which relates only to the quality, or the description of the thing or business, or the place where the thing is produced, or the business is carried on" and by section 3196 of the *Political Code* it is declared:—

"The phrase 'trade-mark' as used in this chapter includes every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label or wrapper, usually affixed by any mechanic, manufacturer, druggist, merchant or tradesman, to denote any goods to be imported, manufactured, produced, compounded, or sold by him, other than any name, word, or expression generally denoting any goods to be of some particular class or description."

We do not perceive that either the letters or words upon the plaintiff's sign or label, nor the device as a whole, in any manner indicated origin or ownership. A sign placed over a man's place of business with a row of beer barrels painted on it, would indicate that he sold beer; the letters "P. B." stamped on the heads of the barrels, and the words "Depot of the Celebrated" placed above, and the words "Philadelphia Beer" placed below the row of barrels, would indicate that he sold Philadelphia Beer. It

does not appear that the plaintiff is the manufacturer of the Philadelphia Beer, nor the sole agent for its sale. For aught that appears any one else has as much right to sell Philadelphia Beer as the plaintiff. In our opinion the sign and label of the plaintiff relates only to the description of the beverage dealt in by him, and therefore cannot be protected as a trade-mark.

Judgment affirmed.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

HOSTETTER, AND OTHERS,

vs.

FRIES, AND OTHERS.

DECIDED 31 MAY, 1883.

REPORTED 17 FEDERAL REP., 620.

“Hostetter Bitters Extract” Case.

1. NAME OF NEW ARTICLE—RIGHT TO USE OF.—When a new article is made a name must be given to it, and this name becomes, by common acceptance, the appropriate descriptive term by which it is known and therefore becomes public property, so that all who have the right to manufacture and sell the preparation have the right to designate and sell it by the name by which alone it is known, provided care is observed to sell the preparation as the manufacture of the seller, and not the preparation made by another.
2. TRADE-MARK—DEFINITION.—A trade-mark consists of a word, mark or device adopted by a manufacturer or vendor to distinguish his production from other productions of the same article.
3. SAME—NAME INDICATING KIND OR DESCRIPTION OF THING.—A name alone is not a trade-mark when it is understood to signify not the par-

ticular manufacture of a certain proprietor, but the kind or description of thing which is manufactured.

4. SAME—INJUNCTION REFUSED.—Complainants claimed the right to use the name "Dr. J. Hostetter's Stomach Bitters," in connection with certain labels, bottles and other devices which designated the preparation as of their own manufacture and indicated its origin, and in their bill they averred that defendants' were selling to the trade an extract out of which it was claimed Hostetter's Bitters could be made, with directions how to make such bitters, and that the retail dealers were making these bitters and refilling complainants' bottles, with their labels and devices thereon, and thus selling them. HELD:

That defendants had the right to sell their extract as charged as no purchaser could suppose that he was purchasing the preparation made by complainants; that they could not be held responsible for the acts of third parties, and that an injunction would not be granted.

A. H. Clark and James Watson, for complainants.

I. A. Englehart and A. J. Dittenhoefer, for defendant.

WALLACE, J.:

The motion for preliminary injunction must be denied, because it does not appear from the bill and affidavits that defendants are infringing the complainant's trade-mark. Complainants' property consists in the right to use the name "Dr. J. Hostetter's Stomach Bitters" in connection with certain labels, bottles, and other devices, which designate the preparation as of their own manufacture, and indicate its origin. The bill alleges that the defendants are engaged in manufacturing and selling certain essences, oils, and extracts which they represent can be so manipulated and used as to produce a good imitation of various well known brands of bitters, among them an imitation of Hostetter's Bitters; that they sell the same to compounders and jobbers, with instructions to the purchaser as to the mode of compounding the bitters and selling them as the genuine article; and that such purchasers compound the essence and sell the bitters made thereby to retail dealers, and the latter procure the second-hand empty bottles that have been sold by the complainants, having the labels thereon, and refill them with the bitters compounded from the

defendants' essences and palm them off upon the public as the genuine bitters of the complainants' manufacture.

The complainants have neither the exclusive right to make bitters compounded after the formula of Dr. Hostetter, nor the exclusive right to sell bitters by the name of Hostetter's Bitters. The preparation never had any name until it was offered to the public and christened. When a new article is made a name must be given to it, and this name becomes by common acceptance the appropriate descriptive term by which it is known, and therefore becomes public property. If this were not so, any person could acquire the exclusive right to a formula by giving a name to the compound produced, not only when the compound has not been patented, but when it might not be the subject of a patent. All who have the right to manufacture and sell the preparation, have the right to designate and sell it by the name by which alone it is known. provided care is observed to sell the preparation as the manufacture of the seller and not the preparation made by another. A trade-mark consists of a word, mark, or device adopted by a manufacturer or vendor to distinguish his production from other productions of the same article. A name alone is not a trade-mark when it is understood to signify, not the particular manufacture of a certain proprietor, but the kind or description of thing which is manufactured. *Singer Manuf'g Co. v. Loog*, 15 *Reporter*, 538; *Wheeler & Wilson Manuf'g Co. v. Shakespear*, 39 *Law J. Ch.*, 36; *Young v. Macrae*, 9 *Jur.*, (N. S.), 322.

Obviously, no one would be deceived into the supposition that the defendants were selling the complainants' production when they only profess to sell an extract from which Hostetter's Bitters can be made. Defendants not only have the right to make and sell the extract, but they have the legal right to make and sell a preparation which they call Hostetter's Bitters, provided they do not employ the bottles, labels, symbols, or devices which have been used by the complainant to distinguish their own production of that preparation, or such equivalents as may deceive the public in that regard. If the bill had distinctly alleged that the defendants were engaged in a scheme to put upon the market and

palm off upon the public a preparation of their own as the complainants' preparation, and these allegations were shown to be true, the defendants could not escape an injunction merely upon the ground that they had not sold the preparation themselves. But all the general allegations of fraud and conspiracy in the bill are resolved into the specific acts of wrong-doing particularly stated; that is, selling the extract and informing their customers how it may be made into Hostetter's Bitters. The actionable transgression of the complainants' rights, is that committed by the retail purchasers who buy from the defendants' customers—those who use the bottles, labels, and symbols which constitute the complainants' trade-mark. The defendants may be instrumental in effecting the wrong by providing some of the means employed, but they only do what the law permits them to do. And even if it could be assumed that they contemplated the further wrong-doing of the retailers, the law does not visit motives or intent unaccompanied by a wrongful overt act. The bill, however, does not allege that they are participants in the violation of the complainants' rights further than by selling the extract, and giving instructions how it can be made into Hostetter's Bitters.

The motion is denied.

“See *Wilcox & Gibbs Sewing Machine Co. v. The Gibbens Frame*, *infra*; *Burton v. Stratton*, 12 *Fed. Rep.*, 696, and note, 704; *Shaw Stocking Co. v. Mack*, *Id.*, 707, and note, 717.”—(ED.)

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF ALABAMA. IN EQUITY.

PETER OAKES

vs.

HENRY TONSMIERRE AND JOHN CRAFT.

DECIDED JUNE, 1883.

REPORTED 4 WOODS, 547.

“Peter Oakes Candy” Case.

The sale by a person engaged in manufacturing certain goods, of the right to use his name as a trade-mark, will be valid provided the trade-mark is not used to deceive the public, and a sale of the right to use such trade-mark by the vendee to another person, will not be affected by any contract between the original parties of which the second vendee had no notice.

FINAL hearing on the pleadings and evidence.

Messrs. Harry Pillans and E. S. Russell, for complainant.
Messrs. W. S. Lewis and Stephens Croom, for defendants.

BRUCE, DIST. J.:

The evidence shows that Peter Oakes, complainant, and one Hiram S. Probasco, in December of the year 1865, in St. Louis, Missouri, entered into a copartnership for the manufacture and sale of candies, under the firm-name of Probasco & Oakes. This firm first called their candies Excelsior candies, but as Probasco testifies, they found this name too long, hard to be remembered, and not easily spoken by children, and they changed the name to Oakes' candies, Oakes' home-made candies and Oakes' pure home-made candies.

This firm of Probasco & Oakes carried on the business of making and selling candies up to May 17, 1869, when Peter Oakes, for a valuable consideration, sold out to his partner, Probasco. The bill of sale is in evidence, and to quote the language, the transfer is of "all my right, interest and estate, it being one-half, in and to the stock of candies, materials, goods, wares and merchandise, fixtures, furniture, tools and equipments of the firm of Probasco & Oakes, also the good-will of the business and name of the firm of Probasco & Oakes, and the exclusive right to make and sell Oakes' candy, and to use the name thereof."

On the same date another memorandum of agreement was made, which is also in evidence, by which Oakes agreed to work for Probasco, and Probasco agreed to employ him for two years at wages therein specified at manufacturing home-made candies, or at any other work necessary to be done, or properly appertaining to the business of candy-making and in this memorandum it is provided that "should he, Probasco, sell out his said business of candy-making, and selling within said two years, or at any other times, then said Oakes shall be relieved from all obligation, under this agreement, and the right and privilege of making and selling Oakes' candies, and of using said name, shall revert to said Oakes."

Probasco continued the business after the dissolution of the firm, and in addition to the word Oakes, or the words Oakes' candies, in 1870 he devised a trade-mark of two oak trees with the word Oakes across the branches and the word candies on a plank across the trunk of the trees, and used this trade-mark or symbol in his store and upon labels placed upon packages and boxes of candies offered and sold in the market.

He continued this business and use of the trade-mark after Oakes sold out to him and after Oakes had quit his employment, which continued after the sale for eighteen months, when Oakes left Probasco's employment, by mutual consent, as he states.

In January, 1877, over seven years after the sale from Oakes to Probasco, Probasco sold out to one W. J. Hammon, for a valuable consideration, and in May afterwards, transferred in writing, which is in evidence, "the trade-mark, name, good-will and reputation connected with the manufacture, production and sale of certain candies * * * * commonly known as Oakes' candies."

W. J. Hammon carried on the business until the 25th of March, 1878, when he sold out to H. Skinner and N. C. Skinner, who carried on business as Skinner & Co., and who constituted Tonsmierre & Craft, the defendants herein, their agents in Mobile, Alabama, for the sale of Oakes' candies made by Skinner & Co., of St. Louis, Missouri.

Tonsmierre & Craft received candies from Skinner & Co., of St. Louis, advertised and sold them as the genuine Oakes candies, and their advertisements sometimes stated that the Oakes candies were made by Skinner & Co., of St. Louis, and sometimes only stated that Tonsmierre & Craft were the agents for the sale of the genuine Oakes candies.

Complainant prays for an injunction against the defendants to restrain them from selling or offering for sale * * * * any kind of candies or caramels as Oakes' candies, or to use in any way the name or trade-mark of Oakes, or simulate the same in connection with the manufacturing, selling or offering for sale * * * * any candies or caramels as Oakes' candies, except such as may be manufactured by and purchased from Peter Oakes, and that Tonsmierre & Craft be ordered and decreed to account to Peter Oakes for all profits which they have made * * * * and all the profits which Peter Oakes could or would have made on the sales of his genuine candies and caramels, and the prayer is for general relief.

The right of the defendants to use the trade-mark in question, which combines the word or name Oakes with the two oak trees, and their right to represent and advertise themselves as the agents

for the Oakes candies in the market here in Mobile, depends upon the right of Skinner & Co., of St. Louis to use this trade-mark and the name Oakes, and their right depends upon the right of W. J. Hammon, from whom they purchased it, and their right in turn depends upon the right of Hiram S. Probasco, from whom they purchased.

What right, then, had Probasco to use the trade-mark in question? either to use the word Oakes alone or in combination with any other mark or device in the sale of the candies made by him.

The general principle is that one man will not be permitted, by imitating the distinctive name or mark used by another person to designate articles of the latter's manufacture, to impose articles of his own manufacture on the public as the articles of the former. The cases so holding rest upon two considerations.

1st. That it would be a fraud on the rights of the former person thus to permit his trade-mark to be imitated.

2d. That it would be a fraud on the public. *Skinner & Co. v. Oakes, et al.*, 10 Mo. App., 45, and cases there cited. See also, *McLean v. Fleming*, 96 U. S., 245.

The Courts proceed upon the two-fold principle that the public have a right to know that goods which bear the signature or mark of a particular manufacturer or vendor are in fact the goods of such manufacturer or vendor, and that the manufacturer or vendor of such goods had a right to any advantage which might accrue to him from the public knowing that fact. Same authority and cases cited.

The evidence shows that Peter Oakes was a practical candy-maker. That he superintended the making of the candies of his firm during its existence, and perhaps it is only fair to infer from the testimony that he continued to do so after he sold out to his partner, and during the eighteen months after the sale that he remained in his employ. It does not appear, however, that the candies made and sold by Probasco & Oakes at their place of business in St. Louis, Mo., were called Oakes candies because the man Peter Oakes made or superintended the making of them, but it is shown by the evidence that the reason why these candies were called Oakes candies was because the name was deemed by the firm a proper one to designate their candies.

They were first called Excelsior candies, but this was a difficult name for children to speak, and Oakes was deemed the better name.

Probasco was not a practical candy-maker, yet he was the business man of the concern, and most probably had as much or more to do with building up the reputation of the candies manufactured by his firm as had his partner Peter Oakes.

The evidence on this subject I think repels the idea that the candies of this firm were called Oakes candies because Peter Oakes manufactured them, or that the use of the name was intended to be any guaranty to the public that Peter Oakes actually manufactured or superintended the manufacture of them.

This case then, does not fall within the rule that one man is not permitted to use the trade-mark of another; for the use of the word Oakes was as much the device of Probasco as it was of Peter Oakes, and the more elaborate mark of the two oak trees, with the words Oakes candies, was the device of Probasco alone.

In the case of *Skinner & Co. v. Oakes, et al., supra*, it is said to be settled law, that the right to use a trade-mark is not a mere personal privilege, but within certain limits it is capable of being bought and sold as other property. "A trade-mark," says Justice Strong, "like the good-will of a store or manufacturing establishment, is a subject of commerce, and it has been many times held to be entitled to protection at the suit of vendors." *Fulton v. Sellers*, 4 *Brewst.*, 42, and other authorities. See also, *Kid v. Johnson*, 100 *U. S.*, 617.

In the same case, however, (*Skinner v. Oakes*), the Court proceeds: "But when the trade-mark consists of a name, how far is it capable of assignment? is a more difficult question."

It is a name that we are dealing with here, and I cannot do better than to give the answer which the Court gave in that case to the query which is propounded. The Court said: "We think the answer to this question depends upon the effect which the use of the name, in each particular instance, is shown to have upon the minds of the public. If it leads the public to believe the particular goods are in fact made by the person whose name is thus stamped upon them, or in whose name they are advertised,

whereas they are in fact made by another person, then such a use of the name will not be protected by the Courts, for to do so would be to protect the perpetration of a fraud upon the people."

Tested by this rule, what is there to show that the use of the name or word Oakes by Probasco in the sale of his candies implied, or was calculated to imply, any guaranty to the public that the candies were made by Peter Oakes?

While Peter Oakes was a member of the firm, it might be a reasonable inference on the part of the public that he made the candies; but after he sold out to Probasco, and after Probasco had devised and used in his business the more elaborate trade-mark of the two oak trees with the words "Oakes Candies" upon them, and this had been continued for years after Peter Oakes had ceased all connection with the business carried on by Hiram S. Probasco, how could such use of the name Oakes lead the public to believe that the goods were made by the man Peter Oakes?

On the contrary, it is but common experience that articles bearing a particular name are not regarded by the public as being the actual manufacture of the person whose name they bear. It may have been so originally, for it is only natural that the article should be associated with and called by the name of its first maker or vendor; but generally speaking, unless in cases of inventions or articles produced by special skill, which are usually protected by letters patent, the public do not in fact believe and are not justified in the conclusion that, because articles bear a particular name, the person of that name is in fact the manufacturer or vendor of the article. The principle contended for here by the complainant goes to the extent that Probasco, after the sale by Oakes to him, had no right to use the name of Oakes as a trade-mark, because by doing so he was perpetrating a fraud upon the public, holding out the idea that Oakes actually manufactured the candies which he, Probasco, made and sold, when such was not the fact.

But this view of the subject cannot be maintained, and was not maintained in the case of *Probasco v. Bouyon, et al.*, 1 Mo. App., 241, in which case the Court say: "By the dissolution of the firm, and Oakes' sale to Probasco, the latter acquired the rights of his

firm to the name. Oakes could so sell his name as to deprive himself of the right to use it for his own manufacture, and give that right to another."

The Court in this case holds that a trade name may be the subject of a sale—that the name of Oakes was the subject of a sale by Peter Oakes to Probasco; but the Court could not so have held if the use of the name Oakes carried with it an assurance to the public that the man Oakes manufactured the candies, for that would have been to protect Probasco in perpetrating a fraud upon the public.

So that it is clear that Probasco's right to make and sell Oakes candies did not at all depend upon the fact that Oakes made the candies. The case falls within another principle, which is, that a name may be used as a mere adjective of description or quality, which the public do not understand as any warranty that the person whose name is used is the maker of the article; and in these cases the right to use the name may be sold with the right to manufacture and vend the goods, without reference to the question as to what person or persons actually manufacture them. But it is claimed that though Probasco had the right to carry on the business and use the trade name in question, yet he had no right to sell it, because he had agreed with Oakes in 1869, that should he, Probasco, "sell out his business within two years, or at any other time, . . . then the right and privilege of making and selling Oakes candies, and of using said name, shall revert to said Oakes."

It may well be questioned if this agreement meant anything more than that, upon a sale by Probasco of his business, that Oakes was then to have an equal right with Probasco's vendee to the use of the name Oakes in the manufacture and sale of candies; but if that admits of doubt, still, can it be doubted that a subsequent purchaser for value without notice of this private agreement between the parties would acquire the right to use the trade-mark or name here in question?

Probasco was carrying on the business of manufacturing and selling candies, and advertising and designating them by a trade-

mark, consisting in part of the name Oakes, and he was in the open possession and enjoyment of this trade-mark.

The great mark of ownership of personal property is possession, and contracts that the title to personal property shall be in one party, and the possession in another cannot be set up to the prejudice of a *bona fide* purchaser without notice.

In 1877 Probasco sold out to W. J. Hammon for \$4,000, and on May 17th executed in writing a transfer of the trade-mark, name, good-will and reputation connected with the manufacture, production and sale of certain candies commonly known as Oakes candies.

Here, then, was a sale of the business and trade-mark for value to one Hammon, who had the right to purchase, and who is not shown to have had any notice of the agreement between Oakes and Probasco, which was a private one, never placed upon record, and which, therefore, could not affect the rights of Hammon.

It is claimed that in August, after the sale to Hammon, notice was served upon both Skinner and Hammon of this agreement of Oakes and Probasco; but even if Skinner & Co. had notice, they would be entitled to defend themselves behind Hammon's want of notice. *Sugden on Vendors*, 531; *Boone v. Chiles*, 10 *Peters*, 177. Again, it is claimed that the case of *Skinner v. Oakes*, *supra*, shows that the complainant is entitled to recover in this suit.

True, in that case the complainants failed to maintain their bill in the Court of Appeals of Missouri, but an examination of the opinion shows the reason for such failure. The Court says: "If we could gather from the record that the plaintiffs are the successors in business of Probasco & Oakes, that they had become the assignees, not merely of the trade-marks and tokens, but also of the establishment and the business, so that they are really carrying on the same business, and manufacturing and selling the same goods as Probasco & Oakes, we would have no difficulty in holding that they are entitled to the relief which the Court below awarded them."

In the case at bar the evidence shows that Skinner & Co. were the successors in business of Hiram S. Probasco, who succeeded the firm of Probasco & Oakes.

Hammon testifies that he succeeded to the business, making no changes in the methods of manufacturing and selling the candies, and did it for a considerable time at the same shop and number in St. Louis, at which Probasco had carried on the business. I see nothing unreasonable or impossible in this. If there was anything in the nature of the business of candy making, any art or incommunicable secret known only to the man Oakes, it might be said that Skinner & Co. and Hammon, and even Hiram S. Probasco, did not carry on the same business and manufacture the same goods as did the firm of Probasco & Oakes.

But the proof shows that the quality of the candies of Probasco & Oakes consisted not only in the skill of Oakes as a candy-maker, but in the use of fine sugars, nuts and flavors; and the weight of the testimony is that the Oakes candies manufactured and sold by Skinner & Co. were quite equal, if not superior, in quality to those manufactured by Peter Oakes.

The result of these views is that Skinner & Co. had a right, derived as shown in the evidence, to the use of the trade-mark in question, and that the respondents, Tonsmierre & Craft, as their agents in Mobile, had such right, and the relief prayed against them by the complainant on account of their use of the word or name Oakes is denied.

The use, however, of the name *Peter Oakes* stands upon different principles, and it is not claimed by counsel that they had any right to use this name, but that it was used by reason of an inadvertence or mistake, was not intentional, and, in point of fact, it was used to a very limited extent.

The rule, however, is that trade-marks are protected not exclusively on the ground of fraud, but also on the ground of property. The testimony shows that Peter Oakes is making and selling candies in his own name, and designating them in the market by the name of Peter Oakes. So that if insisted upon, the case may go to a Master for an account of gains and profits, on account of the unauthorized though not intentional and fraudulent use by respondents of the name of Peter Oakes.

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COURT OF APPEALS, STATE OF NEW YORK.
IN EQUITY.

ELISHA G. SELCHOW, ET AL., RESPONDENTS,

vs.

JAMES S. BAKER, ET AL., APPELLANTS.

DECIDED 19 JUNE, 1883.

REPORTED 93 N. Y., 53.

“Sliced Animals” Case.

1. While, where a complaint shows no cause of action, the granting of a preliminary injunction is an error in law, which may be reviewed in this Court on appeal, the case must be very clear to justify the Court in deciding the merits of the controversy on a mere motion; and where a doubtful question of law arises on the complaint, the decision thereof should be deferred until a hearing of the case upon its merits.
2. Where a manufacturer has invented a new name, consisting either of a new word or a word or words in common use, which he has applied for the first time to his own manufacture, or to an article manufactured for him, to distinguish it from those manufactured and sold by others, and the name so adopted is not generic or descriptive of the article, and is not used merely to denote grade or quality, but is arbitrary or fanciful, he is entitled to be protected in the use of that name as a trade-mark,

and this, although it has become so generally known that it has been adopted by the public as the ordinary appellation of the article.

3. Plaintiffs were manufacturers of certain games or puzzles for children, which consisted of pictures of animals, birds or objects on paste-board, cut into strips or pieces, and the puzzle consisted of putting the pieces together so as to form the original picture. To distinguish these manufactures plaintiffs had given to them the names "Sliced Animals," "Sliced Birds," or "Sliced Objects," according to the character of the picture, which names were placed upon the boxes containing the puzzles and upon the outside of the packages in which they were put up for sale, and the said articles had become well known by the names thus given them. In an action to restrain defendants from using said names in connection with similar articles manufactured for and sold by them, HELD:

That the names so given were capable of being appropriated as trade-marks, and plaintiffs, having so appropriated them, were entitled to be protected in their use as such.

Barnett v. Kubler, (*Browne on Trade-Marks*, 113, sec. 166); *W. & W. M. Co. v. Shakespear*, (39 *L. J.*, *N. S. Chan.*, 36); *S. M. Co. v. Loog*, (27 *Alb L. J.*, 270), distinguished.

Fetridge v. Wells, (4 *Abb. Pr.*, 144), limited.

APPEAL from the order of the General Term of the Court of Common Pleas in and for the City and County of New York, made November 9, 1832, which affirmed an order of Special Term, granting a preliminary injunction restraining defendants from using the names "Sliced Animals," "Sliced Birds," "Sliced Objects," in connection with certain games or puzzles.

Plaintiffs' complaint alleged in substance, among other things, that they were, and had been for many years, manufacturers and wholesale dealers in certain games and puzzles, to which they had given the names above stated, invented by them as trade-marks, to distinguish them from the manufactures of others, and which names were placed upon the boxes containing the puzzles and on the packages in which they were put up for sale; under which names they had become widely known to the public. These puzzles consisted of pictures of animals, birds and different objects upon card-board, cut into strips or pieces, and the puzzle consisted in putting them together so as to form the complete picture.

In July, 1882, defendants began to sell similar articles, using the same names in connection therewith. Plaintiffs asked to restrain such use.

Charles M. DeCosta and *William D. Guthrie*, for appellants.

The granting of the temporary injunction order was without authority of law, and therefore such order is reviewable on appeal to this Court. (*Campbell v. Seaman*, 63 *N. Y.*, 569; *McHenry v. Jewett*, 90 *Id.*, 58; *Allen v. Meyer*, 73 *Id.*, 1, 3; *Collins v. Collins*, 71 *Id.*, 269, 271; *People v. Common Council*, 79 *Id.*, 56, 61; *Paul v. Munger*, 47 *Id.*, 469, 473). Unless protected by the operation of a statute, such as the Patent Act, no one can have any exclusive property or right to manufacture and sell any article to the exclusion of others, although he may be the inventor thereof, and the first person to make and sell the same. (*Caswell v. Davis*, 58 *N. Y.*, 223; *Thomas v. Winchester*, 19 *Pick.*, 214, 215). As Mr. Thompson had a right to manufacture and defendants to sell games like those invented and manufactured by plaintiffs, they had a right to use the names by which the games are exclusively known to the public. (*Fetridge v. Wells*, 4 *Abb. Pr.*, 144; *Taylor v. Gillies*, 59 *N. Y.*, 331, 334; *Caswell v. Davis*, 58 *Id.*, 223, 234, 235; *Hegeman v. Hegeman*, 8 *Daly*, 1, 9, 10; *Thomson v. Winchester*, 19 *Pick.*, 214, 216; *Canal Co. v. Clark*, 13 *Wall.*, 323, 327; *Corwin v. Daly*, 7 *Bosw.*, 222, 226; *Sherwood v. Andrews*, 5 *Am. Law Reg.*, 588, 591; *Burton v. Stratton*, 12 *Fed. Rep.*, 696, 700; *Marshall v. Pinkham*, 52 *Wis.*, 572; *Wheeler & Wilson Manuf. Co. v. Shakespeare*, 39 *L. J.*, [*N. S.*], *Ch.*, 36; *L. M. Co. v. Nairn*, *L. R.*, 7 *Ch. Div.*, 834, 837; *Singer Manuf. Co. v. Long*, *Alb. L. J.*, *Apr.* 7, 1833, *pp.* 272, 274; *Van Beil v. Prescott*, 82 *N. Y.*, 630; *Browne on Trade-Marks*, 151, *sec.* 219.

The terms "Sliced Animals," "Sliced Birds," and "Sliced Objects," which the plaintiffs claim to appropriate as the trade-marks of the games in question, cannot legally be appropriated as such. (*Canal Co. v. Clark*, 13 *Wall.*, 311, 322; *Manuf. Co. v. Trainer*, 11 *Otto*, 51; *A. Manuf. Co. v. Spear*, 2 *Sandf.*, 597; *Congress Spring Co. v. High Rock Spring Co.*, 45 *N. Y.*, 291, 295; *Newman v. Alvord*, 51 *Id.*, 189, 193; *Topham v. Cole*, 66 *Id.*,

69, 75; *Caswell v. Davis*, 58 *Id.*, 223, 233; *Van Beil v. Prescott*, 82 *Id.*, 630; *Zinter v. Kinney Tobacco Co.*, 12 *Fed. Rep.*, 782; *Ayer v. Rushton*, 7 *Daly*, 9; *Browne on Trade-Marks*, secs. 134-136, 164, p. 43; sec. 66, p. 113; sec. 166, p. 141, *Upton on Trade-Marks*, 22, 25, 26; *Larabee v. Lewis*, 13 *Ga.*, 270; 25 *Alb. L. J.*, 203; *Raggett v. Findlater, Eng. L. R.*, 17 *Eq.*, 29; *Town v. Stetson*, 3 *Daly*, 53; *Annales de la Prop.* tome x, p. 320).

Frank R. Lawrence and *Malcolm R. Lawrence*, for respondents.

The words applied by plaintiffs to their articles being arbitrary or fancy names, they have acquired the exclusive right to use them for that purpose. (*Canal Co. v. Clark*, 13 *Wall.*, 311; *Manuf. Co. v. Trainer*, 101 *U. S.*, 51; *Hier v. Abrahams*, 82 *N. Y.*, 519; *Gillett v. Esterbrook*, 48 *Id.*, 374; *Town v. Stetson*, 3 *Daly*, 53; *Smith v. Sexbury*, 25 *Hun*, 232; *Burnett v. Phalon*, 42 *N. Y.*, 594; 3 *Keyes*, 594; *Davis v. Kendal*, 2 *R. I.*, 566).

RAPALLO, J.:

As a general rule this Court will not review an order granting or refusing a temporary order of injunction which the Court below had jurisdiction to grant.

1. In the case of *McHenry v. Jewett*, (90 *N. Y.*, 58), this general rule was qualified to the extent of holding that where it clearly appears that the complaint shows no cause of action, a preliminary injunction is unauthorized, and the granting of it is an error of law which may be reviewed in this Court on appeal.

The principles established in the case above cited does not apply where a doubtful question of law arises upon the complaint. The decision of such a question would be deferred until the hearing of the case upon its merits, and would not be summarily disposed of on a motion to dissolve the injunction. The case must be very clear to justify this Court in deciding the merits of the controversy on a mere motion, and it would ordinarily decline, in a case presenting any serious question, to deprive either party of the privilege of having the merits of his case deliberately heard and passed upon on appeal from the final judgment.

In the present case no question of fact arises upon the motion, and the only question presented is whether the words "sliced animals," "sliced birds," and "sliced objects," which the plaintiffs claim to have appropriated as a trade-mark, are capable of being so appropriated. This is a question of law, and although it is not so simple a question, and its solution is not so clear that we should, against the objection of either party, decide it on this appeal, yet, as both parties unite in requesting such a decision, in order to save the delay and expense of going through the forms of a trial and successive appeals from the judgment to the General Term, and to this Court, for the purpose of ultimately presenting the same question, we have concluded to determine it now, and thus dispose of the controversy.

2. The plaintiffs have no exclusive right to manufacture or vend the articles to which they have attached their names, but they have the right to attach to the articles which they may manufacture any distinctive name, and to appropriate it as a trade-mark, by which such articles may be distinguished from similar articles manufactured by other persons, provided the name so selected by them is original, and has never before been applied to such articles, and provided, also, that it is an arbitrary or fanciful name, not in itself descriptive of the article. The reason for not permitting names, descriptive of the article or its component parts, to be appropriated as trade-marks, is that inasmuch as all persons have an equal right to produce and vend similar articles, they also have the right to properly describe them, and to use any appropriate language or words for that purpose, and no person can appropriate to himself exclusively any word or expression, properly descriptive of the article, its qualities, ingredients or characteristics, the right to the use of such language being common to all. But a name which does not, in itself, indicate what the article is, or what are its qualities or component parts, but which is invented or adopted by a manufacturer solely for the purpose of distinguishing his products, and whose exclusive appropriation to that purpose in no way restricts others from properly describing similar articles produced by them, may be appropriated as a trade-mark and protected as such.

Whether a name claimed as a trade-mark is subject to the objection of being descriptive, or whether it is an arbitrary or fancy name, must depend upon the circumstances of each case as it arises. Several instances are cited upon the brief of counsel, of names which have been sustained as valid trade-marks, and others of names which have been rejected as descriptive. In *Burnett v. Phalon*, (3 *Keyes*, 594), the word "Cocoaine" as applied to a hair wash compounded from cocoanut oil and other ingredients, was upheld as a trade-mark. So with "Magnetic Balm," as applied to a medical preparation of which magnetism or electricity was not in fact one of the component parts, (*Smith v. Sexbury*, 25 *Hun*, 232), while on the other hand various names are cited from *Browne on Trade-Marks*, (134, 136 and 164), which have been rejected as descriptive. A cursory reading of these names conveys at once to the mind an idea of the article to which they refer. A case which is claimed by the learned counsel for the appellants to be very much in point, is cited from *Browne on Trade-Marks*, (p. 113, sec. 166), viz: *Barnett v. Kubler*, decided in the French Courts, and I agree that this case is a fair illustration of the principle under discussion. It related to the toy known as "The Serpent of Pharaoh," a chemical preparation, sold under the form of a little cone, which being set on fire develops into the form of a real serpent, with its length, movements and color. The infringement charged consisted of the application to a similar article manufactured by the defendant, of the name "Magic Serpent," and this use of the word "serpent" was complained of, and it was held that the plaintiff had no right to the exclusive appropriation of it. It is plain that the article was in fact the imitation of a serpent, or the production of an artificial serpent, and the defendant having the right to manufacture the article, it would have been a clear invasion of his rights to prohibit him from using a name so appropriate and necessary to its description. The words "Magic Serpent," or "Artificial Serpent," were as accurate a description of the toy as could well be devised. A comparison of this case with that of the "Pearls of Ether," as applied to ether pills, covered with a silvery coating which made them resemble pearls, exemplifies the distinction.

This was held by the French Courts to be a good trade-mark and not descriptive. The word "Pearls," as applied to pills, was an arbitrary and fancy name, whose exclusive appropriation abridged no one's right to the use of language in describing pills. If in the case of the "Serpent of Pharaoh," the infringement had consisted of the piracy of the word "Pharaoh," as applied to the toy, it could hardly have been said that the plaintiff was not entitled to protection, if the word had been adopted for the purpose of distinguishing the plaintiff's manufacture.

3. In the present case the infringement complained of consists in the unauthorized use of the words "Sliced Animals," etc., which had been appropriated by the plaintiffs as the name of the toy. This word was not, in our opinion, descriptive of the article. It would not convey to a person who had never seen the toy, and who did not know what it was, any idea of its character, nor would it be an appropriate term to be used by a person desiring to give a correct or any description of it. It does not even indicate that pictures of any kind are referred to, and none of the objects are in fact sliced. The name had been invented by the plaintiffs and had never before been applied to the toy, although toys of a similar character had been in use. The plaintiffs were the only persons using it, and it had become the distinguishing mark by which their manufactures had become known and were dealt in in the market. It is difficult to conceive what motive the defendants could have had in adopting it, other than to appropriate to themselves the benefit of the popularity which the plaintiffs had obtained for their products, by advertising and other means, and to divert their trade to themselves. We think the word adopted by the plaintiffs constitutes a valid trade-mark.

It cannot be true as a general proposition, as contended on the part of the defendants, that when a manufacturer has given to his products a new name invented by himself for the purpose of distinguishing them as his, and the article becomes generally known to the trade and to the public by that name; the name becomes public property and every one has a right to use it. That proposition can be sustained only in respect to names which are descrip-

tive of the article and incapable of being appropriated as trade-marks. The value of a trade-mark consists in its becoming known to the trade as the mark of the manufacturer who has invented or adopted it, and in being known to the public as the name of an article which has met with popular favor. It cannot be that the very circumstances which give it value operate at the same time to destroy it.

Several cases and *dicta* are cited by the learned counsel, upon which he predicates his proposition. These cases depend upon various considerations. Some of them refer to names which are descriptive of the article, and hold that where such a name is given to a new article it becomes its proper appellation, and all who have a right to manufacture and sell the article have the right to designate it by its appropriate name. Other decisions are applicable where an article has been patented and has become generally known by the name of the patent or of the patentees. The name by which it is thus known is not a trade-mark, indicating that the article is manufactured by any particular person. The article may be manufactured by any one who may, as assignee or licensee, be entitled to use the patent, and it indicates that the article is made under or on the system of such patent, and any person making the article according to such patent may designate it by its proper name. And when the patent expires, or in foreign countries where the patent has no force, there is no piracy in making or selling the article under the name by which it has become generally known. This name has become the proper description of the article, as indicating that it is made according to the patented invention, and is not the trade-mark of any particular manufacturer. The patentee relies for his prosecution upon his patent, and cannot, by calling the name of his patent a trade-mark, protect his monopoly after the patent has expired, or where it has no force. Such are the cases of *Wheeler & Wilson Manuf. Co. v. Shakespear*, (39 *L. J.*, [*N. S.*] *Chanc.*, 36); *Singer Manuf. Co. v. Loog*, (27 *Abb. Law Jour.*, 270).

In the case of the *Singer Manuf. Co.*, the grounds of the decision are very distinctly stated in the opinion of the Lord Chancellor. Referring to the plaintiff's allegations (which were, that

the defendant, by representing sewing machines sold by him as "Singer" machines, had endeavored to obtain, and succeeded in obtaining for the machines so sold by him, some of the reputation attaching to the plaintiff's manufactures, and had induced or, unless restrained, would induce purchasers of his machines to believe that they were in fact machines of plaintiff's manufacture), the Lord Chancellor observes that if the case so stated were established, there could be no doubt of the plaintiff's right to relief upon the ordinary principles applicable to trade-marks, but that the case was not of that description, but analogous to that of *Wheeler & Wilson Manuf. Co. v. Shakespear*, (39 L. J., [N. S.] Ch., 36), in which it was held that the name Wheeler & Wilson had come to signify in the trade, not the particular manufacture of Messrs. Wheeler & Wilson, or of the Wheeler & Wilson Co., but the kind of machine which they made, the manufacture of which was *publici juries*.

Judge Duer, in *Fetridge v. Wells*, (4 Abb. Pr., 144), uses language with reference to the name "Balm of a Thousand Flowers," which, if adopted without qualification, would sustain the defendants' proposition, but on the other hand, Judge Hoffman, with reference to the same name in *Fetridge v. Merchant* (4 Abb. Pr., 156), dissents from the views of Judge Duer. The true limitation upon the right to adopt a new name for an article as a trade-mark is, I think, pointed out in the case of the *Linoleum Manuf. Co. v. Nairn*, (L. R., 7 Ch. Dis.). In that case the plaintiff had patented a floor covering of oil cloth which it named "Linoleum," and after the expiration of his patent, endeavored to restrain the defendant from using the same word as the name of the goods made by him. The word is stated in the case to signify "solidified oil" and this was the composition of the article. The Court refused an injunction, holding that the name was appropriate to describe the article, and that, having the right to make the article, the defendant had the right to use an appropriate name, and suggests that he was not bound to invent a new name for it. The Court distinguishes the case from that of *Braham v. Bustard*, (1 Hem. & Mil., 447), where the name "Excelsior White Soap Co." was sustained as a valid trade-mark, by saying that the word "Ex-

celsior," having no relation to the subject-matter, and being a purely fancy name, could lawfully be appropriated, but that, in the case of linoleum, the plaintiffs, having invented a new subject-matter, used merely the name distinguishing the *subject-matter*, but did not use a name distinguishing the subject-matter *as made by them*, from the same subject-matter as made by other persons.

In the case now before us the proofs are quite sufficient to justify the Court in holding that the plaintiffs were the first to introduce the article in the market, that they gave it the name in conjunction with their own name and address, and that by advertising and a long course of dealing, the article had become widely known and the plaintiffs had been identified with it as its manufacturers.

The right to give a new name to an article and adopt it as a trade-mark has been questioned in some cases, but recognized in others in this State. The general rule is laid down in *Canal Co. v. Clark*, (13 Wal., 322), as follows: "The office of a trade-mark is to point out distinctively the origin or ownership of the article to which it is affixed, or give notice who was the producer. This may in many cases be done by a *name*, a mark, or a device, well known but not previously applied to the same article." A trade-mark may consist of a name if adopted by a manufacturer to distinguish his goods from those manufactured by others. Judge Ingram, in *Wolfe v. Goulard*, (18 How. Pr., 64), observes that: "When a person forms a new word to designate an article made by him, which has never been used before, he may obtain such a right to that name as to entitle him to the sole use of it as against others who attempt to use it for a similar article." The Act to punish fraud in the use of trade-marks (*Laws of 1862, chap. 306, sec. 4*), makes it a misdemeanor, with intent to deceive to knowingly affix to any goods, etc., any label, mark, etc., which shall designate such goods, etc., either wholly or in part by a *word or words*, wholly or in part the same to the eye or in sound to the ear, as the word or words, or some of them, used by any other person to designate goods, etc., manufactured or prepared by him, and the point that the word adopted as a trade-mark may be a name given by the manufacturer to the article itself and that by which it becomes known to the trade, is authoritatively denied by

this Court in the case of *Burnett v. Phalon*, (3 *Keyes*, 594). (See also, *Davis v. Kendall*, 2 *R. I.*, 566; *Williams v. Johnson*, 2 *Bosw.*, 1; *Taylor v. Carpenter*, "Persian Thread," 2 *Sandf. Ch.*, 603; names registered as trade-marks under Act of July 8, 1870, in *Browne on Trade-Marks*, 601-639).

2. Our conclusion is, that where a manufacturer has invented a new name, consisting either of a new word, or a word or words in common use which he has applied for the first time to his own manufacture or to an article manufactured for him, to distinguish it from those manufactured and sold by others, and the name thus adopted is not generic or descriptive of the article, its qualities, ingredients, or characteristics, but is arbitrary or fanciful and is not used merely to denote grade or quality, he is entitled to be protected in the use of that name, notwithstanding that it has become so generally known that it has been adopted by the public as the ordinary appellation of the article.

The order should be affirmed, with costs.

Order confirmed.

All concur.

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IN THE UNITED STATES PATENT OFFICE.

EX PARTE KIPLING.

DECIDED 25 JUNE, 1883.

REPORTED 24 O. G., 899.

“Crystalline” Case.

1. TRADE-MARK—DESCRIPTIVE WORDS.—A word merely descriptive of an article of trade, of its qualities, ingredients or characteristics, cannot become a lawful trade-mark by virtue of a change in its orthography to that of a foreign language in which it possesses the same meaning.
2. REGISTRATION OF INVALID TRADE-MARKS SHOULD BE REFUSED.—It is the duty of the Commissioner of Patents to refuse to register alleged trade-marks which, under the decisions of the Courts, are clearly not valid.
3. SAME.—The Office has no right, by accepting and registering words or symbols which are clearly not valid trade-marks, to mislead applicants or the public.

APPEAL from the Examiner of Trade-Marks.

APPLICATION filed June 9, 1883.

Mr. A. Pollok, for the applicant.

MARBLE, *Commissioner*:

Appeal is taken from the decision of the Examiner refusing registration of applicant's alleged trade-mark, because it is descriptive of the character of goods to which it is to be applied. Applicant seeks to register the word "Cristalline" as his trade-mark for artificial stones or brilliants. The word "cristalline" or "crystalline" is thus defined: "Consisting of crystal. Having a texture produced by crystallization. Imperfectly crystallized; as granite is only crystalline. Resembling crystal; pure; clear; transparent; pellucid." (*Webster*).

1. The Examiner was correct in holding that the word selected by applicant as a trade-mark is descriptive of the character of goods to which he desires to apply it. No other word probably could be found which would more perfectly describe the character of said goods. Artificial stones or brilliants are not new to the trade, and it is not shown that applicant manufactures any particular class of artificial stones or brilliants. The word "cristalline" would apply as well to the class of goods manufactured by others as by applicant. There is nothing in the spelling of the word which gives it any but its ordinary meaning. The only question for decision, therefore, is whether, in view of the decision of the Supreme Court in the case of *The Delaware and Hudson Canal Company v. Clark*, (1 O. G., 279), applicant is entitled to the registration of the word as his trade-mark. In said decision the Court say: "No one can claim protection for the exclusive use of a trade-mark or trade name which would practically give him a monopoly in the sale of any goods other than those produced or made by himself. If he could the public would be injured rather than protected, for competition would be destroyed. Nor can a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, be employed as a trade-mark and the exclusive use of it be entitled to legal protection."

In said decision the Court quoted approvingly from the decision in the case of *The Amoskeag Manufacturing Company v. Spear*, the following:—"The owner of an original trade-mark has an undoubted right to be protected in the exclusive use of all

the marks, forms, or symbols that were appropriated as designating the true origin or ownership of the article or fabric to which they are affixed; but he has no right to the exclusive use of any words, letters, figures or symbols which have no relation to the origin or ownership of the goods, but are only meant to indicate their names or quality. He has no right to appropriate a sign or symbol which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose."

As above stated, the word selected by applicant as his trade-mark signifies as clearly as any word can the character of the goods to which he desires to apply it, and under the decisions referred to would not be a valid trade-mark.

2. While it is true that under the recent decisions of the Supreme Court of the District of Columbia, the registration of a trade-mark by the Commissioner of Patents, is to a large degree simply a ministerial duty, yet in the exercise of that duty it must be conceded that he has the right to refuse to register alleged trade-marks which are clearly not valid under the decisions of the Courts. It is still the duty of the Commissioner of Patents, I think, to inform applicants that signs, symbols or words selected by them as trade-marks are not such, so that they may not be deceived in applying them to any class of goods.

3. It is also his duty, I think, to the public to refuse the registration of an alleged trade-mark which would not be a valid trade-mark. Neither an applicant nor the public should be misled by the action of this office in accepting and registering words, signs, or symbols as trade-marks which are clearly not such.

I find no error in the decision of the Examiner refusing registration of applicant's alleged trade-mark, and therefore affirm the same.

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UNITED STATES CIRCUIT COURT, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

WILLCOX & GIBBS' SEWING MACHINE COMPANY

vs.

THE GIBBENS FRAME.

DECIDED 4 AUGUST, 1883.

REPORTED 17 FEDERAL REP., 623.

"G. Sewing Machine Frame."

1. TRADE-MARK—FORM OR SHAPE OF PATENTED MACHINE—EXPIRATION OF PATENT.—While no one has the right to make and sell his own wares as the wares of another, every one has the right to make and sell any wares not protected by patents; and a manufacturer of a patented article, after the expiration of the patent, has a right to represent that it was made according to the patent, and to use the name of the patentee for that purpose.
2. SAME—RIGHT TO USE FORM OR SHAPE OF MACHINE.—Where frames for sewing machines in the form of the letter G, have been so extensively manufactured and sold by the inventor during the time they were protected by patents, that the machine containing this feature has come to be known in the trade thereby, after the expiration of the patents, the patentee cannot, by claimings uch form or shape of frame

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as a trade-mark, prevent others from using such frames in sewing machines manufactured and sold by them.

3. SAME—MARK DESCRIPTIVE OF QUALITY OR STYLE.—Anything descriptive of the properties, style or quality of an article merely, is open to all.

Stephen A. Walker and *A. C. Brown*, for orator.

J. Hampden Dougherty and *Joseph C. Fraley*, for defendant.

WHEELER, J.:

This suit was brought in the Supreme Court of the State to restrain the use of frames in sewing machines in the shape of the Roman capital letter G. A preliminary injunction restraining such use until further order was granted *Ex parte*; and before further proceeding the cause was removed to this Court. It has now been heard on motion to dissolve this injunction.

As the case now stands it appears that letters patent No. 21,129 were granted to James E. A. Gibbs, under date of August 10, 1858, for improvements in sewing machines, the drawings and model of which showed this frame, but it was not claimed as a part of the patented invention; that design letters patent No. 1,206, under date of February 21, 1860, were granted to him for this form of frame; that upon the surrender of the original patent No. 21,129, reissued letters patent No. 2,655, under date of June 18, 1867, were granted to him, in which this shape of frame was particularly described, and its advantages set forth as, "which not only stamps it with a peculiar character, but is also exceedingly useful, as it affords the greatest possible space for the cloth or material to be sewed, of being turned and twisted under the needle and upon the table;" and there was claimed as a part of the patented invention, "combining with the vibrating needle-arm a frame-shape substantially like the Roman letter G, as herein shown and described, and for the purposes set forth." The orator operated under these patents until they expired,—the design patent, February 21, 1867, and the reissue patent, August 10, 1872. The orator registered this form of the frame as a trade-mark, and obtained certificate No. 8,356, dated from June

14, 1881, in the declaration for which it is stated that "this trade-mark has been used continuously in the business of the said company since the year 1859." The orator manufactured and sold sewing machines having this form of frame so extensively and for such length of time, while others were excluded from doing so, that its machines came to be known in the trade by this feature. The defendant makes and sells machines with the same style of frame, which, to some extent, indicates to those not informed that his machines are of the orator's make.

The question now is whether the defendant has the right to continue such use of this form of frame, or the orator has the right to have him restrained from such use. This frame is an essential part of these sewing machines, as it supports most of the moving parts of the machinery in the proper place for doing the work. This form of frame has some advantages over others, in that it requires less room for itself in proportion to the room afforded by it for the other parts and the material sewed, as described in the patent for it. Sewing machines made with these frames, otherwise good, were good machines. The frames in this form were a part of the manufacture to be identified as to source, and not an identifying mark, merely, of source, indifferent to the manufacture. The orator, in the use of this frame, made a good machine in this respect. Without the protection of a patent, however, the orator could not, by making good machines, either in form or style or other respects, exclude others from making the like in either or all of these particulars; in the first instance, certainly. Not until a feature had been used long enough to be known as a mark of the orator's machines, could the employment of it by others be a representation that their machines were the orator's. At common law this form was open to everybody, and, but for the exclusive use conferred by the patents, it might have been employed by others so extensively that the employment of it by the orators would not have amounted to any representation at all, that machines having it were of the orator's make. The exclusive rights of the orator, up to the time of the expiration of the patents, appear to have rested upon the

patents, and not upon any right acquired independently of the patents.

All rights acquired under the patents expired with them.

Congress was given power to promote the progress of science and useful arts, "by securing for limited times, to authors and inventors," the exclusive right to their writings and discoveries. *Const., Art. 1, sec. 8.* The grant to the inventor of the exclusive right for the limited time is in consideration of the benefit which the public will derive from the invention after the expiration of the term. *Grant v. Raymond, 6 Pet., 218.* Whatever was patented to the inventor, and enjoyed by him and those operating under him during the term, belongs to the public and is free to all at the expiration of the term.

1. Accordingly, a manufacturer of a patented article, after the expiration of the patent, has a right to represent that it was made according to the patent, and to use the name of the patentee for that purpose. *Fairbanks v. Jacobus, 14 Blatchf., 337; Singer Manuf'g Co. v. Stanage, 6 Fed. Rep., 279; Singer Manuf'g Co. v. Riley, 11 Fed. Rep., 706; Singer Manuf'g Co. v. Loog, 48 Law T. Rep., (N. S.), 3; 15 Reporter, 538.* Anything descriptive of the properties, style, or quality of the article merely, is open to all. *Canal Co. v. Clark, 13 Wall., 311; Manuf'g Co. v. Trainer, 101 U. S., 51.* While no one has the right to sell his own wares as the wares of another, every one has the right to make and sell any wares not protected by patents. Marks, symbols, or dress placed upon the wares might unlawfully misrepresent their source, but when left to speak for themselves alone, there could be no wrongful misrepresentation. These principles are not much controverted by the orator's counsel, but it is claimed that as the orator's machines are somewhat known by this frame, and other shapes easily distinguishable from this might be equally useful, some of which in hexagonal or octagonal, instead of circular, shape are suggested, the defendant should use some of those. But those, doubtless, would have been infringements of the patents, and the style used is as much freed by the expiration of the patents as those are.

2. All the effect which these frames have in representing machines to be those of the orator, appears to be due to the monopoly enjoyed under the patents; and to give the orator the benefit of the effect by calling the frame a trade-mark, would continue the monopoly indefinitely, when under the law it should cease.

It is obvious that the registration of the trade-mark in 1880 would not affect rights which the public already had acquired; it is not claimed that it should.

Motion granted.

“See *Hostetter v. Fries*, *ante*, 620; *Burton v. Stratton*, 12 *Fed. Rep.*, 696, and *note*, 704; *Shaw Stocking Co. v. Mack*, *Id.*, 707, and *note*, 717.”—ED.

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IN THE UNITED STATES PATENT OFFICE.

EX PARTE LEE & SHEPARD.

DECIDED 8 SEPTEMBER, 1883.

REPORTED 24 O. G., 1271.

*“Design Patent” Case.*MATTER PATENTED AS DESIGN CANNOT BE REGISTERED
AS TRADE-MARK.

The Office, after having adjudicated certain subject-matter patentable as a design, and granted a patent therefor, thereby giving the patentee the exclusive right to use the same for the term of years mentioned therein, cannot register as a trade-mark substantially the same design, and give to another and different party the right to use it as a trade-mark.

APPEAL from the Examiner of Trade-Marks.

TRADE-MARK.—Books.

APPLICATION filed July 13, 1883.

Messrs. Clarke & Raymond, for the applicants.MARBLE, *Commissioner*:

Applicants' appeal from the decision of the Examiner of Trade-Marks refusing registration of “an ornamental book-cover having

projecting beyond the edges thereof silk or other fringe." The Examiner refused registration for two reasons: first, because the book-cover described is anticipated by Design Patent No. 13,040, to G. Bourck, dated July 18, 1882; and, second, because the book-cover is not a trade-mark. The book-cover here claimed is in all essential particulars the same as the card-cover patented as a design to Bourck. Bourck has the right under said patent to use his design not only as a cover for cards but for books as well. There can be no question that the subject-matter covered by Bourck's design patent was properly patentable as such.

While it is true that a design may be used as a trade-mark, and that which is properly the subject for a design patent may also be the proper subject for a trade-mark, still the Office, after having adjudicated certain subject-matter patentable as a design and granted a patent therefor, thereby giving the patentee the exclusive right to use the same for the term of years mentioned therein, cannot register as a trade-mark substantially the same design and give to another and different party the right to use it as a trade-mark. Conflict in the rights of parties would at once arise. One would claim that he had the right to sell his production under his trade-mark and the other under his design patent. The Office should not knowingly bring about such a controversy.

Bourck filed his application long before Lee & Shepard's application was filed, and took his patent in the regular course of proceedings. The Office will do nothing to cast a shadow upon his title to the invention covered by his patent.

As the decision of the Examiner must be affirmed on the first point, it is unnecessary to consider the second.

The decision is affirmed.

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COURT OF APPEALS, STATE OF NEW YORK.
IN EQUITY.

THE ROYAL BAKING POWDER CO.*vs.*

GEORGE SHERRELL, ET AL.

DECIDED 2 OCTOBER, 1883.

REPORTED 93 N. Y., 331.

“*Royal Extract*” Case.

- 1, Letters or figures which, by the custom of traders or the declaration of the manufacturers, are used only to denote quality or grade, are incapable of exclusive appropriation as trade-marks.

Plaintiff manufactured three grades of flavoring extracts; to designate the best grade the firm, to whose business plaintiff succeeded, adopted the word “Royal,” the use of which was continued by plaintiff. Prior to such use defendants’ predecessors manufactured mustard, to designate which they used the words “Royal Standard.” Defendants continued the manufacture and the use of the words. They also began the manufacture of flavoring extracts which they designated as “Royal Standard” extracts. In an action to restrain such use of the word “Royal.”

2. HELD, that plaintiffs were not entitled to the exclusive use thereof as it denoted quality or grade, and that a refusal to dismiss the complaint was error.

Braham v. Bustard, (1 H. & M., 447), and *Hier v. Abrahams*, (82 N. Y., 519), distinguished.

APPEAL from judgment of the General Term of the Supreme Court, in the First Judicial Department, entered upon an order made October 28, 1881, which affirmed a judgment in favor of plaintiff, entered upon a decision of the Court on trial at Special Term.

This action was brought to restrain defendants from using the word "Royal" in connection with flavoring extracts manufactured by them, plaintiff claiming the exclusive right to such use as a trade-mark.

The firm of Zeigler & Seal, in 1886, began the manufacture of flavoring extracts; they manufactured three grades or qualities. To designate these grades they used the words "English," "Royal" and "London." Up to 1873 the word "English" was used to indicate the best grade. In that year they changed and used "Royal" to indicate the best grade, "English" the second, and "London" the third, and thereafter they were so designated. Plaintiff bought out said firm and succeeded to their business, and has continued the manufacture, using the word "Royal" as its predecessors had done. In 1865, Place & Turley, to whose business defendants succeeded, manufactured mustard, which they designated as "Royal Standard" mustard. Defendants continued such manufacture, and in 1873 they began the manufacture of flavoring extracts, which they designated as "Royal Standard" extracts. Further facts appear in the opinion.

Charles M. Marsh, for appellants.

The term "trade-mark" has been applied to a name, symbol or design put on to distinguish the origin or ownership of goods, and to the label or manner of packing them. (*Hier v. Abrahams*, 82 N. Y., 523; *Congress Spring Co. v. High Rock Congress Spring Co.*, 45 *Id.*, 291; *Morgan's Sons' Co. v. Schwachofer*, 5 *Abb. N. C.*, 265; *Amoskeag Co. v. Spear*, 2 *Sandf.*, 599; *Binninger v. Wattles*, 4 *Abb.*, [*N. S.*], 206). Only such words as are not in ordinary use in the English language, or are used to express origin

or ownership, can be used as a trade-mark. (*Corwin v. Daly*, 7 *Bosw.*, 233; *Caswell v. Davis*, 58 *N. Y.*, 233; *Amoskeag Co. v. Spear*, 2 *Sandf.*, 599; *Binninger v. Wattles*, 78 *How.*, 206; *Taylor v. Gillies*, 59 *N. Y.*, 334; *Wotherspoon v. Gray*, 36 *Scott L. Jour.*, 24). The word "Royal" is an adjective, and as such qualifies or expresses the quality of the essence mentioned in the label, and cannot be used as a trade-mark. (*Richardson, Worcester, Webster*; *Corwin v. Daly*, 7 *Bosw.*, 233). The fact that defendants made the name "Royal Standard" on certain goods—*e. g.*, mustard, gave them a right to apply it to other goods embraced within the ordinary scope of their business. (*Amoskeag Co. v. Garner*, 4 *Am. L. T. R.*, [*N. S.*], 176). It matters not that the form of words or phrases adopted as a trade-mark also indicate the origin or maker of the article. The combination of words must express only the latter. (*Caswell v. Davis*, 58 *N. Y.*, 233, 234). The question being an important one, and there being some evidence upon it, the refusal of the Court to find either way is an error of law for which the judgment must be reversed. (Code, sec. 993).

John M. Bowers, for respondent.

A trade-mark can consist of a word, and in such case the use of the same word on similar substances, in any shape, manner or or form, or in connection with any words, will be restrained. No imitation is necessary. (*Hier v. Abrahams*, 82 *N. Y.*, 519; *Am. Grocer v. Grocer Pub. Co.*, 25 *Hun*, 398). The word "Royal" can properly be used as a trade-mark. (*Burton v. Stratton*, 12 *Fed. Rep.*, 696; *Ford v. Foster*, *L. R.*, 7 *Ch. App.*, 611; *Braham v. Bustard*, 1 *Hen. & M.*, 447; *Lee v. Haley*, *L. R.*, 5 *Ch.*, 155; *Messerole v. Tynberg*, 36 *How.*, 14; *Caswell v. Davis*, 58 *N. Y.*, 223, 234; *Van Beel v. Prescott*, 82 *Id.*, 630; *Taylor v. Gibbs*, 59 *Id.*, 331; *Amoskeag Co. v. Spear*, 2 *Sandf.*, 599; *Corwin v. Daly*, 7 *Bosw.*, 233; *Binninger v. Wattles*, 28 *How.*, 206; *Messerole v. Tynberg*, 36 *How. Pr.*, 14; *Newman v. Alvord*, 49 *Barb.*, 588). The imitation having been admitted, plaintiff necessarily becomes entitled to the relief granted below. (*Williams v. Spence*, 25 *How. Pr.*, 366; *Enoch Morgan's Sons' Co.*

v. Schwachofer, 5 *Abb. N. C.*, 265). To sustain an action of this character it is sufficient, if the ordinary mass of customers, paying that attention which such persons usually do in purchasing, would be easily deceived by the label used by the defendant. An exact imitation need not be shown. (*Swift v. Dey*, 4 *Robt.*, 611). Plaintiff's right to maintain an action for violation of its trade-mark does not depend upon defendants' intention to violate it. It is enough that an actual violation is shown. (*Dale v. Smithson*, 12 *Abb. Pr.*, 237; *Dixon Crucible Co. v. Guggenheim*, *Cox's Am. Trade-Mark Cases*, 559; 2 *Brewst.*, [*Penn.*], 321; *Williams v. Spence*, 25 *How. Pr.*, 366; 2 *Bosw.*, 1; *Coffeen v. Brumpton*, 4 *McLane*, 516; *McLean v. Fleming*, 6 *Otto*, 245; *Filley v. Fassett*, 44 *Mo.*, 173; *Potter v. McPherson*, 28 *N. Y. Sup. Ct.*, 559; *Gorham v. White*, 14 *Wall.*, 511; *Devlin v. Devlin*, 69 *N. Y.* 214). This use of plaintiff's trade-mark, by placing an addition or tail to it, is no justification for the defendants. (*The B'klyn White Lead Co.*, 25 *Barb.*, 416; *Howard v. Henriques*, 3 *Sandf.*, *Sup. Ct.*, 725; *Newman v. Alvord*, 49 *Barb.*, 578; *Williams v. Johnson*, 2 *Bosw.*, 1; *Barrows v. Knight*, 6 *R. I.*, 434; *Matsell v. Flanagan*, 2 *Abb. Pr.*, [*N. S.*], 459; *Congress Co. v. High Rock Congress Co.*, 10 *Id.*, 348; 9 *L. T. R.*, [*N. S.*], 199; *Am. Tr. Cases*, 674). No right can be absolute in a name as a name merely. It is only when that name is used, printed or stamped upon a particular article, and thus becomes identified with a particular style and quality of goods that it becomes a trade-mark. (*Powley v. Houghton*, *Am. Trade-Mark Cases*, 486; *McAndrews v. Bassett*, *Cox's Am. Tr. Cas.*, 669). Even if the word "Royal" had been used by some one before the plaintiff, who had not claimed it as a trade-mark, that would be no justification for the defendants' infringing against the plaintiff who had adopted it as a trade-mark. (*Partridge v. Menck*, 2 *Sandf. Ch.*, 622; 2 *Barb. Ch.*, 101; 1 *How. App. Cas.*, 558).

RAPALLO, J.:

1. Letters or figures which, by the custom of traders or the declaration of the manufacturers, are only used to denote quality, are incapable of exclusive appropriation, but are open to use by

any one, like the adjectives of the language. (*Amoskeag Co. v. Trainer*, 101 U. S., 51; *Amoskeag Manuf. Co. v. Spear*, 2 Sandf., 599). The right to use a word or name as a trade-mark, is the right which a person has to use a certain mark or name for articles which he has manufactured, so that he may prevent another person from using it, because the mark or name denotes that articles so marked or named were manufactured by a certain person, and no one can have the right to put the same name or mark upon his goods and thus represent them to have been manufactured by the person whose mark it is. (*Per* Sir Wm. Page Wood, in *Collins Co. v. Cowen*, 3 Kay & Johnson, 428). But there can be no exclusive right to the use of words or marks which have no relation to the origin or ownership of the goods, and are only meant to indicate their quality or grade.

In *Corwin v. Daly*, (7 Bosw., 233), the words "Royal," "Imperial" and "Princely" are referred to as words denoting the quality of an article—as indicating its high degree of excellence, such as "superior," "superfine," "extra," and similar words, and the word "Royal" is to be found of frequent use for that purpose, in many cases in the books. It was used by the defendants and their predecessors as applied to mustard, which they sold as "Royal Standard" mustard, before its adoption by the plaintiffs. In *Braham v. Bustard* (1 Hem. & Mil., 447), the word "Excelsior," in the name "Excelsior White Soft Soap," was sustained as a trade-mark. It was objected that this was merely a mark of quality, but Sir W. Page Wood overruled this objection and held that it was used to denote origin, because the plaintiff did not sell two or three qualities of soap, calling one of them Excelsior, but only one which they denoted the Excelsior White Soft Soap, and that it was like the words "Albert," "Victoria," "Eureka," etc., an arbitrary designation for the sake of distinction. In the present case, however, it appeared upon the plaintiff's own showing, in the testimony of Mr. Zeigler, that when their predecessors, Zeigler & Seal, commenced putting up flavoring extracts, they did not use the word "Royal," but various brands, some being called "Concentrated Extracts," and some "Zeigler & Seal's Extract;" that afterward they put up some

under the name of "Royal," and that they used that word as a distinguishing mark, and that a reputation was established for it as the finest quality the market afforded—one of the favorite qualities.

2. On cross-examination Mr. Zeigler being asked how he came to use the word "Royal," explained that at that time they were handling royal baking powder, and they took it to designate a certain grade of extracts; that they had two or three other brands; one was "London," one "English," and the third "Royal;" that the word "Royal" was applied to a specific article or quality, and the other terms to different qualities or grades; that the "English" brand was the best up to 1873, and then they changed around and made the "Royal" their best grade, that the "London" had always been the poorest. Mr. Wooden, the plaintiff's salesman, testified that the plaintiff did not designate the different grades of its extracts as first, second and third, but in a different way; that one was called "London," another "English," and the other "Royal," and that the name designated the grade; that the "Royal" was the best, and that it only appeared in connection with the name of the plaintiff—The Royal Baking Powder Company—as the manufacturer. Mr. Hoagland, the president of the plaintiff, testified that the name "Royal" was identified with its goods, as indicating a grade of goods of the highest quality.

We think this case comes within the principle of the case of *Amoskeag Mfg. Co. v. Trainer*, (101 U. S., 51); *Amoskeag Mfg. Co. v. Spear* (2 Sandf., 599, 616, 618), and that it appeared that by the custom of the trade and the declaration of the manufacturers, the word "Royal" was used to denote the quality or grade of the goods. It cannot be said, as in the case of *Excelsior White Soft Soap Co.*, (1 Hem. & Mill., 447), that it was used simply as a word of distinction to indicate the origin of the goods, because the plaintiff did not sell two or three qualities, calling one of them "Excelsior." The facts are just the reverse.

In the case of *Hier v. Abrahams*, (82 N. Y., 519), relied upon by the plaintiffs, there was no claim that the word "Pride" was used to denote quality, nor was there any evidence that it was used to denote grade; but it was expressly found that it had been

adopted by the plaintiffs as a trade-mark for cigars manufactured by them, and that this was known to the defendant, and that he imitated it and used it on cigars manufactured and sold by him, whereby the public were deceived into believing that they were purchasing cigars manufactured by the plaintiffs, and the plaintiffs were damaged thereby. In the present case the evidence shows that the word "Royal" was used on one of their grades of extracts, for the purpose of designating one of their grades. There was no element of fraud or imitation, for it appears that the defendants did not even know of the use of the word by the plaintiff until this action was brought. They used it, not as an imitation of any trade-mark of the plaintiff, but in connection with the word "Standard," to denote a superior quality, as they had previously used the words "Royal Standard" on mustard, and we are of opinion that this was no violation of any exclusive right of the plaintiff.

The motion to dismiss the complaint should, we think, have been granted.

The judgment should be reversed and a new trial granted, costs to abide the event.

Judgment reversed.

All concur, except ANDREWS, J., absent.

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SUPREME COURT OF ERRORS, HARTFORD
DISTRICT, STATE OF CONNECTICUT.
IN EQUITY.

NEW HAVEN PATENT ROLLING SPRING BED CO.

vs.

WILLIS B. FARREN, AND OTHERS.

DECIDED 9 NOVEMBER, 1883.

REPORTED 51 CONN., 324.

“Patent Spring Bed” Case.

1. In order to justify an injunction restraining a party from using a trade-mark, name or other device descriptive of his goods, it should appear that he is in fact so using it as to represent, or induce the belief that the goods which he manufactures or sells are the goods of the plaintiff, and that there is danger that the plaintiff will in that manner be defrauded.
2. The plaintiff and Farren Brothers were severally engaged in the manufacture of spring beds at New Haven, under the same patent, the beds manufactured being substantially the same, and each claiming to produce the original article. Both had at their offices and agencies various signs, among which the plaintiffs had that of “New Haven Roll-up Spring Bed,” and Farren Brothers that of “Farren Brothers’ New

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Haven Rolling Spring Bed." A trader who kept for sale the Farren Brothers' beds at Hartford, but who was not their agent or in their employ, attached to one of their beds in front of his store, a placard with the words "The Only Original New Haven Roll-up Spring Bed," upon it. **HELD:**

Not to be a case for an injunction.

SUIT for an injunction; brought to the Court of Common Pleas in Hartford County, and heard before BENNETT, J. Facts found and judgment rendered for the defendants. The plaintiffs appealed. The case is sufficiently stated in the opinion.

T. M. Maltbie and *W. H. Ely*, for the plaintiffs.

C. E. Gross, for the defendants.

CARPENTER, J.:

This is a complaint praying for an injunction restraining the defendants from using certain words and phrases in describing the articles manufactured or sold by them.

Both the plaintiff and Farren Brothers are engaged in the business of manufacturing spring beds, in New Haven, under the same letters patent, and the goods produced by both are substantially identical. Each party claims to produce the original genuine article. The plaintiff has displayed at its office and agencies various signs, namely:—"The Genuine New Haven Rolling Spring Bed;" "The Genuine New Haven Roll-up Spring Bed;" "The New Haven Rolling Spring Bed;" and "The New Haven Roll-up Spring Bed." Farren Brothers have displayed at their office in New Haven signs reading thus:—"Farren Bros' Spring Bed," and Farren Bros' Guarantee Spring Bed;" and at their agencies throughout the State signs reading, "Farren Bros' Rolling Spring Beds;" Farren Bros' New Haven Rolling Spring Beds;" and "Rolling Spring Beds, Farren Bros." But Farren Brothers never used the combination of names, "New Haven Rolling Spring Bed," or "New Haven Roll-up Spring Bed," nor the words "New Haven," as applied to the beds manufactured by them, until about two years before the trial.

The defendant Bill, who was engaged in the coal business in Hartford, bought beds of Farren Brothers and sold them, but he was never their agent, nor does it appear that he was in their employ. At one time, however, he had the exclusive right to sell their goods in Hartford. In June, 1882, he displayed a placard attached to a Farren Brothers' bed, in front of his store, upon which placard were the words—"The only original New Haven Roll-up Spring Bed."

This is in substance the finding upon which the Court of Common Pleas rendered judgment for the defendants, from which judgment the plaintiff appealed.

1. In order to justify an injunction restraining a party from using a trade-mark, the name of a corporation, partnership or individual, or other device descriptive of his goods, it should appear that he is in fact so using it as to represent, or induce the belief, that the goods which he manufactures or sells are the goods of the plaintiff; and that purchasers do so believe; or at least that there is danger that the plaintiff will in that manner be defrauded.

In this case the plaintiff failed to establish any one of the essential requisities. No such representations appear to have been made by the defendants or any of them, no one has been deceived, and the plaintiff is in no danger of being defrauded.

2. Consequently there is no error in the judgment of the Court below.

In this opinion the other Judges concurred.

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CIRCUIT COURT UNITED STATES, DISTRICT
OF INDIANA. IN EQUITY.

HORTON MANUFACTURING CO., Jamestown, N. Y.,

vs.

HORTON MANUFACTURING CO., Ft. Wayne, Ind.

DECIDED 29 DECEMBER, 1883.

REPORTED 18 FEDERAL REP., '816.

“Horton Manufacturing Co.” Case.

1. INDIVIDUAL NAME—USE BY PARTNERSHIP—DISSOLUTION.—A partnership which is suffered by any one to use his name as a part of the firm style and title, though it may acquire by such license an exclusive right to the use of the name so long as the partnership continues intact, cannot, upon its dissolution, confer the same privilege upon its successor.
2. LACHES—ACQUIESCENCE—NOTICE.—Acquiescence by any person in the wrongful use of his name, will not estop him from asserting his rights in equity, unless he has notice during such acquiescence of the facts rendering the use of his name wrongful.

J. K. Hallock and *C. P. Jacobs*, for complainant.

Ninde & Ellison, for defendant.

WOODS, J.:

Bill in equity for an injunction against the use of a name by the respondent, and a cross-bill by the respondent for an injunction against the use of the same name by the complainant, both the parties being incorporated under the name, The Horton Manufacturing Company. The material facts are as follows:

“Sometime prior to 1873, Dr. Theodore Horton was engaged at Bluffton, Indiana, in the manufacture and sale of corn-planters, under letters patent of which he owned a half interest only. This corn-planter was advertised and sold, and became known, as the ‘American Hoosier Hand Corn-planter.’ William K. Vandegriff, having purchased the other one-half interest in the patent, entered into partnership with Dr. Horton and one Rachel V. Blackstone, under the firm name of T. Horton & Co., and by the terms of their partnership articles, undertook to prosecute the business aforesaid for the period of twelve years from October, 1873, the date of the articles. In the conduct of the business, Mrs. Blackstone was represented by her husband, William A., who was made the book-keeper of the concern.

“Soon after the organization of the company, it purchased a patent for a washing-machine, which it proceeded to manufacture and sell, in considerable quantities, under the name ‘Improved Western Washing-Machine.’ In December, 1879, Dr. Horton sold his interest in this business to Vandegriff and W. A. Blackstone, but reserved his half interest in the letters patent upon the corn-planter, and one-third interest in the patent for the washing-machine; his vendees agreeing to pay him a royalty upon such articles as they should manufacture under either patent, and at the same time taking of Horton a lease for one year of the building in which the business had been theretofore conducted, with the intention of continuing the business in the same place. Mrs. Blackstone also retired from the firm at this time, leaving her husband and Vandegriff to constitute the new firm, for the continuance of which no definite time was agreed upon.

“There is conflict in the evidence upon the questions whether or not certain *patterns* were included in the sale by Horton to Vandegriff and Blackstone, and whether or not Horton agreed not to en-

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gage again in the same line of manufacture. The *preponderance* of the evidence seems to be that he did so agree, but upon the understanding, implied but not *expressed*, that his successors should continue to carry on the business at Bluffton. It was distinctly understood between the parties that Vandegriff and Blackstone should continue the business. The sale and transfer of Horton's interest having been completed, he consented, without consideration, that the new firm should adopt the name, "The Horton Manufacturing Company." It did accordingly take this name, and under it prosecute the business at Bluffton, until June, 1880, when the members of the firm concluded to remove, and did remove, to Jamestown, N. Y. Preliminary to this removal the company re-sold to Horton the engine, boiler, shafting, and some other articles used in the business, and settled with him for the rent of the building and for royalties then due. At Jamestown, the company, under the same name, carried on the same business until March 12, 1881, when its members, said Vandegriff and Blackstone, united with T. J. and J. J. Vandegriff in organizing an incorporated company, the complainant, which company has since that time prosecuted the business upon a large scale.

"A few months after the removal of the company aforesaid to Jamestown, Dr. Horton, in association with two others, under the firm name of T. Horton & Co., resumed the business at Bluffton, and published a circular to the effect that he had no connection with the company at Jamestown, and that that company was without a Horton and was sailing under false colors.

"That company put forth a counter circular, claiming to be the lawful successor of the original T. Horton & Co. The new firm of T. Horton & Co. continued in business until June, 1883, when it was placed in the hands of a receiver, and Dr. Horton associated himself with others in the organization of the respondent corporation, which, under the same name as the complainant, is engaged in and proposes to prosecute the same business as the complainant, and has put forth circulars, cuts, and advertisements which will tend to confuse the public in respect to the manufactures of the two companies.

“The goods manufactured by the parties, and by the companies which preceded them, have always been advertised and sold and known to the trade by the names aforesaid, which were stencilled or painted upon the respective articles, and in addition there was on each article the phrase ‘manufactured by,’ followed by the name and place of business of the company which put it upon the market; and in the case of the complainant and its predecessors the goods were marked, besides the name of the particular article, as ‘Manufactured by the Horton Manufacturing Company, Jamestown, N. Y.: successors to T. Horton & Co.’

“The respondent has an express grant from Dr. Horton of his good-will, letters patent, and of the right to use his name. It does not appear that the Horton Manufacturing Company, as a firm or by act of its individual members, made any formal attempt to confer upon the complainant its name or good-will, or the right to use Horton’s name, and if that exists it is by force of the fact stated, and not by express grant.”

For the general principles by which, upon these facts, the rights of the parties must be determined, counsel on either side have cited the opinion in *Holmes v. Holmes, etc., Manuf'g Co.*, 37 Conn., 278. Stated generally, the decision announced in that case is to the effect that incorporators of a business company, who had permitted the use of their individual names in the competition of the corporate name, could not, after the business of the company had become established and its manufactures well known under that name, confer upon a new and rival company or corporation the right to use their individual names in a similar way, to the confusion of the public and consequent detriment of the first company; and this, upon the ground that in the use of a name lawfully acquired, which designates the origin and ownership of its goods, a manufacturing company or corporation will be protected “upon the same principle and to the same extent that individuals are protected in the use of trade-marks.” The following extract from this opinion illustrates well the views of the Court, and will be found to bear somewhat directly on the case now presented:

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“The principles we have been contending for should, under similar circumstances, be applied to partnerships and corporations alike. It is only when the circumstances change that the principle becomes inapplicable. A person whose name appears in the firm-name of a partnership, in the absence of anything raising a contrary presumption, will be presumed to have agreed that it should so continue during the existence of the partnership. If, before the partnership expires, he merely sells his interest in the concern to a stranger, he conveys to the purchaser a right in the use of the name during the remainder of the term. If, at the expiration of the term, he sells his interest, with an agreement, express or implied, that the business shall thereafter be continued under the same name, the same rule applies. At the dissolution of the partnership, the partners *revert* back to their individual rights and responsibilities, and each partner, in the absence of any agreement to the contrary, has an absolute right to control the use of his own name. In all these respects there is no difference between a corporation and a partnership.”

In respect to the case presented: If it can be said that the old firm of T. Horton & Co, was not dissolved in 1879, upon the going out of Horton and Mrs. Blackstone, and that Vandegriff and Blackstone took it up as a going concern, then, in the absence of a contrary understanding, they perhaps had a right to go on under the old name. But as, in that case, Horton would have continued liable to the public as a member of the firm, notwithstanding his withdrawal, the more reasonable application of the rule would seem to be that the use of his name could not have been continued without his authority and so the parties themselves seem to have understood. Instead of going on under the old name of T. Horton & Co., to which they do not appear to have supposed they had any right, Vandegriff and Blackstone, with the consent of Horton, determined to adopt, as the style of their firm, the name of “The Horton Manufacturing Company.” This consent, having been given without consideration, was probably a mere license, *revocable* at pleasure. *McGowen Bros' Case*, 2 *Cin. Rep.*, 313. And if there was in it an element of contract which made it irrevocable, it was a grant to the new firm as then com-

posed, and, by force of the language quoted from the Connecticut decision, as well as upon sound reason, was capable of continuing only so long as that partnership should last, and therefore not transferable, either directly or indirectly, to any other person, firm, or organization, without Horton's consent.

1. There is certainly no authority, in any case cited by counsel, or which has come under observation, for the proposition that a partnership, whose name consists in whole or in part of the name of a person who is not a member of the firm, can, without the consent of the owner, transfer the right to another company or corporation to make a like use of such name. A man might willingly forego the use of his name in favor of an ordinary partnership, which, whether limited or not to a definite term of existence, is liable, upon many contingencies, to come to an end; but from such a grant there could not reasonably be inferred an intention to authorize a transfer or assignment to other companies or corporations, whereby the owner might be perpetually deprived of the control of his own name.

There may be some cases which seem inconsistent with this view, but upon closer consideration it is believed they are not so. The case of *Dixon Crucible Co. v. Guggenheim*, 2 Brewst., 321, and the authorities cited, will be found to be instructive. It is doubtless the law, as in that case it is held, that "the property in a trade-mark will pass by assignment, or by operation of law, to any one who takes at the same time the right to manufacture or sell the particular merchandise to which the trade-mark has been attached;" and if one has made of his own name a trade-mark, and then transfers to another his business, in which his name has been so used, the right to continue such use of the name will doubtless follow the business as often as it may be transferred.

Such was *Bajou's Case*, decided by the *Tribunal of Commerce* of Paris in 1854, cited in 2 Brewst., *supra*; and such are the many cases there cited, and which might be cited, wherein persons have been enjoined against the use of their own names as marks or labels on goods, when the tendency was to injure others in the rightful use of the same or similar names upon like goods. If, for instance, Horton had called his goods "The Horton Corn-planter"

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and "The Horton Washing-machine," doubtless his vendees and successors in the manufacture, including the complainant, would have been entitled to continue to mark, advertise, and sell the goods by the same name. But this is manifestly very different from the use of the name, as a constituent part of the name of the company or corporation which should manufacture or sell the goods so marked.

The conclusion seems clear that the complainant did not acquire from the Horton Manufacturing Company, the partnership which preceded it, the right to use Horton's name; and as that partnership was dissolved, or at least abandoned, when the corporation was formed, Horton, if he had ever lost, was then remitted to the full control of his name.

2. The complainant claims further that if it did not in the first instance acquire a right to the use of the name, it did acquire it by long use, and by the acquiescence of Horton in that use to such an extent as to constitute an estoppel against him or any claiming under him.

Conceding that there may be such an estoppel, it is not shown in this instance. Besides the circular published by Horton, as already stated, which implied and indicated, it would seem with sufficient plainness, his dissent from the use of his name by the establishment at Jamestown, it does not appear that Horton had notice or knowledge that the partnership had been abandoned and the complainant corporation formed; and without such knowledge it could hardly be said that there is an estoppel; even if the facts were otherwise sufficient.

The proposition established that the complainant had no right to the name, and has been using the same wrongfully, the conclusion seems necessarily to follow that the respondent, by virtue of Horton's grant, acquired a complete right to the name, and is entitled, on the cross-bills to an injunction against its use by the complainant.

Decree accordingly.

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SUPREME COURT, STATE OF OHIO.
IN EQUITY.

BUCKLAND, ET AL.*vs.*RICE, ET AL.

DECIDED JANUARY, 1884.

REPORTED 49 OHIO ST. REP., 526.

“Trommer’s Extract of Malt” Case.

1. Where a trade-mark contains a material misleading representation, a Court of Equity will not protect it.
2. There are however other distinctive features of the trade-marks, labels and circulars, which are not subject to the objection urged to the use of the word “Trommer,” which the Court below protected by their decrees in this case. Some of these devices the plaintiffs in error wrongfully made use of, and in rendering judgment which the District Court should have rendered, we make our decree the same as that of the Court below, except wherein it protects the defendants in error in the use of the word “Trommer.”

ERROR to the District Court of Sandusky County.

R. P. & H. S. Buckland, for plaintiffs.

J. M. Lemmon and *William Henry Browne*, for defendants.

NASH, J.:

The defendants in error in the Court of Common Pleas, ask for an injunction to restrain the plaintiffs in error from infringing upon an exclusive right claimed by them in the word "Trommer," used together with the words "Extract of Malt Co.," as a trade-mark upon bottles of a malt extract and advertising pamphlets.

The following facts appear from the bill of exceptions: The extract of malt sold by the defendants in error was made by one Gessner, and in accordance with a formula prepared by him. The preparation of this extract was begun in 1874. Many years before that time, Dr. Felix Von Niemeyer, a German physician of some note, published a "Text Book of Practical Medicine," the third American edition of which was printed in 1870. This book was a standard work and became authority with physicians and students of medicine. In this book Dr. Niemeyer stated that in late years he had obtained very good effects from an extract of malt, prepared by Trommer. He also in general terms described Trommer's malt extract. Ziemssen, in his "*Cyclopedia of the Practice of Medicine*," a standard medical authority, also speaks of a malt extract prepared by Trommer's receipt. Gessner did not know Trommer's receipt, and it is not claimed that the malt extract sold by the defendants in error was prepared in accordance with Trommer's method, or that their malt extract was like Trommer's extract of malt. When they put their extract upon the market they adopted the word Trommer to be used as a trade-mark upon their labels and in their advertising matter.

What was the object in doing this? Why was the name of Gessner—the real author of the extract—concealed and "Trommer" put forward as the catch word?

1. There could have been but one motive, and that was that the public should be led to believe that the defendants in error were making an extract of malt like that made by Trommer and mentioned by Niemeyer and Ziemssen. This object is made more apparent by an examination of the advertising pamphlets issued by

the defendants in error. In these, upon the page immediately following the title page, are printed without note or comment, except to show where they came from, extracts from Niemeyer's text book and Ziemssen's cyclopedia in regard to Trommer's extract of malt, and in such manner as to indicate to the ordinary reader that what these authors had written was in regard to their extract of malt.

It is well settled that where any symbol or label claimed as a trade-mark is so constructed or worded as to make or contain a distinct assertion which is untrue, a Court of Equity will not protect it by injunction. *Leather Cloth Co. v. American Leather Cloth Co.*, 4 *De Gex, Jones & Smith*, 136; *H. of L. Cases*, 523; *Connell, et al. v. Reed, et al.*, 128 *Mass.*, 477; *Manhattan Medicine Co. v. Wood*, 108 *U. S.*, 218.

We think that the word "Trommer" was used by the defendants in error so as to hold out to the public that they were making a malt extract like that made by Trommer. This was a deception, and to the extent that the District Court by its order protected them in the use of the word "Trommer" it erred. For this reason we reverse the judgment of the District Court.

There are, however, other distinctive features of the trade-marks, labels and circulars of the defendants in error which are not subject to the objection urged herein to the use of the word "Trommer," which the Courts below were asked to and did protect by their decrees in this case. Some of these devices the plaintiffs in error wrongfully made use of, and in rendering the judgment which the District Court should have rendered, we make our decree the same as that of the Court below, except wherein it protects the defendants in the use of the word "Trommer."

Judgment accordingly.

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COURT OF APPEALS, STATE OF MARYLAND.
IN EQUITY.

CARLOS D. SIEGERT, AND OTHERS,

*vs.*CORNELIUS W. ABBOTT AND CORNELIUS F. ABBOTT.

CORNELIUS W. ABBOTT

*vs.*CARLOS D. SIEGERT, AND OTHERS.

DECIDED 7 FEBRUARY, 1884.

REPORTED 61 MD., 276.

“Angostura Bitters” Case.

INJUNCTION—TRADE-MARK—MISREPRESENTATION.

1. A Court of Equity will not interpose by injunction to protect a claim to a trade-mark or label, where either contains a misrepresentation.

The complainants, claiming to be the manufacturers and exclusive proprietors of certain cordial or aromatic bitters, popularly known as “Angos-

tura Bitters," and claiming as its trade-mark this designation, sought to enjoin the defendants, who were engaged in the manufacture of an article styled "Angostura Aromatic Bitters," from manufacturing or selling any preparation or article under the name of "Angostura Bitters," and from imitating the complainants' labels in which the bottles containing their bitters were wrapped. The label of the complainants, used when their bill was filed, stated that the bitters is prepared by Dr. S——, that it was prepared at Angostura, but is now prepared at Port of Spain. Dr. S. died some years before the bill was filed by his successors in the business, and he never lived at Port of Spain. The label also stated that the bottles bore the signature of the complainants, when in fact they bore the signature of the original inventor. **Held:**

That the complainants, in consequence of the misrepresentations contained in their label, were not entitled to relief against the defendants.

APPEAL from the Circuit Court of Baltimore City.

The case is stated in the opinion of the Court.

The cause was argued before ALVEY, C. J., MILLER, IRVING, and BRYAN, J.

Samuel Wagner, and *John M. Carter*, for Siegert and others.

The fact that the respondents have avoided an exact imitation of the complainants' label will not relieve them. The Courts have had much more frequent occasion to deal with this class of cases, than with those where the bolder plan was resorted to of an exact imitation. *Amoskeag Manuf'g Co. v. Spear*, 2 *Sandford S. C.*, 599; *Burnett v. Phalon*, 5 *Abb. Pr.*, *N. S.*, 212; *Newman v. Alword*, 51 *N. Y.*, 189-193, and *Coleman v. Crump*, 70 *N. Y.*, 573-8. In the last case it was held that "It is not necessary that the symbol, figure or device used or printed and sold for use should be a *fac simile* or precise copy of the original trade-mark, or so close an imitation that the two cannot be distinguished except by an expert, or upon a critical examination by one familiar with the genuine mark. If the false is only colorably different from the true; if the resemblance is such as to deceive a purchaser of ordinary caution; or if it is calculated to deceive the careless

and unwary, and thus to injure the sale of the goods of the proprietor of the trade-mark, the injured party is entitled to relief."

The same rule has been recognized by this Court in *Robertson v. Berry*, 50 Md., 591. See also *Meriden Britannia Co. v. Parker*, 39 Conn., 460; *Lawrence Manufacturing Co. v. Lowell Hosiery Mills*, 129 Mass., 328; *Filley v. Fassitt*, 44 Mo., 178; *Barrow v. Knight*, 6 R. I., 434-8.

In the Federal Courts also, the rule has been adopted. *McLean v. Fleming*, 96 U. S., 245. See also *Walton v. Crowley*, 3 Blatch. C. C., 440-7; *Gorham Co. v. White*, 14 Wall., 511-527; *Hostetter v. Adams*, 13 Reporter, 454. The recent English cases are to the same effect: *Seixo v. Provezende*, 12 Jurist, N. S., 217; *Wotherspoon v. Currie*, 27 L. T. R., N. S., 393; *Orr v. Johnston*, 40 L. T., N. S., 307, 311-313; *Taylor v. Taylor*, 23 L. J. Ch., 255; *Siegert v. Findlater*, 26 Weekly Rep., 461. Fraudulent intention is not necessary to constitute an infringement. *Stonebraker v. Stonebraker*, 33 Md., 267-8; *Millington v. Fox*, 3 My. & Cr., 338, 352; *Collins Co. v. Walker*, 7 W. R., 222; *Clement v. Maddick*, 33 L. T., 117; *Amoskeag Co. v. Spear*, 2 Sand. S. C., 599-608; *Coleman v. Crump*, 70 N. Y., 573-8; *McLean v. Fleming*, 96 U. S., 245, 253; *Filley v. Fassitt*, 44 Mo., 178. Nor is it necessary to show actual deception. *Filley v. Fassitt*, *supra*; *Abbott v. Bakers' Assn.*, W. N., 1872, page 31, (*Cox's Manual*, 213, 214); *Edelston v. Edelston*, 1 DeG., J. & S., 185, (*Cox's Manual*, 118).

But our Courts have gone farther than this, and have held that not only is the actual imitation unnecessary to constitute an infringement, but that the adoption by another, with intent to deceive the public, of certain peculiar characteristics of the package, label or wrapper by which a manufacturer's goods had become known and recognized, amounts also to an infringement. This principle was established in *Frese v. Bachof*, (reported in 13 U. S. Pat. Gazette, 635, and in *Cox's Manual*, 346); and the same point has been decided in the State Courts in *Williams v. Johnson*, (2 Bos. N. Y., 1 *Cox's Manual*, 85), and in *Morgan's Sons' Co. v. Troxell*, (*Cox's Manual*, 415).

Henry Stockbridge, and *George Hawkins Williams*, for C. W. and C. F. Abbott.

Dr. J. G. B. Siegert never had any valid right, title or claim to the name "Angostura Bitters" as a trade-mark.

In order to acquire or to have that right, Dr. Siegert must have been the first to appropriate that name, must have used it invariably in a lawful business, with truth and in good faith, have stamped, attached, or in some way applied it uniformly to his merchandise, and have been the only one who could rightfully, and with truth, so apply it.

This proposition is sustained by all the authorities. A trade-mark is a "technical commercial emblem," "nothing more nor less than one's commercial signature to his goods," and the right to it is perfected "only when the owner stamps the symbol upon an article of merchandise which he desires to sell." *Browne on Trade-Marks*, secs. 127-130, also, sec. 143; *Shaw Stocking Co. v. Mack*, 12 *Fed. Rep.*, 707, and note, 717.

"A proprietor can have but one trade-mark; that must have a practical existence—not resting in the mind of the owner alone—but be stamped, impressed or attached in some way to the article itself." *Candee, et al. v. Deere, et al.*, 54 *Ill.*, 439.

The doctrine, as enunciated by the Supreme Court of the United States is, "that no one can apply the name of a district or country to an article of commerce, and obtain thereby such an exclusive right to the application as to prevent others from truthfully using the same designation," and it adopts, as its own, the language of the Supreme Court of New York, that "no one has a right to appropriate a sign or symbol, which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose." It therefore refused to enjoin the use of the term "Lackawanna" as applied to an article of merchandise. *Canal Company v. Clarke*, 13 *Wall.*, 311, 324, 327.

The Supreme Court of Pennsylvania hold the same doctrine, refusing to recognize a right to the exclusive use of the term "Glendon" as a trade-mark. *Glendon Iron Co. v. Uhler*, 75 *Penn. St. Rep.*, 467.

The principle, contended for by the complainants, that a mere geographical name can be exclusively appropriated as a trade-mark, finds no sanction in the cases cited to sustain it. They only hold that the use may be good as against a wrong-doer, who attempts, by fraudulent means, to divert custom from its legitimate channel. This is shown wherever Courts have occasion to discuss some unguarded expressions dropped in such cases as those of *Newman v. Alword*; *McAndrews v. Bassett*, and *Seixo v. Provezende*; *Canal Co. v. Clarke*, 13 Wall., 325; *Browne on Trade-Marks*, secs. 182, 184.

The fact, therefore, if it be a fact, that Dr. Siegert made bitters in the town of Angostura, gives him no monopoly of that town or its name as against one who can use it truthfully. He has no patent or exclusive right to compound ingredients and give them that name, and, if it rightfully belongs to the compound, restrain any one else who produces the same compound from giving it the same name. Anybody else, anywhere in the world, has a right to make the same article, and to sell it under the same name. Again, if the name be used to indicate the origin of the merchandise, any person producing merchandise having the same origin has a right so to indicate in its name. The first user could only claim it as against those who would seek to deceive the public by its use.

In this case, there is no evidence of any wish or intention to practice any deception upon any one. The answer avers, and the evidence fully sustains it, that the name used by the defendants was applied to the goods made by them before they had any knowledge that there was any article in the public market, or known to the public, bearing the name of "Angostura Bitters," or any person in existence bearing the name of "Siegert."

"Angostura bark" was an article that had been known to the medical profession and to the pharmacopœia as a valuable bitter and tonic for three-quarters of a century at least. That medicinal simple; the defendant, or those under whom he holds, had a right to use, and if they so used it that it was the leading characteristic of the article manufactured therefrom, they had a right to give it its true name, derived from, or descriptive of, its composi-

tion and properties. See *Encyclopedia Britannica*, 9th Ed., Art. *Angostura*; *Osgood v. Allen*, 6 Am. L. Times, 20; *Cheavin v. Walker*, L. R., 5 Ch. Div., 862-3; *Raggett v. Findlater*, L. R., 17 Eq. Cas., 29.

Neither Dr. Siegert nor the plaintiffs could any more monopolize the use of the name "Angostura," as against any one manufacturing a medicine in any one of the numerous towns bearing that name, or as against any person, anywhere in the world, making a bitters with *Angostura bark* as its leading ingredient, and truly naming it accordingly, than the canal company could monopolize the name "Lackawanna," or the Glendon Iron Company could monopolize the word "Glendon."

"A generic name, or a name that truly describes the article that he makes or sells, every one has a right to attach to the goods that he places upon the market." *Thompson v. Winchester*, 19 Pick. Rep., 214; *Manufacturing Co. v. Trainer*, 11 Otto, 101 U. S., 54; 58 N. Y., 234.

But not only had Dr. Siegert no right to monopolize the use of the word "Angostura" as applied to bitters, he never attempted to do so. He never claimed a right to do so. He never called his bitters "Angostura Bitters" at all. During all the time of his making of bitters he always called his article "Aromatic Bitters," and never "Angostura Bitters."

But if Dr. Siegert had a right to the exclusive use of the name "Angostura Bitters," and it had "devolved" upon the complainants, still the label, or wrapper, which they seek to have protected, bristles all over with misrepresentations—is itself a palpable fraud—and forfeits any and all right that they might otherwise have to relief from a Court of Equity.

This label or wrapper, in which the name "Angostura Bitters" was for the first time used by any of the Siegert race, and which they now seek to have a Court of Equity protect, was adopted by them in the year 1875—after they had removed from the place that had once borne the name Angostura, and ceased to have any connection with it,—twenty-nine years after there ceased (as they allege) to be any such place as Angostura, and five years after the death of Dr. Siegert. And yet in every wrapper used by them since

that time, they announce, in all the languages that figure on it, that it is "Aromatic Bitters, or Angostura Bitters, *prepared by Dr. Siegert,*" &c. They nowhere say or suggest, or hint that the skill and care and experience with which the original discoverer of the article compounded it, are no longer used in its manufacture, but it is made by entirely different persons. Their doing so would be the exact truth, but it would advertise the public that the skill and care in which they confided in Dr. Siegert is no longer employed in the manufacture of the goods, and so they conceal that fact from the public, endeavor to extend their trade by falsely asserting that what they offer to sell was "prepared by Dr. Siegert," and then ask a Court of Equity to sustain them in so doing. *Partridge v. Menck*, 1 *How. App. Cases*, 558; *Browne on Trade-Marks*, sec. 490; *Fetridge v. Wells*, 13 *How. Pr. Rep.*, 385; *Hobbs v. Francais*, 10 *How. Pr. Rep.*, 567; *Hennessy v. Wheeler*, 69 *N. Y.*, 271; and see *Connell v. Reed*, 128 *Mass.*, 477; *Leather Cloth Co. v. American Leather Cloth Co.*, 4 *DeG., J. & S.*, 143, 144, 148, and 11 *H. L. Cases*, 523; *Phalon v. Wright*, 5 *Phila.*, 464; *Palmer v. Harris*, 60 *Pa. St.*, 156; *Ginter v. Kinney Tobacco Co.*, 12 *Fed. Rep.*, 782; *Witthaus v. Mattfeldt*, 44 *Md.*, 303; *Sherwood v. Andrews*, 5 *Am. Law Rep.*, (*N. S.*), 589; *Manhattan Medicine Co. v. Wood, et al.*, 108 *U. S. Rep.*, 218.

Neither Dr. Siegert, nor the complainants, who claim to have a title under him, were the first to use the term "Angostura Bitters," and consequently neither he nor they acquired any right by priority of user. Dr. Siegert never called the article made by him "Angostura Bitters." During all his life he called it "Aromatic Bitters," and labeled it with that name, advertising it as prepared by himself at "Angostura." For five years after his death these complainants labeled their article in the same way, and specifically claimed the name "Aromatic Bitters" as their trade-mark, and even prosecuted a competitor in the trade in 1874, for infringing their trade-mark by using the name "Aromatic Bitters." *Siegert v. Elders*, *Cox's Manual of Trade-Mark Cases*, 243.

IRVING, J., delivered the opinion of the Court.

The bill in this case was filed by Carlos D. Siegert and others, to prevent, by injunction, Cornelius W. Abbott and Cornelius F. Abbott from imitating the complainants' trade-mark and labels, in which they wrapped the bottles of their bitters popularly called "Angostura Bitters," by putting up a compound represented to have similar properties and virtues, in labels so much like those of the complainants, as to be a palpable simulation of them, by which the public was likely to be, and was, deceived into buying the defendants' preparation as and for that of the complainants. The bill also prayed for an account of profits from the sales made by the defendants in that way. The Circuit Court enjoined one of the defendants, Cornelius W. Abbott, and his agents and employees, and forbade him and them to use the labels described in the proof as used by them; but the bill was dismissed as to Cornelius F. Abbott, and no account of profits was decreed. The complainants appealed because Cornelius F. Abbott was not *co nomine* enjoined, and also because an accounting was not decreed. The defendant, Cornelius W. Abbott appealed because any relief was granted.

A motion has been made to dismiss the complainants' appeal, on the alleged ground, that they have estopped themselves from prosecuting the same, by taking proceedings, after decree granting partial relief and awarding them costs, to enforce the payment of the costs. The whole case being open for review on the appeal of the defendant in the suit, and, on careful consideration, being of opinion that there was error in the decree, and that the bill ought to have been dismissed, we have found the motion unimportant, and have not considered the legal question it raises.

1. It is a general rule of law, that Courts of Equity, in cases of this kind, will not interfere by injunction where there is any lack of truth in the plaintiff's case; that is, where there is any misrepresentation in his trade-mark or labels. *Browne on Trade-Marks*, sec. 71, and sec. 474, *et seq.* The respondents invoke the application of this rule to the complainants' case, as made, which they contend contains a misrepresentation on the face of the label, at its very beginning.

The heading of the label, as used when the bill was filed, is in three different languages, but the translation of the Spanish and German is the same as the English, which reads "Aromatic Bitters, or Angostura Bitters, prepared by Dr. Siegert, at Angostura, now Port of Spain, Trinidad." Here is, certainly, a statement that the article is prepared by Dr. Siegert; that it was prepared at Angostura, but is now prepared at Port of Spain.

It is a conceded fact that Dr. Siegert died in 1870. The bill so charges. He never lived at Port of Spain. The complainants, his sons and successors in business, removed to Port of Spain, several years after his death. One of the complainants was associated with Dr. Siegert in the business as his partner, and alleges that, as survivor, he succeeded to the business; and subsequently he associated his brothers, the other complainants, with him as partners in the trade.

A late case in the Supreme Court of the United States, (*Manhattan Medicine Co. v. Wood*, 108 U. S., 218), decided in April, 1883, since the decision of the learned Court from which this appeal was taken; seems to be conclusive against the right of the complainants to the relief asked. There the complainants sold a medicine, put up in glass bottles with panel-shaped sides, on five of which, in raised letters, the words "Atwood's Genuine Physical Jaundice Bitters, Georgetown, Mass." are blown in the glass. Twenty-five years ago the medicine was manufactured by Moses Atwood, in Georgetown, Massachusetts, and was sold by his agents throughout the United States. The complainant in the suit was a corporation under the laws of New York, to which, by successive *mesne* assignments, the sole right to use the recipe and manufacture the compound had passed; and that right was being exercised in New York City, when a bill was filed against one Wood for using their trade-mark and labels, or simulating them, for a medicine manufactured by Wood in Portland, Maine. The Court says, that Dr. Atwood sold his "Atwood's Vegetable Jaundice Bitters" with this designation, that it was manufactured by him. "As the medicine was tried and proved to be useful, it was sought for under that designation, and that purchasers might not be misled, it was always accompanied with a label showing

by whom and at what place it was prepared. These statements were deemed important in promoting the use of the article and its sale, or they would not have been continued by the assignees of the original inventor. And yet they could not be used with any honest purpose, when both statements had ceased to be true. It is not honest to state that a medicine is manufactured by Moses Atwood, of Georgetown, Massachusetts, when it is manufactured by the Manhattan Medicine Company in the City of New York." The Court further says: "The object of the trade-mark being to indicate, by its meaning or association, the origin or ownership of the article, it would seem that when a right to its use is transferred to others, either by act of the original manufacturer or by operation of law, the fact of the transfer should be stated in connection with its use, otherwise a deception would be practiced upon the public and the very fraud accomplished, to prevent which, Courts of Equity interfere to protect the exclusive right of the original manufacturer." Because of these untruthful statements, the Supreme Court held that the complainants were not entitled to the aid of a Court of Equity, and relief was denied. Numerous cases were cited by the Court in support of the law as laid down by them, among which are *The Leather Cloth Company v. The American Leather Cloth Company*, 4 DeG., J. & S., 137, and 11 *Clark H. L. Cases*, 523; *Pidding v. How*, 8 Sim., 477, and *Perry v. Truefitt*, 6 Beav., 66.

A more exactly analogous case can hardly be imagined. It is true a removal from "Angostura" or "Ciudad Bolivar" to "Port of Spain," is noted in the label; but it is so noted as to leave the impression that Dr. Siegert, the inventor and original manufacturer, had so removed and was continuing his manufacture at "Port of Spain." Although Dr. Siegert died in 1870, and a new firm was compounding the bitters at a place where he never did live and compound them, when the simulation by defendants was begun and committed, no intimation is to be found in the label that he is dead, and that complainants as his legal successors are conducting the business under his name and signature, a *fac simile* of whose signature is preserved on the label. It should be remarked, that in the note of warning against counter-

feits, at the left hand of the label, it is stated the bottles bear the complainants' signature; which inspection shows to be not theirs, but the original inventors. We are unable to distinguish this case from the Manhattan Medicine Company case, from the opinion in which we have quoted, and which we think it proper to follow in a case of this nature, in the absence of a statute of the State controlling the subject. The complainants have relied on *Siegert v. Findlater*, 26 *Weekly Reporter*, 459, wherein the present complainants after the death of their father, were awarded injunction by Justice Fry, in England. The same point respecting misrepresentation seems to have been made in that case, and to have been made in the pleading; but just how it was pleaded does not appear. The learned Judge, however, overrules the objection, but his reasoning is most unsatisfactory. We do not see how the misrepresentation of the fact that Dr. Siegert is personally compounding these bitters is announced and explained by the statement that he has removed to Port of Spain in the Island of Trinidad. The point is treated, in that case, as if the misrepresentation was solely of the place of manufacture, which, in fact, is the most harmless part of the misrepresentation. Upon that question we cannot regard the Findlater decision as of sufficient authority to control the case as now presented to us. In the case of *Robertson v. Berry & Co.*, 50 *Md.*, 591, wherein the property right of a publisher to the title and name of his work, is recognized in analogy to the law of trade-marks, and relief was granted against imitation, the point, on which we dispose of this case, did not arise, and the case is distinguishable from this. This decision, therefore, is not intended to depart from any of the principles therein established.

For the reasons we have assigned, the decree in this cause must be reversed and the bill of complaint must be dismissed.

*Decree reversed, and
bill dismissed.*

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CIRCUIT COURT UNITED STATES, DISTRICT
OF RHODE ISLAND. IN EQUITY.

MORGAN, ET AL.

vs.

ROGERS.

DECIDED 12 FEBRUARY, 1884.

REPORTED 26 O. G., 1113.

“Dr. Haynes’ Arabian Balsam” Case.

1. TRADE-MARKS—A TRADE-MARK MAY BE CONVEYED WITH THE PROPERTY WITH WHICH IT IS ASSOCIATED.—As an abstract right, apart from the article manufactured, a trade-mark cannot be sold, the reason being that such transfer would be productive of fraud upon the public, but in connection with the article produced, it may be bought and sold like other property.
2. TRADE-MARKS WILL PASS UNDER BILL OF SALE WITHOUT SPECIFIC MENTION.—For a trade-mark to pass under a bill of sale, it is not necessary that it should be specifically mentioned. If a trade-mark is an asset, as it is, there is no reason why it should not pass under the term “assets,” in an instrument which conveys the entire partnership property.
3. The fact that the complainants agreed to turn over the property to the Millers after they had been paid, cannot operate to divest them of the

exclusive right to the trade-mark if they acquired such under the mortgage.

Mr. Nathan F. Dixon, Mr. J. Van Santvoord, and Mr. A. Chester, for the complainants.

Mr. Benj. F. Thurston, and Mr. J. C. B. Woods, for the defendant.

COLT, J.:

It appears by the bill and evidence that the complainants had from time to time advanced large sums of money to the firm of J. Miller & Sons, who were carrying on the business, in Providence, R. I., of the manufacture and sale of certain proprietary medicines, notably the compound known as "Dr. Haynes' Arabian Balsam." To secure the complainants, Miller & Sons executed a chattel mortgage to them, dated June 1, 1875. On or about March 22, 1876, the complainants took possession under the mortgage and proceeded, through an agent, to carry on the business of the manufacture and sale of these medicines. Subsequently, on February 13, 1877, Miller and Sons conveyed to the defendant, Rogers, the exclusive right to use their trade-marks and to make and sell their medicinal compounds. The present suit is brought to restrain the defendant from using these trade-marks. The main question in the case turns upon the meaning of the following clause in the mortgage:

"The following articles of personal property, now in our possession, and now in and upon the premises known and designated as numbers (8) eight and (12) twelve High street, in said City of Providence, viz: The entire property, stock, furniture and fixtures, and other articles now in and upon said premises, together with all debts and book accounts, assets and effects of every kind and nature belonging to said firm of J. Miller & Sons."

The complainants contend that the above recital includes all trade-marks then owned and used by Miller & Sons in their business on High street, and that such was the intention of the contracting parties. The defendant claims that this description does not cover any trade-mark, but only the property, stock, accounts,

&c., belonging to the firm; that such was the intention of the parties, and that the proof shows that at most, and independent of the mortgage, the complainants have a parole license to use the trade-mark until reimbursed for their advances to Miller & Sons.

The clause of conveyance in the mortgage is very broad in its terms. Clearly the language bears the construction and will bear no other than that the whole property of Miller & Sons upon the premises occupied by them, together with their assets of every kind, passed by way of mortgage to the complainants. The description plainly identifies the property and states what is conveyed. It is not a case where there is an ambiguity by reason of two inconsistent descriptions in the same instrument, nor is it a case where the instrument fails to point out the subject-matter, so that a stranger after examination might be deceived, but in plain and unequivocal language, and for the large consideration of \$48,500, the entire property of the firm of Miller & Sons at their place of business and all the firm assets are conveyed by way of mortgage to the complainants.

1. There is no reason why a trade-mark cannot be conveyed with the property with which it is associated. As an abstract right, apart from the article manufactured, a trade-mark cannot be sold, the reason being that such transfer would be productive of fraud upon the public. In this respect it differs from a patent or a copyright; but in connection with the article produced, it may be bought and sold like other property. It constitutes a part of partnership assets, and is properly sold with the firm property. (*Browne on Trade-Marks*, secs. 360, 361; *Hall v. Barrows*, 10 *Jur. N. S.*, 55; *Ainsworth v. Walmesley*, 44 *L. J. R.*, 252; *Kidd v. Johnson*, 100 *U. S.*, 617; *Walton v. Crowley*, 3 *Blatch.*, 440; *Congress and Empire Spring Co. v. High Rock Congress Spring Co.*, 57 *Barb.*, 526, and 4 *Am. Law Times R.*, 168; *Dixon Crucible Co. v. Guggenheim*, 2 *Brewster*, 321).

2. For a trade-mark to pass under a bill of sale it is not necessary that it should be specifically mentioned. In *Shipwright v. Clements*, (19 *Weekly Reporter*, 599), there was a sale by one partner to the other of all his interest in the partnership, stock in trade, goods, chattels and effects, book-debts, moneys, in the bank, and

all other property not being on the premises, the defendant covenanting that he would not carry on the trade within one mile of the premises or in any way affect the business to be thereafter carried on by the purchaser, the Court held that this was a sale of the business, and that a trade-mark passed under such a sale, whether specially mentioned or not. If a trade-mark is an asset, as it is, there is no reason why it should not pass under the term "assets" in an instrument which conveys the entire partnership property. To hold that the trade-mark is not included in this mortgage is to say that the most valuable part of the partnership property is not covered by the words "assets and effects of every kind and nature."

The evidence, in our opinion, strongly confirms the construction we have put upon the instrument, and shows that such was the intent of the parties. The complainants proceeded to take possession under the mortgage of the entire property and assets of the firm, to use the trade-marks, and to manufacture and sell the medicinal compounds. At the time possession was taken one of the Millers sent for Mr. Morgan and surrendered the keys. Two of the Millers for months after this continued to sell the medicines under the direction of the agent who was carrying on the business for the complainants. The annual royalty due Dr. Haynes the complainants assumed and paid. The defendant, Rogers, as shown by his letters, understood that the complainants had succeeded to all the rights of Miller & Sons and were running the business. He says, however, that in the fall of 1876, after a consultation with the Millers, and after what they said, he took legal advice, and found that the complainants had title under the mortgage only to the goods and effects of Miller & Sons; but that his mind was not clear on the question of the trade-marks is shown by the fact that subsequently, in his conveyance from Miller & Sons, of February 13, 1877, under which he now claims the right to use these trade-marks, there is a provision that if, at the expiration of two years, he should not be in the exclusive enjoyment of the trade-marks in consequence of any act done by the Millers in conveying or encumbering them, then, at his option, the annuities to be paid to the Millers under the agreement were to cease.

3. The fact that the complainants agreed to turn over the property to the Millers after they had been paid cannot operate to divest them of the exclusive right to the trade-marks if they acquired such under the mortgage. With such exclusive right they, as well as Miller & Sons, might hope the debt would soon be extinguished, but without such exclusive right such a result would be most improbable.

Upon a proper construction of the clause of conveyance in the mortgage, and upon the evidence showing the intent of the parties, we are satisfied that the relief prayed for should be granted, and that the defendant should be enjoined from the use of the trade-marks.

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SUPERIOR COURT OF COOK COUNTY, CHICAGO, STATE OF ILLINOIS. IN EQUITY.*

WILLIAM I. BUNKER, ET AL.

vs.

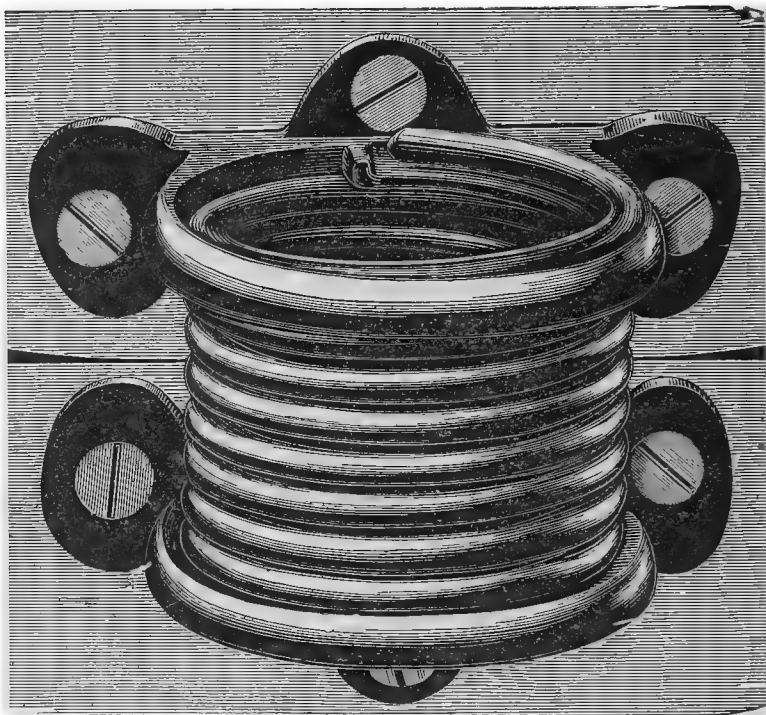
JOSEPH W. KENNA AND REUBEN A. HITCHCOCK.

DECIDED APRIL, 1884.

THIS cause coming on to be heard upon the bill of complaint of the complainants, the answer of the defendants thereto, the replication of the complainants, to such answer, and the proofs taken and offered by said parties respectively, and being argued by *Messrs. Banning & Banning* and *Melville W. Fuller, Esq.*, counsel for the complainants, and *Messrs. Peirce & Fisher*, counsel for the defendants, and the Court being now fully advised in the premises doth find—

1. That in or about the year 1879, the complainants, Jacob Beiersdorf and William I. Bunker, adopted and began to sell a spring attachment for connecting together the rockers and base-rails of stationary or platform rocking chairs, consisting of a broad, short, spiral spring, with rigidly attached brackets, and having

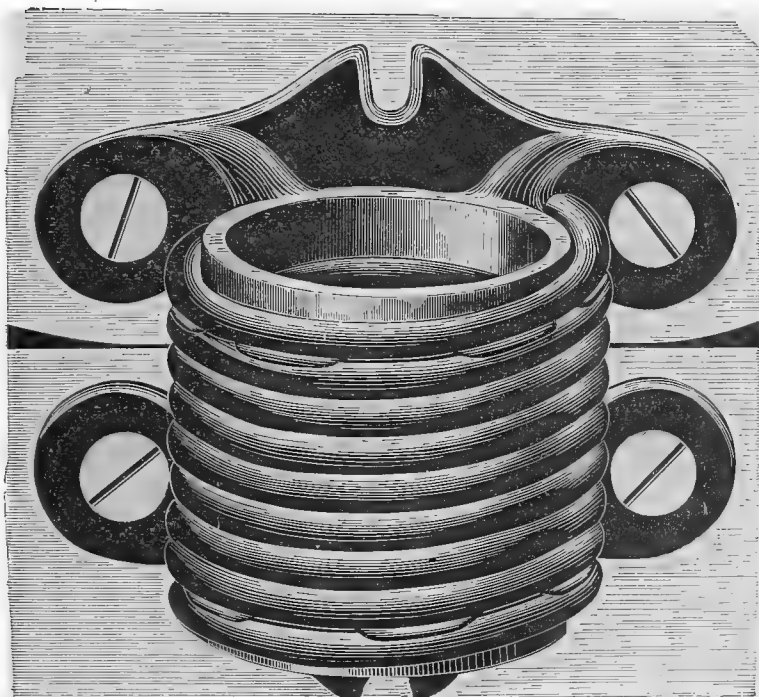
* Not reported.



ORATORS' SPRING.

the external form and appearance shown in the complainants exhibits "Orators' Spring;" that they were the first so to adopt and sell such rocking chair attachments, and have ever since their adoption continued the sale thereof; that the external form and appearance of said rocking chair attachments are distinctive and arbitrary; that the complainants' said attachments have become and are generally known in the trade as being of their manufacture, because and by reason of their said peculiar characteristics; and that the complainants are entitled to and have the exclusive right to make and sell rocking chair attachments having the peculiar characteristics of form and appearance aforesaid.

2. That the defendants, Joseph W. Kenna and Reuben A. Hitchcock, have infringed upon the said exclusive rights of the

**DEFENDANTS' SPRING.**

complainants by the sale of spring attachments for connecting together the rockers and base-rails of stationary or platform rocking chairs, each attachment consisting of a broad, short, spiral spring, with rigidly attached brackets, and having substantially the same external form and appearance as the complainants' said attachments, that is to say, having the form and appearance shown in the complainants' exhibit "Defendants' Spring;" that there are structural differences between said exhibits, "Orators' Spring" and "Defendants' Spring," in mode of attaching the bracket-plates to the spiral springs therein; but the same are well calculated to deceive and do deceive the general public having occasion to purchase a stationary base rocking chair with said rocker spring attachments applied thereto.

3. That the subject-matter at issue between the parties in sum or value in the controversy exceeds one thousand dollars (\$1000.00), exclusive of costs, in amount.

It is therefore ordered, adjudged and decreed, and the Court doth hereby order, adjudge and decree, that a perpetual injunction issue in this cause, restraining and enjoining the said defendants, Joseph W. Kenna and Reuben A. Hitchcock, their agents, attorneys, servants and workmen, and each of them from directly or indirectly selling or offering for sale rocking chair attachments consisting of broad, short, spiral springs, with rigidly attached brackets, and having the external form and appearance of the complainants' said attachments or in colorable imitation thereof, or so nearly resembling the same as to be calculated to mislead or deceive ordinary purchasers desiring to buy the complainants' said attachments.

It is further ordered that neither said complainants nor said defendants shall by advertisements, circulars or otherwise make any representations calculated to embarrass or injure the trade of the other, save only as said representation shall be in strict accordance with the findings of this decree.

It is further ordered that the defendants pay the costs of this suit, to be taxed, and that execution issue therefor.

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IN THE UNITED STATES PATENT OFFICE.

EX PARTE LANDRETH.

DECIDED 23 APRIL, 1884.

REPORTED 31 O. G., 1441.

“Red Bag” Case.

1. Neither the color alone nor the form alone of a package, nor the color of an article of commerce can constitute a trade-mark.
2. The doctrine of the United States Courts, so far as it goes, is in entire consonance with that of the Courts of Great Britain and France, that color alone cannot constitute a valid trade-mark.
3. As words, characters and symbols descriptive in their application to any merchandise, cannot be appropriated by any one to his exclusive use, for the same reason ordinary materials sold in the market and adapted for manifold uses, cannot be appropriated to any particular one of these uses by any person to the exclusion of the public from the same employment of them.
4. Colored fabrics being commonly on sale and in use, there can be no legal restriction upon their use by any person for any lawful purpose that suits his convenience.
5. The word “device” is used in respect to trade-marks in a sense totally different from that in which it is employed in connection with mechanical contrivances. It does not signify an expedient or scheme for any purpose but an emblematic figure, mark or sign capable of being imprinted or otherwise displayed upon merchandise.

APPLICATION of Oliver Landreth, filed January 12, 1884.

BUTTERWORTH, *Commissioner*:

The following opinion has been prepared by the Examiner of Trade-Marks as his answer to reasons of appeal:

The matter presented is a red bag to be used for seed-peas. Applicant specifies certain words of a descriptive character, which may be imprinted on it, but says—

“The essential features of my trade-mark is the red bag, and I therefore claim the use, broadly, of a red bag in which the pea-seed is packed for the trade, either plain, or with any or all of the above words or pictures, printed, stamped, woven therein, or otherwise fixed thereon. It is not necessary that the bag be canvas, as it may be formed of red paper, or of any other fabric; but I prefer canvas on account of its strength.”

The so-called *fac simile* filed in the case is not such, but a drawing in black lines, representing in outline a bag gathered at the top and sealed, and having descriptive words printed upon it. The Examiner holds that this is not such a *fac simile* as the law requires. Although no amendment has been made in this particular, an exhibit has been filed, showing the actual red canvas bag employed by applicant, and this objection is waived pending the appeal.

For a better understanding of the merits of the case it is observed that in a similar application filed simultaneously with this, a blue bag is claimed as a trade-mark for spinach-seed. In all other respects the cases are identical, and the decision in one concludes the office upon the other, and upon an entire series, which, if the decision is favorable, are to be presented by this applicant, involving the use of different colors to distinguish different seeds of his production from those of other parties.

It is evident, though not apparent from the single case, that applicant's purpose is to secure the exclusive use of a system of packing seeds, in which each kind of seed shall be indicated and its origin shown by the color of the package alone. It is also evident that were the right of applicant to the exclusive use of such a system recognized by the office it would be impossible to

maintain it in the Courts under trade-mark law, since it would be in any one's power, without infringing a single one of the so-called trade-marks, to employ a similar system or any number thereof, within the almost infinite limits of arithmetical permutation. Perhaps this consideration alone is enough to show the impracticability of making the matter set forth perform the office of a trade-mark. As requested by applicant, both the exhibits referred to are presented herewith. There is no limitation in respect to the matter claimed as essential in this case, except the color of the receptacle. As to shape and material, it is limited to nothing, except that it must be such material as can be made into a bag—paper, silk, canvas, leather, india rubber, mosquito-netting, flannel, any textile stuff capable of receiving a red color—and the bag may be of any shape or size, an envelope, a lady's reticule, a gunny-sack, as well as the particular canvas bag shown in the exhibits.

Now, the Examiner takes the position that color alone, unlimited by form or specific device, cannot constitute a legal trade-mark. In this position he is sustained by the Office decision in the case of Williamson, cited in *Browne on Trade-Marks*, (272). The application file shows no reference to the Commissioner, and and no Office record shows it to have been brought to his attention; but the author of the work cited was the Examiner who acted upon the case, and he states in his remarks upon it that the Commissioner was consulted in person. The claim, as shown by the file, was for the colors of two labels or wrappers, or a single color, and color regardless of form was insisted upon.

The Examiner was upheld in his rejection.

"A contrary opinion (says the author) would virtually have conceded the right of any man to select a certain color by which his goods should be designated, a peculiarly-colored paper in which his merchandise should be wrapped, and his exclusive right to that color. The effect would have been, if such a wild theory were maintained, to gradually throttle trade."

In *Harrington v. Libby*, (12 O. G., 188), this language was quoted by the Court with approval. (U. S. Circuit Court, So. Dist., N. Y.). The matter involved in this case was a decorated

pail as a package for paper collars. Held that, such pail being a common article of commerce, the right of the claimant was not clear to seize it and make a title to its exclusive use for a special purpose by calling it a trade-mark. Injunction was refused. In the case *Moorman v. Hoge*, (2 *Sawyer*, 78), also quoted in the above case, the United States Circuit Court, District of California, held that a barrel of peculiar dimensions could not become a trade-mark irrespective of the brands upon it. Another case having a close bearing on the present issue is that of *Tetter* for a red color in illuminating oil. This was appealed to the Commissioner, who reversed the Examiner in a decision, recorded vol. 17, MSS. Decisions, p. 420, and directed the case to issue. So far the authority of the Office appears to be adverse to the Examiner's position; but the present owners by assignment, The Red C Oil Manufacturing Company, in their registration No. 9,952, January 9, 1883, have abandoned the whole matter claimed by the former registrant, and restrict themselves to a colored label in which the word and letter "Red C" are prominent and the oil of a red color appears only in their statement as the particular goods on which the trade-mark is used. If they had regarded the matter formerly registered as a valuable or even tenable trade-mark, it is reasonable to suppose they would not have abandoned it, since the value of a trade-mark, if not in direct proportion to its age, is greatly enhanced by long use. It does not appear that any Court ever directly determined upon the legality of this alleged trade-mark. In the case *United States v. Rider* in the United States District Court, Maryland, Rider was charged with counterfeiting this trade-mark and was acquitted by the jury. Being a criminal case, it is not reported, and there was no written decision; but the *Baltimore American* of October 8, 1878, reports that Judge Giles, in giving the case to the jury, expressed his opinion that the color of the oil could not be a valid trade-mark, although registered in the Patent Office. This expression of opinion, along with the failure of the suit, seems to account sufficiently for the voluntary abandonment of the alleged trade-mark, and to show that the Commissioner was in error in permitting it to be registered.

1. The conclusion to be drawn from these various decisions is that neither the color alone, nor the form alone, of a package, nor the color alone of an article of commerce can constitute a trade-mark.

If we regard the authority of other nations, it should be added that the British Statutes for registration of trade-marks, both the former law and that now in force, set forth specifically what shall constitute a trade-mark for the purposes of the Act, and in both it will be noticed that color as an element is entirely ignored. This determines the practice of the British Courts, in which this element is treated as a subordinate accessory, needful perhaps as a means of distinguishing form in devices, but otherwise of little value. Such a case as that now presented could not stand a moment in a British Court. Recognized of high authority in trade-mark cases are the decisions of the French Courts. In the case *Davey, Bickford, Watson et Cie. contre Nier*, in the Tribunal *Correctionnel de Nimes* (Criminal Court), the Tribunal held that jurisprudence and authors concur that color alone cannot constitute a trade-mark; that independent of color a concurrence of other circumstances is necessary. Plaintiff having appealed from this decision, it was reviewed by *La Cour de Nimes*. (Answering to a Circuit Court). Regarding the sufficiency of color alone to constitute a trade-mark, the Court used this language:

“Held, that if color cannot sometimes constitute a trade-mark it is because color isolated from all combination can scarcely serve for a distinctive sign. It has been determined that a tint given to a product in the process of manufacture cannot constitute a color-mark, and, further, that an artificial color extending to the entire product constitute a commercial quality of the merchandise rather than a distinctive mark for it. That in these conditions, outside of a patent for invention, color cannot create a monopoly to the exclusion of other manufacturers; but held; that from the moment that color, either by its special arrangement or by its application to certain parts of the product, however simple the arrangement, arrives at forming a distinctive sign capable of

striking the eyes of the purchaser, it enters into the category of signs which can be employed as trade-marks."

This case is fully reported in *Annales de la Propriete Industrielle*, vol. 25, p. 81.

Adverse to this position, so distinctly enunciated by the French Court, and apparently the accepted doctrine in Europe and America, applicant cites *Knott v. Morgan*, a British case to be found in *Cox's Manual*, (57). In this case no exclusive right in the plaintiff to the peculiar color on his omnibuses was recognized. It was not in any sense a trade-mark case; but injunction was granted to restrain the defendant from trading upon the plaintiff's reputation. Applicant also cites *Morgan v. Troxell*, (*Supreme Court of New York, Cox Manual*, 674). Here a silver-foil wrapper for soap was employed having a blue band upon it passing around the cake. This arrangement of contrasting colors, simple as it is, brought the case precisely within the category named by the French Tribunal and separates it most widely from such a case as that now in question. In *Sawyer v. Horn*, (*U. S. Circuit Court, Md. District, Cox Manual*, 667), laundry-bluing was put up in package consisting of a blue cylinder with a red top. Under the French ruling this might constitute a trade-mark, but the Court was very cautious not to so pronounce. Injunction was granted, "whether the complainant has a trade-mark or not," because there was no question that the respondent's bluing was so put up as to mislead customers.

With the single exception of the Red Oil decision, the Examiner is unable to find an authority on either continent in support of such a case as that in issue; and in this decision, while directing the issue of the case, it is interesting to remark that the Commissioner himself indicated a doubt as to the real validity of the trade-mark. It was a doubt which he resolved in favor of the applicant in view of the fact that from his refusal there was no appeal. He expressed the feeling that while by his refusal he might prevent the applicant from enjoying a right he was possibly entitled to exercise, on the other hand if it should turn out that the matter in question was no trade-mark no harm could result. This decision, then, can be regarded only as a reference of the

question to the final determination of the Courts and of public opinion. If the very language of the decision, however, does not remove it from the category of authorities on the subject, this is done by the subsequent history of the case, and we are left absolutely without an authority of the Offices or of the Courts on which such a case as applicant's can rest for validity.

2. The doctrine of the U. S. Courts, as far as it goes, is in entire consonance with that of the British and French, that color alone cannot constitute a valid trade-mark.

With these determinations for our guidance it is perhaps needless to inquire closely into the principles upon which the tribunals of so many lands have based their conclusions. In the judgment of the Examiner these principles are not far to seek. 3. As words, characters, and symbols, descriptive in their application to any merchandise, cannot be appropriated by any one to his exclusive use, for the same reason ordinary materials sold in the market and capable of employment for manifold uses cannot be exclusively appropriated to any particular one of these uses by any one. They are the common property of the public. Be the restriction ever so slight it is still a restriction, and abridgment of the public right. He who proposes to fence in any part of the highway must show a stronger title than his mere inclination. It is not enough to plead that since all the rest of the broad highway is open to him the traveller is not impeded. Public rights are, and always must be, more jealously guarded than private rights, since they are more liable to encroachment from the lawless and unthinking. Hence the slightest approach to such an intrusion must be resisted.

4. Red materials, suitable for bags, being commonly on sale and in use, there can be no legal restriction upon their use by any person for any lawful purpose that suits his convenience. If the contrary were true, if it were in the power of the applicant to appropriate to his own use a red bag for peas, it would be equally in the power of the next man to appropriate a blue bag to the same merchandise, and the next a green bag, and so on. Who can say where the line must be drawn? Is there any reason why the trader who chooses should be prevented from adopting a white

bag to distinguish his goods if this door is once opened? Such a suggestion needs no answer. There can be no restriction on the use of white paper or white fabrics for any lawful purpose, and the Examiner can see no reason why this is not just as true of red cloth and red paper or of cloth or paper of any hue or shade commonly sold and used.

In the ordinary definitions given of a trade-mark the Examiner believes he finds one source of the confusion that exists upon this question in some minds, and at the same time additional reason for the position taken by the Courts. Upton opens his first chapter on the Law of Trade-Marks with this definition:

“A trade-mark is the name, symbol, figure, letter, form, or device adopted and used by a manufacturer, etc.”

The present British law, in its enumeration of the matter which must be contained in a trade-mark for registration, after certain other essentials, none of which involve color, says:

“(c) A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use.”

These may be regarded as fair examples of the languages used by writers in defining a technical trade-mark. If we consider carefully the terms employed—“name, symbol, mark, figure, word,” etc.—we find in none of them any ambiguity except in the single word “device,” which is employed by every writer. To persons unaccustomed to nice distinctions in the meaning of words this one, with its diversity of meanings, has often been misleading. 5. It has been defined, first, a contrivance, scheme, expedient, and the various synonyms of these words; second, artifice, stratagem, trick, and other words of like meaning; and, third, emblem, symbol, type, sign, etc. In the Patent Office it is constantly used to signify a mechanical contrivance. In common language elsewhere and in literature it signifies a trick, a stratagem, or an expedient for any purpose. This last interpretation, perhaps, is the principal source of confusion, since it leads many to imagine that any expedient they may fix upon to distinguish their goods may constitute a lawful trade-mark. Such is the “device” of putting them up in packages of particular shape or dimensions, which the decisions heretofore cited show to be unten-

able as trade-marks. Such, precisely, is the matter of the present application. It is a device in the sense that it is an expedient. As indicated by applicant in his written and oral statement, it is part of a system by which he attempts to distinguish his goods; but it is in no sense a device as the word is used in the British law and in the treatises on the subject. To determine accurately what this meaning is, it will not be amiss to notice how the word is used by writers upon a subject in some respects analogous, and upon which language has for centuries been used with remarkable precision—to wit, heraldry. When Scott, in *Marmion*, speaks of

Scotland's arms, device, and crest,
Embroidered round and round,

and elsewhere of the streamers:

Various in shape, *device*, and hue,

no close study is necessary to see that whatever specific meaning attaches to the word "device," it is something quite distinct from mere color. It is a design capable of representation by embroidery. So in *Boutell's Heraldry*, (*London*, 1864.), p. 15, where it is said—

"The shield * * * * has at almost all times been decorated with some *device* or figure."

The last words are used synonymously, and indicate a decorative design or symbol on the surface of the shield. Citations of this character might be multiplied indefinitely. Only one will be given. The author last named, in his work entitled "*English Heraldry*," p. 13, says:

"Among the earliest shields and banners of arms * * * many are found to be without any *device* whatever, their distinction consisting simply in some peculiarity of the coloring."

It would be difficult to express more clearly in language that a device and a mere peculiarity in color are two quite distinct things in the art of heraldry. It is not strange that the Americans, to whom heraldry is scarcely known, save as a relic of an institution

in which they have no concern, this specific meaning of the word should have been lost sight of; and, especially, that those to whom its use in the customary Patent Office sense is habitual, should fail to recognize its clearly-defined significance when unrelated to a mechanical structure; and yet we cannot conceal from ourselves that the emblematic language of this art is closely analogous to that of trade-marks. The symbols represented on a shield or escutcheon or panel indicated the person or family of their owner: and in the same way the marks impressed or in any way produced by a manufacturer upon his merchandise serve to identify them with their origin. So when trade-marks came to be treated of in statutes and in works of authors the language of arms afforded the readiest and, perhaps, the only terms that could be employed in their discussion. Hence the strict sense of the word "device;" and as in arms it might be a picture, a motto, or any of the curious blazonry of the art, but never a mere surface of solid color, so a device in the trade-mark sense may be almost anything in the range of fancy—a name, picture, monogram, quaint design of any sort, but never can consist in the mere application of color to the merchandise or the packages thereof. Such body-color may be the field on which the trade-mark is exhibited, as the knight's shield constituted the field on which his arms were emblazoned, and nothing more. A single stripe or bar of contrasting color imposed on such a body, a chevron, or any other mark or distinctive pattern, however simple, may form a sufficient trade-mark, since it constitutes a true "device."

The space the Examiner has given to this question indicates the importance he attaches to it. He has studied it more closely because, as before stated, there is no American decision in which it is discussed, except the Commissioner's in the *Red Oil Case*, and that, for reasons given, cannot now be regarded as authoritative.

To grant the registration asked would be, in his judgment, an abrupt departure from established precedents. With the possibility that by long use and identification in the minds of purchasers with his particular goods, the applicant may acquire rights of some sort analogous to those of trade-marks, in which, in the

interest of commerce, he might be sustained by the Courts, yet the Examiner can find no authority which, in his opinion, would justify him, in the present conditions, in admitting the matter presented to registration as a trade-mark.

The Examiner has very carefully and fully examined the questions raised in the appeal, and I am content to adopt his decision as my own. His action is affirmed.

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CIRCUIT COURT UNITED STATES, WESTERN
DISTRICT OF ARKANSAS. IN EQUITY.

LIGGETT & MYER TOBACCO COMPANY

vs.

HYNES.

DECIDED MAY, 1884.

REPORTED 20 FEDERAL REP., 883.

“Liggett & Myer's Star Tobacco” Case.

1. TRADE-MARK—INFRINGEMENT.—In a case where it is claimed that a trade-mark has been infringed, to constitute an infringement it is not necessary that the device complained of should be a *fac simile* of the device of complainants. There may be an infringement without exact similarity.
2. SAME—RESEMBLANCE.—Two trade-marks are substantially the same in legal contemplation, if the resemblance is such as to deceive an ordinary purchaser, giving such attention to the same as such a purchaser usually gives, and to cause him to purchase the one supposing it to be the other.

3. SAME—LIABILITY TO DECEIVE.—The resemblance need not be such as would deceive persons seeing the two trade-marks placed side by side, or as would deceive experts.
4. SAME—INTENTION TO DECEIVE.—There may be an infringement without a specific intent to deceive the public. If the effect of the device, when considered alone or in connection with the shape, size, character and appearance of the article upon which it is placed, is to deceive, the party adopting it must be held to have intended deception, as every man is held to have intended the necessary, natural and probable consequences of his own acts.

THIS is a bill in equity, brought here on account of citizenship of the respective parties, to perpetually restrain the defendant from using the mark attached to complainant's exhibit, "Robert S. Hynes' Plug Tobacco," on plug tobacco, complainants claiming to have an established right to the use of the mark of a "star" affixed to plugs of tobacco as a trade-mark, and complainant's mark is shown on complainants' exhibit, "Liggett & Myer's Plug Tobacco." Specimens or samples of both the complainants' and defendant's goods are produced in Court and offered in evidence; also wood engraving of the same in the brief of the complainant.

The star of the complainant was a simple six pointed star, while that of the defendant had curved indentations between the points and obtuse angles at the points, which were also six in number.

Paul Bakewell, for complainant.

Clendenning & Sandels, for defendant.

PARKER, J.:

The law is well settled that a party who has appropriated a particular trade-mark to distinguish his goods from other similar goods, has a right or property in it which entitles him to its exclusive use, and that this right is of such a nature that equity will protect it by injunction from innovation. *Hostetter v. Van Winkle*, 1 *Dill*, 329. The leading principle upon which the law of trade-mark is based, is that the honest, skillful, and industrious manufacturer, or enterprising merchant, who has produced or brought into the market an article of use or consumption that has

found favor with the people, and who, by affixing to it some name, mark, device, or symbol, which serves to distinguish it as his, and to distinguish it from all others, has furnished his individual guaranty and assurance of the quality and integrity of the manufacture, shall receive the first reward of his honesty, skill, industry, or enterprise, and shall in no manner and to no extent be deprived of the same by another, who to that end appropriates and applies to his production the same, or a colorable imitation of the same name, mark, device, or symbol, so that the public are or may be deceived or misled into the purchase of the productions of the one, supposing them to be those of the other. 6 *Wait, Act. & Def.*, 23, and authorities there cited.

The question to be considered in this case is, whether the conduct of the defendant amounts to an infringement of the plaintiff's trade-mark, or an injury to his legal or equitable rights. As was well remarked by the Kentucky Court of Appeals in the case of *Avery v. Mickle*: "The object of the trade-mark law is to prevent one person from selling his goods as those of another, to the injury of the latter and of the public." It grew out of the philosophy of the general rule that every man should so use his own property and rights as not to injure the property or rights of another, unless some priority of right or emergency exists to justify a necessarily different manner of use.

It is true, in this case, that the trade-mark upon the tobacco of defendant is not a *fac simile* of that upon the tobacco of the plaintiff. If it was, it would, of course be an infringement. They are not exactly similar. But to constitute an infringement exact similarity is not required; there may be an infringement without it. The Supreme Court of the United States in *Gorham Co. v. White*, 14 *Wall.*, 511, declares: "Two trade-marks are substantially the same in legal contemplation, if the resemblance is such as to deceive an ordinary purchaser,"—giving such attention to the same as such a purchaser usually gives, and to cause him to purchase the one supposing it to be the other. The same Court, in *McLean v. Fleming*, 96 *U. S.*, 255, says: "Where the similarity is sufficient to convey a false impression to the public mind, and is of a character to mislead and deceive the ordinary

purchaser in the exercise of ordinary care and caution in such matters, it is sufficient to give the injured party a right of redress." Nor need the resemblance be such as would deceive persons seeing the two trade-marks placed side by side, (*Manuf'g Co. v. Trainer*, 101 U. S., 64), or such as would deceive experts, persons, because of their peculiar knowledge from their being wholesale or retail dealers, or in any other way specially conversant with the trade-mark simulated. But the tradesman brings his privilege of using a particular trade-mark under the protection of equity if he proves, or it is apparent or manifest to the Court by inspection, that the representation employed bears such a resemblance to his as to be calculated to mislead the public generally, who are purchasers of the article, to make it pass with them for the one sold by him. If the *indicia* or signs used tend to that result, the party aggrieved will be entitled to an injunction.

This principle is sustained by the cases above referred to; by *Walton v. Crowley*, 3 *Blatchf.*, 440; 2 *Story Eq. Jur.*, 951; 2 *Kent Comm.*, 453; and a long and unbroken line of authorities, American and English.

The difference in the trade-marks of the plaintiff and defendant, in this case, would, perhaps, be at once detected by the intelligent user of tobacco, looking for his favorite brand, just as the man of luxurious tastes would discern his favorite brand of champagne. But the plaintiff is entitled to protection if the trade-mark of defendant would deceive the ordinary purchaser, purchasing as such persons ordinarily do. In this connection we must not lose sight of the character of the article, the use to which it is put, the kind of people who ask for it, and the manner in which they usually order it.

There is no proof in this case, coming from living witnesses, that the defendant adopted the trade-mark complained of with the specific intent of selling his tobacco as that of plaintiff, or that he expected to deceive the public. But if it is apparent to the Court from an inspection of the two articles, or the Court is able to see by such inspection, that plaintiff's trade-mark is so simulated as probably to deceive customers or patrons of his trade or business, there is a good ground for the Court to enjoin. *Filley v. Fassett*,

44 *Mo.*, 178. If the effect of the simulated trade-mark is to deceive the public into the belief that the article upon which it is placed is the article of some other manufacturer, then it is a deception, whether it was the actual intention of the person using the simulated trade-mark to deceive or not, as the principle of law applies that persons are held to have intended the necessary, natural, and probable consequences of their acts.

In looking at the trade-mark to see whether it is so far an imitation of another as to deceive ordinary customers exercising ordinary care when purchasing, we must not look at the device alone, but we must also examine the article upon which it is placed, and if there is a resemblance in it to another article bearing the trade-mark that is claimed to have been infringed, and if this resemblance when blended with the appearance of the device, has a tendency to deceive the ordinary public into the belief that they are buying the other article, then the very nature of the article becomes potential evidence in the case to show a purpose to deceive.

In this case, if the device of defendant was upon a plug of tobacco different in shape from that of complainant, the chance of deception would be so slight that no Court could find from the appearance of the two designs, that the ordinary public would be deceived. Now, while there is no trade-mark in the shape of the plugs of tobacco of the complainant, and consequently the defendant could make his plugs in any shape he pleases, without being guilty of an infringement, yet when he makes his plugs in such a way as to give them the general appearance of complainants', and puts on them a device of such a character, and of such shape and appearance, as that the customer generally, when he sees the shape and appearance of the plug, and the device on it, will be deceived into the belief that it is complainants' tobacco that he is buying, there is a state of case presented by blending the size, nature, structure, and appearance of the plug with the device which would not exist if we viewed either the plug of tobacco or the device separately.

Taking this as the true rule, and applying it in this case, I am forced to the conclusion that the ordinary mass of purchasers

would be deceived, after paying ordinary attention when purchasing, into the belief that they were buying the tobacco of complainant, when in fact they were getting the tobacco of the defendant. Ordinary care, in this connection, means the care that men ordinarily exercise when buying chewing tobacco.

Entertaining this view of the case, I think complainant is entitled to an injunction enjoining defendant from using the device adopted by him; and it will be so ordered.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

ATLANTIC MILLING COMPANY

vs.

ROBINSON, AND OTHERS.

DECIDED 6 MAY, 1884.

REPORTED 20 FEDERAL REP., 217.

“Champion Flour” Case.

1. TRADE-MARK—RIGHT TO THE SYMBOL INSEPARABLE FROM RIGHT TO SELL COMMODITY.—The right to the exclusive use of a word or symbol as a trade-mark, is inseparable from the right to make and sell the commodity which it has been appropriated to designate.
2. SAME—MAY BE PECULIAR TO A FACTORY AND PASS WITH IT.—A trade-mark may be appropriated by a manufacturing company as well as an individual, and pass with the property to their successors.
3. SAME—MEASURE OF DAMAGES.—The measure of damages is limited by the extent to which the unlawful use of the design by the defendant, has interfered with the sale of plaintiff's commodity.

Briessen & Steele, for complainants. *A. V. Briessen*, of counsel.

L. H. Arnold, Jr., for defendant Robinson.

Geo. H. Forster, for defendant Rowland.

WALLACE, J.:

The proof shows that in 1861, the firm of Alexander H. Smith & Co., then the proprietor of the Atlantic Mills, at St. Louis, Missouri, adopted the word "Champion," and employed it to distinguish a particular quality of flour made and sold by them. From that time until the present it has been used as a trade-mark, either by that firm or the several firms and corporations that became the proprietors of the property and business of the Atlantic Mills. The flour to which it was applied was particularly adapted for the southern export trade, and became generally known and recognized as the production of the Atlantic Mills by the word which was thus used to designate it.

The complainant has not made proof of any formal transfer by Alexander H. Smith & Co. to any of the succeeding proprietors of the Atlantic Mills, of the right to use the trade-mark; and complainant has acquired that right it is because it passed upon the purchase of the mill property and business as an accessory thereof, to each purchaser who became the proprietor of the premises, including the complainant, without any agreement respecting the trade-mark.

1. The right to the exclusive use of a word or symbol as a trade-mark, is inseparable from the right to make and sell the commodity which it has been appropriated to designate as the production or article of the proprietor. It may be abandoned if the business of the proprietor is abandoned. It may become identified with the place or establishment where the article is manufactured or sold, to which it has been applied, so as to designate and characterize the article as the production of that place or establishment, rather than of the proprietor. A trade-mark of this description is of no value to the original proprietor, because he could not use it without deception, and therefore would not be protected in its exclusive enjoyment. Such a trade-mark would seem to be an incident to the business of the place or establishment to which it owes its origin, and without which it can have no independent existence.

2. It should be deemed to pass with a transfer of the business, because such an implication is consistent with the character of the

transaction and the presumable intention of the parties. *Dixon Crucible Co. v. Guggenheim*, 3 *Amer. Law T.*, 228; *Hudson v. Osborne*, 39 *L. J. Ch. (N. S.)*, 79; *Shipwright v. Clements*, 19 *Weekly Rep.*, 599.

The defendant controverts the right of the complainant to the exclusive use of the word "Champion" as a trade-mark, by the testimony of two witnesses, to the effect that they used it or saw it used as a brand upon flour before it was adopted by Alexander H. Smith & Co. The testimony of the witness Potter fails to show the use of the word, in the instances to which he refers, prior to 1867, and is therefore valueless. The witness Reamey testifies that he used it for branding the flour of nine different firms, as long ago as 1857. None of the persons for whom it was so used have been produced, although many of them were accessible. If Reamey's statement is correct, it could have been readily corroborated. The failure to do so is significant. His statement is not supported by any extrinsic evidence, and is not deemed sufficiently reliable to defeat the complainant's right.

3. Upon the accounting to ascertain damages, the fact is not to be overlooked that, in the instances in which the trade-mark has been used by the defendants in connection with the names of other manufacturers than the complainant's, damages are measured by the extent to which the unlawful use of the word "Champion" has interfered with the sale of their flour. Their right to an injunction is not affected, because the appropriation of their trade-mark has been a limited one, and it is not incumbent on them to show that it has been copied in every particular. It is sufficient if his trade-mark has been copied to an extent calculated to mislead purchasers, and cause the article to which it has been applied to pass as their article. The cases *Gillott v. Esterbrook*, 48 *N. Y.*, 374; *Newman v. Alword*, 51 *N. Y.*, 189; *Hier v. Abrahams*, 82 *N. Y.*, 519, and *Walton v. Crowley*, 3 *Blatch.*

A decree is ordered for complainant.

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IN THE UNITED STATES PATENT OFFICE.

EX PARTE LYON, DUPUY & CO.

DECIDED 1 JULY, 1884.

REPORTED 28 O. G., 191.

“Triumphant Flour” Case.

1. No applicant may register a trade-mark unless he can establish, first, that he has the right to use it, and no one else has; second, that it is not identical with the registered or known trade-mark of another person, and beyond this he must show that he is using the trade-mark which he so owns, in commerce with foreign nations or Indian tribes.
2. The statute does provide that the trade-mark sought to be registered shall be used in foreign commerce, but it does not in terms provide, nor in fair intendment convey the idea, that a party may acquire the right to use somebody else's trade-mark, merely by using it in such trade.
3. Where the records of this Office disclose that certain parties registered a trade-mark under the law of 1870, that such trade-mark was their property, that they had been using it in this country for ten years next preceding the date of their application for registration, and there is no evidence that they have ever abandoned such trade-mark, HELD:

That section 3, of the Act of 1881, and the spirit of the whole statute, authorize the Patent Office to take notice of the facts recited in said records, in determining “the presumptive lawfulness of claims to the alleged trade-mark” by subsequent applicants for registration, and the Examiner was justified in rejecting the application for registration on the facts disclosed in said record.

APPEAL from the Examiner of Trade-Marks.

TRADE-MARK for Wheaten Flour, "TRIUMPHANT."

APPLICATION filed December 21, 1883.

Mr. R. H. Eddy and Messrs. Voorhees & Singleton for the applicants.

DYRENFORTH, *Acting Commissioner*;

The applicants seek to register as a trade-mark for wheat flour the word "Triumphant." The Examiner refuses registration upon the ground that the mark too nearly resembles the trade-mark of Imbs, Meyer & Co., (the word "Triumphant" appropriated to flour), their certificate being No. 3,472, and dated February 29, 1876, in the application for which it is stated that the trade-mark had been "used ten years last past."

The applicants do not deny the near resemblance of their trade-mark to the trade-mark registered by Imbs, Meyer & Co., that it so nearly resembles a mark appropriated to the same class of goods that one might be mistaken for the other, but contend, it is understood, that the citation is not proper, in that Imbs, Meyer & Co., having registered under the law of 1870, since held unconstitutional, and not having renewed their registration under the present law, there is no competent evidence that the word is still used as a trade-mark, the certificate and record under the old law not being competent evidence of ownership. The question is clearly raised on this appeal, whether the Examiner may properly reject an application for registration of a trade-mark on reference to a prior registration of the same thing by another party, made under the Act of Congress approved in 1870, subsequently and recently declared to be unconstitutional. In other words, is the registration made under the Act of 1870, which is on the file in the Patent Office, and which was made in conformity to the law as it then stood, evidence of anything? If so, of what? The question is worthy of careful consideration, as it is arising constantly, and a precedent must be established.

The Act of Congress, approved March 3, 1881, (passed to cure the defects in the Act of 1870), which provides for the registration of trade-marks, is very carefully worded, and, in my judgment, was so worded with direct reference to preventing the practice of fraud upon those who had, under a prior law, and in accordance with the terms thereof, registered their trade-marks, and also protect the public against imposition. No one adopts the trade-mark of another, or a trade-mark which is similar in appearance to that of another, except for the purpose of deriving benefit therefrom. The benefit hoped for results from the reputation of the trade-mark. If it has not been in use except for a very short period, it is substantially worthless, since one device or symbol, when first appropriated, is about as good as another, the value of a trade-mark depending upon the superior quality of the article of commerce to which it is attached, or its desirability to the public, since it becomes indicative, after a long use, of that peculiar quality, and the article in the market becomes known and designated by that particular trade-mark. If the trade-mark is valuable, it is because of its use in connection with an article of peculiar quality. If it has been used in connection with an article of commerce which is of inferior quality or undesirable, the trade-mark is not only worthless, but it is palpable that its use would be absolutely injurious. So it follows as a corollary that where an applicant has adopted as his own and seeks to register a trade-mark which is the *fac simile* of that used by another, attached to the same class of merchandise, he does it, if knowingly, to avail himself of the property and rights of that of another person or firm, and with the intent "to deceive purchasers," and this is precisely what the law seeks to prevent.

The question here raised is, what shall be regarded as sufficient evidence that an applicant is not entitled to the trade-mark he seeks to register. It is understood that the applicants in this case admit that their trade-mark is substantially the same as that registered in 1876 by Imbs, Meyer & Co., which is cited as a reference; but make the point that, inasmuch as the registration was not authorized by law, therefore it cannot be accepted by this Office as evidence of the existence of such trade-

mark, nor of prior use or ownership by others, nor, in fact, of anything which could tend to defeat the registration of the trade-mark they present. Now, let me examine the case at bar in the light of what I regard as the obvious intent and meaning of this statute. The application under consideration is in proper form, and, in the absence of any showing against it, entitles applicants to registration of the trade-mark as prayed. They are, however, met by a reference, which, if at all competent as evidence, raises a presumption that applicants' declaration that "no other person, firm, or corporation has a right to such use, (use of the trade-mark), either in the identical form or in such near resemblance, thereto as might be calculated to deceive" the public, is erroneous; and, further, the reference cited, if considered as evidence, negatives the allegation in the pending application that the trade-mark sought to be registered is not—

"Identical with a * * * *known* trade-mark owned by another and appropriate to the same class of merchandise, or which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers."

If the reference is competent as evidence tending to establish the facts disclosed therein, clearly the applicants must be required to meet it by additional evidence to sustain the declaration contained in their application be refused. Applicants do not offer to meet the reference cited; do not intimate in reply to it that Imbs, Meyer & Co., have abandoned their trade-mark, or that they (the applicants) have in a lawful way, in view of any previous right of Imbs, Meyer & Co., acquired the right to use it now. Their answer to the reference is that the Act of Congress, under the provisions of which Imbs, Meyer & Co., registered that trade-mark, was, by the Supreme Court, held to be unconstitutional, and therefore the registration was *nil in law*, and the Commissioner of Patents is not authorized to regard the record of registration at all for any purpose whatever; that to all intents and purposes the applicants are in the same position, so far as the Office can take notice, as if Imbs, Meyer & Co., had never registered or attempted to register the trade-mark in controversy, and the

Office had in no wise received any intimation whatever of the fact that they owned, or claimed to own, a property right therein. Is that position based on reason or authority? I am satisfied that it does not rest on sound reason, and hence, I think, not upon authority.

"A trade-mark becomes the exclusive property of one only when he has, prior to any one else, appropriated and used it to indicate the origin, ownership, and quality of an article to which it is attached. Its value rests on reputation and on its implied guaranty that the article is of a certain quality. Its object is to prevent one person from selling his goods as those of another of established reputation, to the injury of that other." See *Avery & Sons v. Meikle & Co.*, 27 O. G., 1027.

If the trade-mark in question, or one substantially the same, has been for many years in use by Imbs, Meyer & Co., on the same character of merchandise, (flour), in connection with which applicants propose to use and do use it, one thing is clear, and that is that the trade-mark is of value, for no firm will use a trade-mark which has a bad reputation, as such would *destroy* the trade instead of *building* it up. If it is valuable, it may be assumed that value results from the fact that Imbs, Meyer & Co., have used it in connection with flour of superior quality. It follows that if applicants use that identical trade-mark, or one substantially identical with it, the result must be to "cause confusion or mistake in the mind of the public or to deceive purchasers." In that case the law requires that registration should be denied.

1. But it might be urged that the use and ownership mentioned in the Statute have reference only to the *right to use that particular trade-mark in commerce with the Indian tribes and foreign nations*, and that no other character or quality of title or ownership or use can be considered. That view, in my judgment, were but a thin disguise and subterfuge under the protection of which one party would be seeking to appropriate property that does not belong to him, and by the same token to practice a fraud on the public. The statute does not say in words, nor does it by fair intendment convey the idea, that a party may appropriate and have registered as his own the old and well-established trade-mark

of his neighbor by proving that he has sent a few (one or more) packages of goods with the trade-mark attached to the Indian tribes, or one or more to some foreign nation, and thereupon predicate a perfect right to register that trade-mark, thus clouding his neighbor's title to his property, if not in fact robbing him of it altogether.

2. The statute does not provide that the trade-mark sought to be registered shall be used in foreign commerce or with the Indian tribes; but it does *not* provide that a party may acquire the right to register somebody else's trade-mark, and so secure *prima facie* evidence of ownership, simply by using it in such trade. The statute provides that a trade-mark sought to be registered shall not be identical with a registered or *known trade-mark* owned by another, etc. It also provides that applicant shall state under oath that he has the right to use such trade-mark, and that no other person, firm, or corporation has the right to such use, either in the identical form, or in any such near resemblance thereto as might be calculated to deceive. In my judgment, it is clearly wrong, in view of the effect which would result, to read the statute as if the words "in commerce with foreign nations or Indian tribes" were interpolated after the word "registered," and after the word "deceive" in the second section, and after the word "merchandise" and after the word "purchaser" in the third section. Such construction could not have been intended by Congress.

1. On the contrary, no applicant may register a trade-mark unless he can establish, *first*, that he has the right to use it, and no one else has; *second*, that it is not identical with the registered or *known* trade-mark of another person; and *beyond* this he must show that he is using the trade-mark which he owns in commerce with foreign nations or Indian tribes. The ownership does not give the United States jurisdiction. It is the use in commerce with foreign nations or Indian tribes that confers it. But the statute makes not merely the use but also the exclusive ownership a prerequisite to registration. To give the Statute the construction contended for is to use the law not to prevent fraud and imposition, but to shield and protect both. The proposition

that an owner of a trade-mark may assert his common law right, notwithstanding registration by another, is not of importance in determining the question here presented: It is a novel suggestion that the statute of the United States authorizes one party to appropriate the property of another unless the common law can afford a remedy to prevent it, which the Court will utilize to that end.

In passing upon the sufficiency of the reference I endeavor to act upon principles of common sense. The registration of Imbs, Meyer & Co., was complete under the law of 1870, and established not only the title to the trade-mark in controversy, but that they had been using it for ten years. There is no pretence that that record does not disclose the exact truth. The point made is that the law under which that solemn act took place and the record of it was made up was unconstitutional, and, *ergo*, I must shut my eyes to what that record discloses. But the statute says that applicant shall not be entitled to registration of a trade-mark which is identical, or substantially identical with the registered or *known trade-mark* of another. This record discloses to me that applicants are seeking to register substantially the *known trade-mark* of another—to wit: that of Imbs, Meyer & Co. It is true that these parties may have abandoned their trade-mark, but abandonment is not to be presumed. If it had become worthless, no other person would have sought to appropriate it, or that which is substantially identical with it.

It is said that to act upon the record of registration made under the law of 1870 would be, in effect, the same as citing a rejected application for a patent. This is error. If there is any similarity, it is more like citing a patent itself, and the full record of public use. To decide otherwise would be to open Pandora's box and turn loose fraud upon individuals and imposition upon the public. On the other hand, the construction I give the statute cannot work any hardship. Certainly it is no injustice to an applicant to require him fairly to establish that he is the owner of the property he seeks to appropriate as his own. If a former registrant has abandoned his property, it is easy to ascertain and prove the fact. If applicants have by purchase or otherwise legally

acquired the right to the property, it could not be difficult to establish that fact.

It is contended that the registration of a trade-mark confers no title thereto. Neither does the registration of a deed to land confer title. But the certified transcript of the record is evidence of title, and the statute permits registration of a trade-mark as a means of preserving in a public record evidence of ownership, and since it is evidence of ownership care has been taken in the statute to provide against fraudulent registration.

It is said that I am giving the registration under the law of 1870 the same force and effect as if it had been made under the statute of 1881. This is palpable error. I find here in this Office a public record—public in the sense that it is open and notorious, and may be seen and read by all men—in which is recorded a *fac simile* of trade-marks, with a full statement of ownership, and period of use, etc., all under the sanction of an oath. This public record discloses that Imbs, Meyer & Co., in 1876, registered a trade-mark, proved that it was their property; that they were using it attached to flour; that they had been so using it for ten years next preceding the date of their application for registration. Now, I do not hold that that registration has the force and effect of a registration made under the present law. Nothing of the kind.

3. But I do hold that I am properly authorized under the provision of section 3 of the Act of 1881, and by the true spirit and intent of the whole statute, which is to prevent and not to connive at fraud and imposition, to take notice of the facts recited in that record, in determining “the presumptive lawfulness of the claim to the alleged trade-mark” by the applicants. I hold, therefore, that the Examiner was clearly justified in rejecting applicant’s petition of registration on the reference of Imbs, Meyer & Co., which disclosed that they were and had been for many years using that identical trade-mark, or one substantially the same, on flour; that they had been so using it for a long time before the applicant’s claim to have known of it or sought to use it.

The decision of the Examiner is approved and affirmed.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

ESTES, AND OTHERS,

vs.

WILLIAMS, AND OTHERS.

DECIDED 31 JULY, 1884.

REPORTED 21 FEDERAL REP., 189.

“*Chatterbox*” Case.

COPYRIGHT—FOREIGN PUBLISHER—AMERICAN ASSIGNEE—
USE OF A NAME—RIGHT OF ACTION.

The publisher of “Chatterbox” in England, having assigned the exclusive right to use and protect that name in this country, the assignee may maintain his action against any other person who undertakes to publish books under that name in the United States.

J. L. S. Roberts, for orators.

Walter M. Rosebault and *Roger Foster*, for defendants.

WHEELER, J.:

Mr. James Johnston, of London, England, appears to have published a regular series of juvenile books of uniform appearance,

and in a style of peculiar attractiveness, and called them the Chat-terbox, until they have become widely known and quite popular by that name, in that country and this. He assigned the exclusive right to use and protect that name in this country to the orators for 10 years from January 1, 1880. The defendants have since that time commenced the publication of a series of books, and called them by that name, and made them so similar in appearance and style to those of Johnston as to lead purchasers to think they are the same. As a matter of fact it is found that they intended to make the books appear to be the same, and to avail themselves of the popularity which the books had attained by the labor and skill bestowed upon them by and at the expense of Johnston. There being no copyright to prevent, the defendants claim the right to so print and publish the series of books in this country, and that if they have not the right, the orators have no right to prevent them. There is no question but that the defendants have the right to reprint the compositions and illustrations contained in these books, including the titles of the several pieces and pictures. *Jollie v. Jaques*, 1 *Blatchf.*, 618. That does not settle the question as to the right claimed here. There is work in these publications aside from the ideas and conceptions. Johnston was not the writer of the articles nor the designer of the pictures composing the books, but he brought them out in this form. The name indicates this work. The defendant, by putting this name to their work in bringing out the same style of book, indicate that their work is his. This renders his work less remunerative, and while continued is a continuing injury which it is the peculiar province of a Court of Equity to prevent. These principles are discussed, settled, and applied in *McLean v. Fleming*, 96 *U. S.*; 245.

It has been argued that there have been various publications from earlier times by the same name, so that no new right to the use of that name could be acquired. This would be true, doubtless, as to all such publications as those to which the name was applied, but not as to those essentially different. The fact of these other publications bears only upon the question of fact as to whether Johnston's work had come to be known by this name,

and the defendants by using the name represent that their work is the same. The conclusion stated as to the fact has been reached after consideration of what is shown as to these other publications.

Johnston had the exclusive right to put his own work, as his own, upon the markets of the world. No one else had the right to represent that other work was his. Not the right to prevent the copying of his, and putting the work upon the markets, but the right to be free from untrue representations that this other work was his when put upon the markets. This gives him nothing but the fair enjoyment of the just reputation of his own work, which fully belongs to him. It deprives others of nothing that belongs to them.

The question then arises whether Johnston could transfer his right, or any part of it, to the orators, so that the defendants, in what they have done and are about to do, trespass upon the orator's rights, and not upon Johnston's. He could not do all this himself; he must act by and through others. No reason is apparent why he could not give them the exclusive right to put his work on the market as his, as he had that right. This seems to be what he undertook to do. They had that right, and the profits of its enjoyment would belong to them. The defendants would deprive them, and not Johnston, of the profits. The injury would be to them and not to him, and they are, in this view, entitled to the remedy.

It is objected that they also trespassed upon Johnston's rights before they acquired them. This may be true, and, if so, they may be liable for the damages. Such a trespass would not prevent them from acquiring a lawful right in a lawful manner. Had such trespasses been so frequent and long-continued that the work had come to be known to be the work of others, or had lost identification as the work of Johnston, the course of the defendants might not amount to any representations that their work was his; but the evidence does not show this, as the case is now understood the orators appear to be entitled to relief.

Let there be a decree for an injunction and an account.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

LUYETIES, AND OTHERS,*vs.*HOLLENDER, AND OTHERS.

DECIDED 9 AUGUST, 1884.

REPORTED 21 FEDERAL REP., 281.

1. The rights and remedies concerning trade-marks generally depend upon the laws of the States, common or statutory, and not upon the laws of the United States.
2. Laws of the United States now in force, relate only to trade-marks specially used in connection with foreign nations or with Indian tribes.
3. Courts of United States have not jurisdiction between citizens of same State, unless the trade-mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe.

Samuel T. Smith, for orators.*Louis C. Raegener*, for defendants.

WHEELER, J.:

1. Rights and remedies pertaining to trade-marks generally depend upon the laws of the State, common and statutory, and not upon the laws of the United States. *Trade-Mark Cases*, 100 U. S., 82.

2. The laws of the United States now in force, under which this trade-mark was registered, relate only to trade-marks specially used in commerce with foreign nations, or with the Indian tribes. Act of March 3, 1881, (21 *St. at Large*, ch. 137, sec. 1).

3. They are particularly restricted so as not to give cognizance to any Court of the United States in an action or suit between citizens of the same State, unless the trade-mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe. *Id.*, sec. 11. The goods on which the trade-mark in question is used are not intended to be transported to any foreign country, nor for any Indian tribe, but are mineral waters sold for consumption in the City of New York; and the parties are all citizens of the State of New York.

As this case is now presented, the orators are not entitled to maintain it in this Court, and this motion for a preliminary injunction must be denied.

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UNITED STATES CIRCUIT COURT, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

GOODYEAR RUBBER COMPANY

vs.

GOODYEAR'S RUBBER MANUFACTURING CO., ET AL.

DECIDED 15 AUGUST, 1884.

REPORTED 30 O. G., 97.

“Goodyear Rubber Co.” Case.

1. TRADE NAME—RIGHT OF CORPORATION TO ACQUIRE—INFRINGEMENT BY ANOTHER CORPORATION.—A corporation may acquire a property right to the use of a name other than its original corporate name as a trade-mark, or as incidental to the good will of a business, as well as an individual; and when it has acquired such a right, it cannot be deprived thereof by the assumption of such name subsequently by another corporation, whether the latter selects its name by the act of incorporators who organize under the general laws of the State, or the name is selected for it in a special Act by a legislative body.
2. SAME—PRIORITY—EVIDENCE—INJUNCTION—“GOODYEAR RUBBER COMPANY”—“GOODYEAR'S RUBBER MANUFACTURING COMPANY.”—Upon examination of the evidence in case at bar, HELD:

141 Goodyear Rubber Co. *vs.* Goodyear's Rubber Mfg. Co.

That the "Goodyear Rubber Company" was entitled to an injunction restraining the defendant from using the name "Goodyear's Rubber Manufacturing Company."

Mr. W. W. MacFarland, for the complainant.

Mr. F. H. Betts and *Mr. Stephen P. Kellogg*, for the defendants.

WALLACE, J..

The complainant is a corporation organized under the laws of New York, in 1872, by its present corporate name. The defendant is a corporation organized under the laws of Connecticut, in 1847, by its present corporate name. Each corporation seeks to enjoin the other, the complainant by bill and the defendant by cross-bill, from using the name "Goodyear's Rubber Mfg. Co." Both parties concede this name to be practically identical with complainant's name. The parties are competitors in the manufacture and sale of rubber goods, and have their principal places of business in the City of New York. Each insists that it has acquired the right to the use of the name in dispute, and that such name has become a valuable adjunct of its business, and each insists that the other has endeavored, and is now attempting, by a wrongful use and appropriation of the name, to divert the custom of the other. As each party concedes that the right to use the name for the purposes of its business is a valuable property right, and asserts that such use by the other is vexatious, embarrassing, and necessarily tends to pecuniary injury, the controversy manifestly resolves itself mainly into a question of title to the name. It is incumbent upon one of the parties to establish a lawful right to use the name as against the other, and the party which does this will be entitled to the relief prayed for.

1. The name of a corporation has been said to be the "knot of its combination," without which it cannot perform its corporate functions. (*Smith, Merc. Law*, 133). It has neither the right nor the power to change the corporate name originally selected without recourse to such formal proceedings for the purpose as may be authorized by the laws under which it has been incorporated, or by the consent of the authority from which its charter is

derived. Nevertheless, it may become known by another name by usage, and the Courts have frequently treated acts done and contracts entered into by corporations under another name as though done or entered into by it with the true name. *Minot v. Curtis*, 7 Mass., 441; *South School Dist. v. Blakeslee*, 13 Conn., 227; *Eastham v. Blackburn Ry. Co.*, 23 Law J. Exch. N. S., 199; *Boisegerard v. N. Y. Banking Co.*, 2 Sandf. Ch., 23. There is no reason why a corporation may not acquire a property right to the use of another name as a trade-mark, or as incidental to the good-will of a business, as well as an individual, and if it has acquired such a right it will of course be protected in its enjoyment to the same extent as an individual would be. It cannot be deprived of the right by the assumption of the name subsequently by another corporation, and it is immaterial whether the latter selects its name by the act of incorporators who organize under the general laws of a State, or whether the name is selected for it in a special Act by the legislative body. Manifestly, if the defendant had no right to use the name by which the complainant was incorporated, or one practically identical with it, at the time of the latter's incorporation, the title of the complainant is clear, because it adopted the name formally, publicly, and legitimately for all its corporate purposes. The defendant insists that it had acquired a prior right to the use of the name; that this right took its origin as early as 1862, and by a gradual process of development had ripened into a good title before complainant was incorporated.

Neither party makes any claim of exclusive right to use the word "Goodyear" alone, that word having become a generic term of description applied to a large class of India-rubber fabrics before either party became a corporation, or to the word "Goodyear" in combination with "Rubber." There were trading concerns, called the "Goodyear Metallic Shoe Co." The "Goodyear Rubber Works," and the "Goodyear Rubber Emporium" before either party claimed the right to the name in controversy.

The defendant's theory, as sustained by the proofs, is that, beginning in 1862, when it ceased to confine itself to the manufacture of gloves, and engaged in manufacturing and selling rubber

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goods generally, its customers occasionally addressed it in their correspondence by various abbreviated names, such as "Goodyear's Rubber Mfg. Co.," "Goodyear Rubber Co.," "Goodyear's Co.," "Goodyear's I. R. Company," "Goodyear Company," and other abbreviations; that the use of such abbreviated addresses by its customers gradually increased, so that in 1871 the defendant received nearly two hundred letters addressed to the "Goodyear Rubber Company," and nearly one hundred to the "Goodyear Rubber Mfg. Co." On the other hand, the proofs show that during this time the defendant received many thousands of letters yearly; that the letters addressed to it by other names were comparatively a small number, averaging not over five hundred a year, but embraced upwards of seventy varieties of names, and that its correct corporate name was usually adopted by its correspondents and patrons.

It is not claimed that the officers or agents of the defendant were accustomed during any part of this period to use any other than its corporate name, or assumed the right to do so until after the complainant commenced business. To the contrary, they were solicitous and painstaking to correct the tendency of its customers to address it by any other than its corporate name; and it was their practice to send envelopes to customers with its correct name printed upon them, to prevent the occurrence of such mistakes. Concisely stated, the question would seem to be, whether the defendant can appropriate to itself the various misnomers applied to it by the carelessness or inaccuracy of a comparatively small number of its customers during a period of ten or eleven years, notwithstanding the zealous and active measures of its managers to repress the practice, and their success in preventing it from ripening into a general usage.

It would hardly be contended that an individual could found a claim of possessory right to any species of property upon the unauthorized conduct of other persons, or maintain that he had adopted a name symbolizing his products or identifying his personality with his business by protesting against its use, and of course a corporation does not occupy a different position. The proof shows that there was no general recognition of the defend-

ant among its customers by any other than its corporate name, and no adoption by the defendant of a different name, and it must be held that the occasional or persistent use of the misnomer by a few of the defendant's customers, gave no privilege to the defendant to a monopoly in the use of the name.

If the proofs warranted the inference that the complainant assumed a name by which the defendant was known for the fraudulent purpose of deceiving the public and supplanting the defendant in the good-will of its business, the Court would not only refuse to assist the complainant, but would intervene to protect the defendant. A careful reading of the proofs do not disclose the existence of any such design, or of any intention to adopt a name with which the defendant had already become appreciably identified. The case is destitute of evidence to indicate that the complainant's corporators were aware or had reason to suppose that the defendant had become known to any extent by any other name than its corporate name. So far as appears, they had no knowledge that defendant's customers ever addressed it by other names. Nor is there anything in the proofs to justify the insinuation that the complainant was organized for the purpose of annoying the defendant by illegitimate competition. It does appear that the persons who organized the complainant had been the managers and agents of another corporation, the Rubber Clothing Company, which for many years had been a competitor of the defendant at the City of New York; that propositions for a consolidation of this company with the defendant had been somewhat discussed between their respective managers without result, and that shortly afterward the complainant was organized. For a time its affairs were transacted at the office of the Rubber Clothing Company, and the two concerns maintained very intimate relations, as might be expected from the circumstance that the managers were the same persons in both. But the salient facts that the new corporation started with a cash capital of five hundred thousand dollars and engaged in new branches of trade, while the old company continued in business, sufficiently refute any theory that complainant was not a *bona fide* concern. If it should be conceded that the two concerns were practically one,

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and that the main object of the complainant's organization was to enable the Rubber Clothing Company to assume a new name—one which would represent a corporation dealing in rubber articles generally, instead of in clothing only—there would be no occasion for censure, because the new name was better adapted to describe the business of the corporation. The Rubber Clothing Company had long ceased to manufacture and sell clothing only, and had become engaged in selling rubber goods generally. It was undoubtedly intended by those who organized the new concern to engage in the general rubber trade upon a more extensive scale than that of the old company. The name selected was an appropriate one, and those who adopted it had a perfect right to do so, provided they did not know or have reason to believe that by doing so they would interfere with the business of the defendant. The fact seems to be that both the Rubber Clothing Company and the defendant were doing business under names that were somewhat misleading to such persons as had not learned, by business intercourse with them, that they were manufacturers and dealers in rubber goods generally. It would have been entirely proper for either of them to adopt a new name. The complainant adopted a new name first, and if it was only the Rubber Clothing Company with a new name, the defendant had no right to complain so long as the name did not serve to engender unfair competition and deceive the trade. As has been said, however, it was a new concern with a large capital, and contemplating enlarged business operations, and the proofs do not show that its incorporators were moved to select its name by any illicit motive toward the defendant. If the name selected was one calculated, by its similarity to defendant's name, to lead to confusion of business, and to confounding the identity of the two corporations, it might well be urged that those who adopted it should abide by the consequences, although they were innocent in their intentions, and not ask a Court of Equity to protect them against the inconveniences which might follow. But the defendant, not content that the consequences shall rest where they fall, insists upon the exclusive right to use the name, and since the complainant assumed it, has issued notices and circulars to the trade, and

put up a sign calling itself by the complainant's name. Upon the same theory it can also claim the exclusive right to use the multitude of misnomers applied to it from time to time by its careless customers. It has a distinctive name of its own, which it formally adopted, and which has been carefully preserved by its agents until the complainant selected one. It ought not to complain now, because the latter was the first to avail itself of the choice of selection out of all unappropriated names. Certainly, it cannot be permitted to appropriate the complainant's name or one substantially identical, and by asserting itself as the Goodyear Rubber Company, mislead the public to the detriment of the complainant.

A decree is ordered for complainant, and the cross-bill of the defendant is dismissed.

U. S. CIRCUIT COURT—SOUTHERN DISTRICT OF NEW YORK.

Goodyear Rubber Company v. Goodyear India Rubber Glove Manufacturing Company and Goodyear's Rubber Manufacturing Company.

ON MOTION for rehearing and to resettle decree, before Hon. WILLIAM J. WALLACE, Circuit Judge, after argument of counsel, on motion—

Judge Wallace: There is no ground for the motion for rehearing. The use of the name "Goodyear Manufacturing Company," in Boston does not seem material. The injunction in this case is based on interference in trade. If the plaintiff and defendant had been in different cities, there might have been no interference. It is the proximity of one store to the other, and the tendency of the defendants' acts to divert the plaintiff's custom that makes the trouble.

Mr. Betts: The defendant is not to blame for that. The plaintiff followed our location and established its store near us. I

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wish I could be able to satisfy your Honor of what I know to be the fact that this trouble and confusion has been altogether caused by the plaintiff's action.

Judge Wallace: I only know what I find on record in this case, and I have read that very carefully. Now, Mr. McFarland, there are two points in regard to the form of decree. I think the first decree was wrong in charging the costs upon the dismissal of the cross-bill. The costs ought to be made general costs in the case. Then there is the form of injunction to be considered.

Mr. Betts: I hope your Honor will expressly limit the decree to the two names "Goodyear Rubber Co." and "Goodyear Rubber Manufacturing Company." Any abbreviations of those names is too general, and it enables Mr. McFarland to contend that you intend to enjoin such names as "Goodyear Rubber Company," or "Rubber Company," or "Goodyear's Manufacturing Company." Those are all abbreviations which I do not understand to be the case; but the decree is being used so in other litigations. I hope your Honor will express this clearly in the decree.

Judge Wallace: I think my opinion is sufficiently clear on this point. I do not think it necessary to put it in the decree. I certainly did not intend to enjoin "Goodyear Company" any more than "Rubber Company." That is not the abbreviation meant.

Mr. Betts: Well, it is being used so, and, as this opinion of your Honor's and decree will be used in different Circuits, because these rubber companies have their business all over—even in California—and other suits may be brought against agents in other States, it ought to be clear.

Judge Wallace: The plaintiff cannot contend that it has a right to "Goodyear Company." Mr. McFarland, do you claim you have a right to that name?

Mr. McFarland: I hope your Honor will not go into that matter, and will leave the decree as it is. That matter is before other Courts. If your Honor should consider the matter of changing the decree at that point, I hope you will hear me for five minutes or ten minutes on it.

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Mr. Betts: He does claim it, and I hope your Honor will embody in the decree a statement which will remove misapprehension.

Judge Wallace: Mr. McFarland, you may hand in a new form of decree precisely like the old one, except that the costs are made general costs in the case, and I will consider whether any alterations of the injunction clause are necessary.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

LECLANCHE BATTERY COMPANY

vs.

WESTERN ELECTRIC COMPANY.

DECIDED 25 AUGUST, 1884.

REPORTED 21 FEDERAL REP., 538.

“Leclanche Battery” Case.

TRADE-MARK—VALIDITY OF MARK IN DOUBT—PRELIMINARY INJUNCTION.

Where it is very doubtful whether the name claimed as a trade-mark does not describe the articles themselves and the kind of them, and indicate that they are made according to the patent known by the name claimed rather than that the patentee made them, a preliminary injunction should not be granted.

Edward N. Dickerson, Jr., for orator.

George P. Barton, for defendant.

WHEELER, J.:

The orator seeks, by motion for a preliminary injunction, to have the defendant restrained from using the words, "Pile Leclanche" and "Disque," and the orator's style of label, upon batteries of the defendant's manufacture. Leclanche was a patentee of an electric battery. One form of his batteries was known as the "disque." The word "Pile" has been used to signify a battery. The prominent feature of the label is a cut of medals awarded to Leclanche's batteries. The question, of course, is whether these words and this label improperly indicate that the batteries come from the orator, or are merely descriptive of their style and qualities. The patented batteries, of course, would become known to some extent as Leclanche batteries, and the word "disque" would naturally follow that form. These words would become apt to describe the batteries and that kind of them, and would indicate that they were made according to the patent, rather than that the patentee, or the orator bearing his name, made them. *Singer Manuf'g Co. v. Stange*, 6 *Fed. Rep.*, 279; *Burton v. Stratton*, 12 *Fed. Rep.*, 695; *Hostetter v. Fries*, 17 *Fed. Rep.*, 620; *Willcox & Gibbs S. M. Co. v. The Gibbens Frame, Id.*, 523. As the medals were awarded to the patented batteries, the representation of them upon the labels would be indicative of the reputation of these batteries rather than of their origin. Under these circumstances and authorities, the question whether these things all together amounted to an unlawful representation of the source of the batteries, is so doubtful, that the granting of a preliminary injunction does not appear to be warranted.

Motion denied.

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IN THE UNITED STATES PATENT OFFICE.

EX PARTE MOODIE.

DECIDED 22 SEPTEMBER, 1884.

REPORTED 28 O. G., 1271.

“Moodie Label” Case.

1. Congress intended to devolve upon the Commissioner of Patents, the duty of determining the character of the subject-matter offered for registration under the label and trade-mark law.
2. The proper construction of the statute is that the subject-matter of an application for label, shall be that which may be properly claimed as a label, and not be merely subject-matter for a trade-mark.
3. But the statute does not mean to imply that if certain subject-matter is found to be incapable of registration as a trade-mark, it can nevertheless be registered as a label, for it may not be descriptive of the quality or nature of the goods, and therefore fail to constitute a label.
4. In the case at bar the Examiner properly refused to register as a label, matter which, gaged by the established rules, constitutes only subject-matter for a trade-mark.

APPEAL from the Primary Examiner.

Registration of a Label. Elhanan L. Moodie's application filed April 9, 1884.

Messrs. Goepel & Raegener, attorneys for Moodie.

BUTTERWORTH, *Commissioner*:

This case brings up before me for consideration two questions: First, has the Commissioner of Patents discretionary power under the statute to refuse to register as a label what, in his opinion, is subject-matter only for a trade-mark? Secondly, if matter offered for registration as a trade-mark be not a trade-mark, by reason of non-adoption and use as such, may it therefore be registered as a label, although not coming within the known and recognized definition of the term label?

1. As to the first point, I am satisfied that Congress intended to devolve upon the Commissioner of Patents the duty of determining the character of the subject-matter offered for registration under the trade-mark and label law. Section 3 of chapter 301, Revised Statutes, contains the following clause: "except that there shall be paid for recording the title of any print or label *not a trade-mark*, six dollars," &c. The words "*not a trade-mark*" plainly indicate that some one must decide whether or not the proffered label is really nothing but a label. Who is to determine this? The same section says:

"And the Commissioner of Patents is hereby charged with the supervision and control of the entry or registry of such prints or labels," &c.

The trade-mark law of 1881, in section 3, speaks of the "*alleged trade-mark*." The whole tenor of the statutes is that the Commissioner of Patents shall determine the question of fact in executing the law—viz., as to whether or not the alleged trade-mark is actually a trade-mark; otherwise the Office would be registering as trade-marks matter which the Courts would unhesitatingly declare to be only labels, and *vice versa*. Much confusion and hardship might readily arise where parties are relying for protection upon a mere label, believing it to be a valid trade-mark, because registered as such. Cases have arisen in the Courts where parties have sued for infringement of an alleged trade-mark which, upon investigation, turned out to be nothing more than a label. (*Cheavin v. Walker*, *Cox's Manual of Trade-Mark Cases*,

294; *Gilman v. Hunnewell, Id.*, 303). Yet if the Office is to blindly accept the opinion of the applicant as to whether he has a trade-mark or a label, or be governed by his preference as to what he will call the subject-matter of the application, incidents of this sort must inevitably continue to arise, and the Patent Office would be in the unenviable position of deliberately misleading the public, whose servant it is. In such an abstract matter as this there are likely to be many differences of opinion among persons unfamiliar with the law, however well settled the principles may be upon which a right decision must be based.

2. The Courts are sometimes confusingly loose in their language respecting trade-marks, classing as such what are really but labels. It would conduce, therefore, to greater uniformity and regularity in the practice of the Office to have some one person decide whether or not an "alleged trade-mark" is actually what it is alleged to be. It seems to me that Congress so intended.

I am aware of the decision of the Supreme Court of the District of Columbia in *The United States, ex rel. The Willcox & Gibbs Sewing Machine Co. v. E. M. Marble*, (22 O. G., 1366). But that was practically an *ex parte* proceeding and not fully argued, and, as I conceive, did not have careful consideration. The transfer to the Commissioner of Patents of the supervision and control of the entry or registry of prints or labels designed to be used for articles of manufacture, not pictorial illustrations or works, was evidently for the purpose of bringing them under the control of the officer who registered trade-marks. Why? Because trade-marks and labels are so intimately connected that confusion might arise were they supervised by separate and independent officials. Furthermore, the fee for registering such prints or labels was at the same time raised from one dollar to six dollars. This was evidently in view of some extra work which would be entailed in the entry or registry of these prints or labels. If simple registry were all that were necessary why was not the same fee charged as for registering other prints or labels by the Librarian of Congress?

It seems more reasonable to view the extra fee as an equivalent for additional labor, which can be no other than an investigation of the alleged label to see whether it does not in fact amount

only to the subject-matter of a trade-mark. The Act requires this fee of six dollars to be paid for the registry of any label "*not a trade-mark.*" Why are these three words added? Because a different fee is required for the registry of a trade-mark, and it is to guard against the registry of one for the other that both are placed in the hands of one officer. An expert in both, he better than any one else, can determine which fee the applicant shall pay and the Government shall receive in any given case. The Act inferentially says that any alleged print or label which *is* a trade-mark shall pay the trade-mark fee, instead of the six dollars charged for a print or label "*not a trade-mark.*" I am aware that it is urged that adoption and use are essential to a trade-mark; that before any symbol or device can be designated a trade-mark it must have been adopted by some person, firm, or corporation, and used in connection with some article of merchandise. That is true. But it does not follow that that which is only a symbol or sign, and does not in anywise indicate the contents of the package, &c., which is the plain office of a label, can be denominated or made the subject-matter of a label. In other words, it does not follow because a certain symbol or device is not a trade-mark, because it has not been adopted and used as such, it may therefore be registered as a label, in the absence of these characteristics and essentials which are inseparable from a label under every known and recognized definition of the term label.

And here is the fallacy of the argument presented to me in this case. It is assumed that because the device or symbol presented for registration is not a trade-mark, because of non-use as such, that therefore it may be registered as a label; simply because the applicant is pleased to call it a label and prefers to register it as such. This is fallacious. It does not have the requirements of a label and it has none of the elements of a label, but is the subject-matter of a trade-mark under every known definition of a trade-mark.

If the argument of counsel in this case is correct, the definition of what is known in law as a "label" and what is known as a "trade-mark" amount to nothing. They can in nowise serve as a guide in determining what is a label and what the subject-mat-

ter of a trade-mark. It is all to be determined and definitely settled by the simple preference of the applicant. He may present to this Office what is well known to be subject-matter for a trade-mark which presents not one of the elements of a label, and simply because he is pleased to call it a "label" it is to be registered as such.

I am aware also that a point can be made on the peculiar phraseology of the statute where the phrase is used, "except that there shall be paid for the title of any print or label, *not a trade-mark*, six dollars," &c. It may be said that to be a trade-mark, in contemplation of this language, it must have been *used* as such. I dissent entirely from that proposition, for that involves the absurdity I have before mentioned, that to be a *label* and have the necessary characteristics of such it is only necessary that the applicant should *call* the subject-matter of his application a *label*.

2. The better construction of the statute, and the proper one, it seems to me, is that the *subject-matter* of an application shall be that which may be properly claimed as a *label* and not be *merely* subject-matter for a *trade-mark*.

The second part of this inquiry follows naturally upon what has been said above. The characteristics of a trade-mark are well settled and have been carefully formulated by text writers. The fundamental purpose of a trade-mark is to distinguish the goods manufactured by its owner from those of another manufacturer. It is the commercial signature of the producer. It says to the public, these goods were made by so and so, at such and such a place, and are therefore such and such a quality. As to what it may consist of, many definitions have been given. Upton's is as follows:

"A trade-mark is the name, symbol, figure, letter, form, or device adopted and used by a manufacturer or merchant in order to designate the goods that he manufactures or sells, and distinguishes them from those manufactured or sold by another, to the end that they may be known in the market as his, and thus enable him to secure such profits as result from a reputation for superior skill, industry, or enterprise."

Browne says:

“The trade-mark may consist in the name of the manufacturer or merchant (provided it be written, printed, branded, or stamped in a mode peculiar to itself), in a seal, a letter, a cipher, a monogram, or any other sign or symbol that can serve to distinguish the products of one man from those of another. It may be any symbol or emblem, however unmeaning in itself, as a cross, a bird, a quadruped, a castle, a star, a comet, a sun; or it may and frequently does consist of a combination of various objects, copied from nature, art, or fancy; and if such symbol or emblem comes by use to be recognized in trade as the mark of the goods of a particular person, no other trader has a right to affix it to goods of a similar description. It may be adhesive or non-adhesive. It may be put inside of the article or on the outside. It may be written, printed, stamped, painted, stenciled, or branded, or otherwise, and either on the article itself or on its case, covering, envelope, or wrapper.” (*Browne on Trade-Marks, sec. 87*).

But what is a label? Worcester defines it as follows:

“A small piece of paper or other material containing a name, title, or description, and affixed to anything to indicate its nature or contents.”

The distinctive feature of a label is that it is descriptive. It tells one the contents of the package to which it is affixed. It is composed of words in ordinary use, used with their ordinary significance. It is such a placard as might be written by any one who had such goods to sell, irrespective of their origin. The protection afforded by the statute, is similar to that of a copyright. It covers the arrangement and dress of the subject-matter, not the subject-matter itself. Anybody else may take the same ideas and dress them up in another way and protect that arrangement by copyright or registration.

3. Nor does the statute mean to imply that if certain subject-matter is found to be incapable of registration as a trade-mark it can nevertheless be registered as a label. An alleged trade-mark may, as before stated, be found to lack the essential characteristics of a trade-mark, or to be untenable as such by reason of prior rights, or because it is merely a colorable imitation of some other mark, and yet not be registerable as a label because it is not de-

scriptive of the quality or nature of the goods, or because it has the outward appearance of being a trade-mark, and so is calculated to deceive. So, too, a so-called "label" or "trade-mark" may be found to be merely a design, and the proper subject of a patent.

4. In the case at bar the Examiner has properly refused to register as a label matter which, gauged by the established rules, constitutes only subject-matter for a trade-mark.

The appeal is dismissed.

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SUPREME COURT, DISTRICT OF COLUMBIA.
IN EQUITY.

UNITED STATES, EX REL. ELHANAN L. MOODIE,

vs.

BENJAMIN BUTTERWORTH, Commissioner of Patents.

DECIDED 27 DECEMBER, 1884.

REPORTED 30 O. G., 97.

STATEMENT OF THE CASE.BUTTERWORTH, *Commissioner*:

Prior to the issuance of the order hereinafter referred to the Examiner of Trade-Marks and Labels had been for some time accustomed, under the construction given to the decision of the Supreme Court of the District of Columbia in the case of *The United States, ex rel. The Willcox & Gibbs Sewing Machine Co. v. E. M. Marble, Commissioner of Patents*, (22 O. G., 1366), to register as a label that which was subject-matter only for a trade-mark, the applicant in each case being permitted to determine for himself whether he would register as a label or trade-mark, and deciding absolutely what was and what was not proper subject-matter for a label or trade-mark. On the attention of the

Commissioner being called to this matter the following order was issued:

“The Examiner of Trade-Marks will determine in each case whether that which is presented for registration is in fact a label or trade-mark. If it is the latter, it will in no case be registered except upon the payment of the fee fixed by law—to wit: twenty-five dollars.”

The petitioner in this case, (Moodie), on April 9, 1884, presented an application covering subject-matter for a trade-mark, and requested to have it registered as a label. The Examiner refused, and appeal was taken to the Commissioner, who sustained the decision of the Examiner, (see 28 *O. G.*, 1271), the point being that the law devolved upon the Patent Office the duty of determining in each instance whether that which was sought to be registered as a label was in fact a label or only subject-matter for a trade-mark. Thereupon applicant filed in the Supreme Court of the District of Columbia a petition for a writ of mandamus to compel the Commissioner to register the subject-matter presented in accordance with the request preferred to the Examiner. The case was fully argued by *Messrs. Goepel & Raeger*, for the petitioner, and *Mr. Frank T. Brown*, counsel for the Patent Office. On the 22d instant the Court in an oral opinion sustained the decision of the Commissioner, and dismissed the bill.

A statement of this case is published for the reason that the opinion seems to obtain that it is entirely within the discretion of the applicant whether he will register that which is subject-matter only for a trade-mark as a label; that it is his province unquestioned to determine whether the subject-matter so presented is in fact a label or subject-matter only for a trade-mark, and that his determination in that behalf is final.

The Court has not sustained that view.

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CIRCUIT COURT UNITED STATES, EASTERN
DISTRICT OF MISSOURI. IN EQUITY.

GOODYEAR RUBBER COMPANY

vs.

DAY, AND ANOTHER.

DECIDED 11 OCTOBER, 1884.

REPORTED 22 FEDERAL REP., 44.

“Goodyear Rubber Co.” Case.

1. TRADE-MARKS—INFRINGEMENT.—No manufacturer will be permitted to stamp upon or attach to his goods, the name of another manufacturer.
2. SAME—NAME OF PATENT.—*Semble*, that after the expiration of a patent, no manufacturer of the patented article can appropriate the name or the principal part of the name of the patent as a trade-mark.

THIS is a suit to restrain the defendants from advertising or selling rubber goods, not manufactured by the complainant, with the name of “The Goodyear Co.” in any manner annexed or attached thereto.

Thos. T. Gantt and *A. & John F. Lee*, for complainant.
McFarland, Reynolds & Harrison, for defendants.

TREAT, J., (*orally*),

The litigation connected with this Goodyear rubber business I am fully conversant with, as the Reports are full of it, and during 20 odd years I have had to look into the matter in causes pending before me. It seems to the Court this is an effort to appropriate the name, "Goodyear." The patent has expired. Now, if, after the termination of the patent, a man can adopt the name of the patent, and use it as a trade-mark, he is, in violation of the laws of the United States, getting an exclusive right which does not belong to him. The case before Judge WALLACE, as I heard it read, is substantially between two corporations, in which the Goodyear Rubber Co., charged that the Goodyear Rubber Manufacturing Co., a defendant, had used the name "Goodyear Rubber Co.," which it had no right to do. It dropped the word "Manufacturing;" therefore it was enjoined by Judge Wallace against using the name of that particular corporation. Now, Judge Donahue has gone a step further than I am willing to go, in saying that any man can appropriate "Goodyear," the generic term, and thereby practically extend the patent *ad infinitum* by using that name.

1. The name of this corporation is "The Goodyear Rubber Co." The quality of its goods is offered as superior to any other. Whether superior or inferior is a matter of no consequence. No man has a right to use the name and palm off his goods marked in that name. Has the defendant done so? It seems some cases were bought of boots and shoes with the mark of "Goodyear" upon them. For the purposes of this case I will say that is all. I will therefore require him to keep an account of all the goods he sells under that name. As at present advised in regard to it, I do not think there is any infringement of the trade-mark, but it will not hurt him to keep an account. If, after a full development of the facts, it turns out otherwise, he must suffer.

Mr. Gantt. You refuse the preliminary injunction?

The Court. I do; but will cause the defendant to keep an account of all the goods he sells, either in your name or of the "Goodyear Co." In determining the question, as at present ad-

vised, I think one man has as good a right to use the name of "Goodyear" as another.

Mr. Gantt. No doubt about the word "Goodyear?"

The Court. Well, "Goodyear Rubber Co." That is the point. Your name is the "Goodyear Rubber Co." It will be ordered that the defendant keep an account of all goods by him sold in the name of the Goodyear Rubber Co. or the Goodyear Co.

Mr. Gantt. I will ask that the account include what he has sold or may hereafter sell.

The Court. I can't order him to keep an account of what has been done. He will have to account for it if you maintain your bill. But hereafter he will keep an account of all sales in those names. That is all I can do now. The rest will be a matter of damages, if you maintain your suit.

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CIRCUIT COURT UNITED STATES, EASTERN
DISTRICT OF WISCONSIN. IN EQUITY.

LANDRETH AND OTHERS,

vs.

LANDRETH.

DECIDED 27 OCTOBER, 1884.

REPORTED 22 FEDERAL REP., 41.

“Landreth Peas” Case.

TRADE-MARK—USE OF SURNAME—PARTIES OF SAME NAME—
DECEPTION AND FRAUD—INJUNCTION.

While a party cannot be enjoined from honestly using his own name in advertising his goods and putting them on the market, where another person, bearing the same surname, has previously used the name in connection with his goods in such manner and for such length of time as to make it a guaranty that the goods bearing the name emanate from him, he will be protected against the use of that name, even by a person bearing the same name in such form as to constitute a false representation of the origin of the goods, and thereby inducing purchasers to believe that they are purchasing the goods of such other person.

George Harding and Francis T. Chambers, for complainants.
Nash & Nash, for defendant.

DYER, J.:

This is a suit for an injunction to restrain the defendant from using a certain label which the complainants allege they have adopted as their trade-mark in the sale of a certain variety of seeds known as "Landreth's Extra Early Peas." A motion has been made for a preliminary injunction, and at the present stage of the case, I do not deem it necessary to do more than to announce briefly and quite informally my conclusions upon certain points concerning which my mind is free from doubt. There are some questions in the case upon which more light may be thrown by further and more elaborate argument and the disposition of which, I think, should be postponed until the hearing on the merits. At present, I can hardly think the defendant has not the right to raise and sell the seed known as "Landreth's Extra Early Peas;" nor am I now of the opinion that he should be restrained from putting the peas on the market in bags of various sizes, fastened in the manner shown, and identified by such a metallic seal as it appears he now uses.

Further, it is not clear that the defendant has not the right to advertise his peas as "Landreth's Extra Early Peas," provided he does so in such manner as to clearly inform the public that the peas are of his own growth and production. It seems to me this case is not, accurately speaking, one of trade-mark or trade name. It is rather a case in which the question appears to be whether the defendant, by the use of certain labels or inscriptions on the bags in which his peas are put upon the market, is not selling his own goods as the goods of Landreth & Sons, of Philadelphia. The complainants, in 1873, placed upon their bags and adopted this inscription, printed in blue ink, and in the following form:

GUARANTEED TO CONTAIN
LANDRETHS'
 EXTRA EARLY PEAS,
 PROVIDED THE SEAL IS UNBROKEN.

Below which is printed the quantity of peas contained in the bag, as, for instance, "1-4 Bus.," and the year. It is very satisfactorily shown that, by this form and character of label, the complainants' bags have become known and recognized by dealers and by the public as containing peas produced and sold by the complainants; and it would appear that this form of designation of their goods has become, by use and public recognition, valuable to them. It is, so to speak, the recognized flag under which they sail in the trade. The defendant, in 1883, having commenced the business of producing and selling a variety of peas which he advertises as "Landreth's Extra Early Peas," at Manitowoc, in this State, placed upon the bags in which his peas were sold, the following inscription, printed in blue ink:

THIS BAG CONTAINS
LANDRETHS'
 EXTRA EARLY PEAS,
 PROVIDED
 THE SEAL IS UNBROKEN.

Below this label is printed the quantity of peas contained in the bag, as, for example, "1-4 Bus.," and the year. That this was a substantial adoption of the complainants' label, in its collocation of words and general appearance, cannot be doubted. The deviation is so slight as not to be observable, except as the two labels are placed side by side. It is equally clear that an ordinary purchaser, accustomed to rely on the inscription upon the complainants' bags as designating the peas grown and sold by them, would be readily led to suppose, upon ordinary observation of the defendant's label, that the peas put up in his bags and sold by him were the goods of the complainants. In short, the defendant's label is a very plain imitation of that previously adopted by the complainants. There is nothing in the defendant's label to fairly distinguish his production of "Landreth's Extra Early Peas" from that of the Philadelphia producers. Even admitting that the defendant has the right to use the same words as those which constitute the complainants' label, he has no right to use them in such form or such style of arrangement, as to lead the public to suppose that the peas contained in his bags are peas grown and sold by the complainants. This is so, without regard to any question of technical trade-mark or trade name. The authorities in abundance declare this to be the law.

In *McLean v. Fleming*, 96 U. S., 254, the Supreme Court say:

"Nor is it necessary, in order to give a right to an injunction, that a specific trade-mark should be infringed; but it is sufficient that the Court is satisfied that there was an intent on the part of the respondent to palm off his goods as the goods of the complainant, and that he persists in so doing after being requested to desist."

Of course, a party cannot be debarred from the right to honestly use his own name in advertising his goods and putting them on the market, but where other persons bearing the same surname have previously used the name in connection with their goods, in such manner for such length of time as to make it a guaranty that the goods bearing the name emanate from them, they will be protected against the use of that name, even by a person bearing the same name, in such form as to constitute a false representation of

the origin of the goods. To illustrate: The complainants and the defendant bear the same surname. Each is a dealer in "Landreth's Extra Early Peas." While the defendant has the right to use his own name in advertising his peas and putting them on the market, he has not the right to use it in such manner as to lead dealers and purchasers to suppose that, when in fact purchasing his peas, they are purchasing the peas grown and sold by the complainants. Adjudged cases thus enunciate the law. As is stated in one of them, "no man has the right to dress himself in colors or adopt and bear symbols, to which he has no peculiar or exclusive right, and thereby personate another person, for the purpose of inducing the public to suppose, either that he is that other person, or that he is connected with and selling the manufacture of such other person, while he is really selling his own." See, also, *Holloway v. Holloway*, 13 *Beav.*, 209. Many other cases of similar and uniform purport might be cited.

Now, as I have said, the defendant's label, is, as it seems to me, a palpable imitation of the complainants' In the color of ink used, in the arrangement of the words, and in the general style of the label, he has, so to speak, dressed his goods in the garb previously adopted by the complainants. Whether intended or not, this necessarily operates as a fraud upon them, and upon the public. If the defendant has the right to use the same words as those which constitute the complainants' label, he ought to accompany them with some clear *indicia* of the source of the goods. He seems to have done so in his late issue of circulars and advertising cards. In the absence of anything in the inscription he places on his bags, distinctly denoting that he is the producer and seller of the peas in which he deals, called "Landreth's Extra Early Peas," he evidently leads or may lead purchasers to believe that in purchasing his peas they are purchasing the peas grown and sold by the complainants. This appears from affidavits presented on this motion. Such abandonment of their label or inscription by the complainants as deprives them of the right to be protected in the use of the same, is, I think, not shown.

The case seems to be a clear one for a preliminary injunction to the extent indicated, and upon the execution by the complain-

ants of a bond in the usual form, in the sum of \$2,000, with surety to be approved by the clerk, an injunction, *pendente lite*, will issue, restraining the defendants from placing on the bags used by him in putting his peas on the market, a label or inscription resembling in design, form, and arrangement, or collocation of identical words, the label or inscription of the complainants, as does the label now used by the defendant.

The printing of the letter "A" over the word "Landreths'," by the defendant, on the bags of peas more recently sent out by him, does not, in the form and style in which it is printed, relieve his label of its tendency to mislead.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

ESTES, ET AL.

vs.

BELFORD, CLARKE & COMPANY, ET AL.

DECIDED 3 DECEMBER, 1884.

REPORTED 30 O. G., 99.

Chatterbox vs. Chatterbook.

1. The infringement of a trade-mark is a trespass upon the rights of the owner, by using it as a false representation that the wares of the infringer are those of the owner, for which an action of trespass on the case would lie at common law, in which all participating would be principals and proper defendants.
2. A bill in equity lies in this Court only on account of its preventive relief, and perhaps to save multiplicity of suits, as in case of the infringement of a patent. *Root v. Railway Co.*, 105 *U. S.*, 189.
3. Where the reading matter of defendants' publication was different from the complainants', but the name, style and arrangement were the same, and it was clear that the latter had been adopted for the advantage they gave. **Held:**

That taking this advantage was injurious and illegal.

Mr. J. L. S. Roberts, for the orators.

Mr. J. A. Hyland, for the defendants.

WHEELER, J.:

1. The infringement of a trade-mark is a trespass upon the rights of the owner by using it as a false representation that the wares of the infringer are those of the owner, for which an action of trespass on the case would lie at common law, in which all participating would be principals and proper defendants.

2. A bill in equity lies in this Court only on account of its preventive relief, and perhaps to save multiplicity of suits, as in case of the infringement of a patent. *Root v. Railway Co.*, 105 *U. S.*, 189. The defendants Belford and Hart are the persons who are actively engaged in, and therefore principals in, all the infringement complained of. They are agents of the other defendant, a corporation of Illinois, which ought to be proceeded against so far as it can be, and the Court might in its discretion decline to proceed against these other defendants if the plaintiffs neglected to proceed against that one. But the plaintiffs have used all diligence in proceeding against the corporation, and have only been put off in that by its efforts not to be found and held here. There is no reason, therefore, why the right to an injunction against these defendants should not be decided on its merits.

3. The case made is clearly within the former decision. *Estes v. Williams*, 21 *Fed. Rep.*, 189. The matter of the defendants' publication is different from that of the plaintiffs, although it is of the same general class of juvenile reading and illustration. If put up in ordinary form, under a name without reputation, it would have to stand on its own merits as a literary and artistic production; but the name, style, and arrangement of the plaintiffs' work is taken, and the reputation and popularity of it thereby appropriated. An ordinary purchaser would be very much guided by the name and style of the publication. It is not bought generally for what is known to be in it, but for what is to be found in it. The standard would be expected to come up to that of the former publications of the same name and the character of that

would be principally relied upon. This name is nothing of itself apart from the work to which it has been applied by the orators and those upon whose right they stand. It is quite clear that the name and style of the work are adopted for the advantage they give, and that taking this advantage is injurious to the orators.

The motion for a preliminary injunction is granted against the defendants Belford and Hart.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

ANHEUSER BUSCH BREWING ASSOCIATION*vs.*PISA.

DECIDED ———, 1885.

REPORTED 24 FEDERAL REP., 149.

“St. Louis Lager Beer” Case.

TRADE-MARK—GEOGRAPHICAL NAME—“ST. LOUIS LAGER BEER”—FRAUDULENT SIMULATION OF LABELS—INJUNCTION.

1. Complainant, a brewer in St. Louis, Missouri, made and exported to Panama and South American ports, beer in bottles, with a label bearing the words “St. Louis Lager Beer.” Defendant, a shipper of beer from New York City, and a competitor of complainant in trade in Panama and South America, labeled his bottles “St. Louis Lager Beer.” HELD:

That although complainant could not have an exclusive property in the words “St. Louis” as a trade-mark, or the exclusive right to designate his beer by the name of “St. Louis Lager Beer,” yet, as his beer had always been made at that city, his use of the designation upon his

labels was legitimate; and that defendant, whose beer was made in New York, should be enjoined from diverting his trade by simulating his labels, or representing in any other way, his products as those of complainant.

2. It is no answer for the defendant, where the complainant asks for protection, to say that it has no exclusive right to designate its products in the manner it has, although this might very properly be asserted by a competitor selling beer made at St. Louis, or who by reason of any circumstance, might be entitled to represent his product as originating there.
3. This case is similar in some of its facts, to that of *Newman v. Alword*, 51 N. Y., 189.
4. It is unnecessary for present purposes, to consider whether the complainant has a valid trade-mark or can have a technical trade-mark in the name "St. Louis." It is sufficient that it was lawful for the complainant to use the name to designate its property, that by doing so it has acquired a trade which is valuable to it, and that the defendants' acts are fraudulent and create a dishonest competition detrimental to the complainant.

WALLACE, J.:

1. The complainant, a corporation doing business at St. Louis, Missouri, has for many years been accustomed to export its beer in bottles with a label bearing the words, "St Louis Lager Beer." It had acquired a considerable market for its products in South America and Panama. During this time there were many other manufacturers and vendors of lager beer at St. Louis, but so far as appears none of them had an export trade, and none of them were accustomed to use labels with the words "St. Louis Lager Beer" printed upon them.

2. The defendant is a shipper of beer at New York City, and a competitor of the complainant in trade at Panama and various places in South America. The affidavits show beyond doubt that in these places the beer, which is known as "St. Louis Lager Beer" is in demand, and it is doubtless because of this fact that the defendant, whose beer is made in New York, labels his bottles so as to represent that his beer is made at St. Louis, and so as to represent that his firm are the sole agents of the "St. Louis Lager Beer" at New York. He alleges that purchasers of beer at

Panama and the other places in question in South America, do not discriminate between the complainant's article and other beer made in the United States, but buy it simply because they suppose St. Louis lager beer is beer produced in the United States as distinguished from German and English beer. This may be true; but if it is, it does not seem to be conclusive against the right of the complainant to the injunction which he seeks. As the goods of the parties go to the same markets, it can hardly fail to happen that the complainant will lose sales, and the defendant will get customers, in consequence of the defendant's acts.

3. Although the complainant cannot have an exclusive property in the words "St. Louis" as a trade-mark, or an exclusive right to designate its beer by the name "St. Louis Lager Beer," yet, as its beer has always been made at that city, its use of the designation upon its labels is entirely legitimate; and if the defendant is diverting complainant's trade by any practice designed to mislead its customers, whether these acts consisted in simulating its labels, or representing in any other way his products as those of the complainant, the latter is entitled to protection.

4. It is no answer for the defendant, when the complainant asks for protection, to say that it has no exclusive right to designate its products in the manner it has, although this might very properly be asserted by a competitor selling beer made at St. Louis, or who, by reason of any circumstances, might be entitled to represent his product as originating there. *Canal Co. v. Clark*, 13 Wall., 322.

It must be assumed, upon the facts as they are now disclosed, that complainant, by its enterprise and the quality of its product, had acquired a foreign market for its beer, under the designation of "St. Louis Lager Beer," that no one else, having a right to use this designation, was a competitor of the complainant in this market until the defendant became one; and that the defendant has attempted to interfere with the complainant's trade and divert it to himself by selling a different article under the same name, and in this behalf has been guilty of false and deceitful conduct toward the public. It is manifest that the complainant's trade must be more or less injured by the defendant's acts.

5. The case is similar in some of its facts to that of *Newman v. Alword*, 51 N. Y., 189. There the plaintiff used the word "Akron" to designate a cement manufactured by him at the village of Akron, New York. The defendant, who was a manufacturer at another place in the same State, was enjoined from designating his cement as "Akron Cement," although he prefixed his own name and added the real place of its manufacture. In the opinion delivered in that case by Earl, J., it was assumed that other persons at Akron had the right equally with the plaintiff to call their cement "Akron Cement," but he added:

"Yet it is quite clear that the plaintiffs, upon the facts, are entitled to protection against the defendant. It is sometimes said in the cases to which our attention has been called that the claimant to a trade-mark must have the exclusive right to it. This form of expression, I apprehend, is not strictly accurate; the right must be exclusive against the defendant. It is generally sufficient in such cases if the plaintiffs have the right and the defendant has not the right to use it. The principle upon which the relief is granted is, that the defendant shall not be permitted, by the adoption of a trade-mark which is untrue and deceptive, to sell his own goods as the goods of the plaintiff, thus injuring the plaintiff and defrauding the public."

The following cases, in which a party has been protected in the use of the name of a place to distinguish a particular business or product, are apposite: "Glenfield Starch," in *Wotherspoon v. Currie*, L. R., 5 H. L., 508, 513; "Anatolia Liquorice," *McAndrew v. Bassett*, 10 Jur. (N. C.), 492; "Seixo Wine," in *Seixo v. Provezende*, L. R., 1 Ch. App. Cas., 192.

6. It is unnecessary for present purposes to consider whether the complainant has a valid trade-mark or can have a technical trade-mark in the name "St. Louis." It is sufficient that it was lawful for the complainant to use that name to designate its property; that by doing so it has acquired a trade which is valuable to it, and that the defendant's acts are fraudulent and create a dishonest competition detrimental to the complainant. Upon the argument of this motion, the impression was entertained that

the "Piza label No. 2" was not such a simulation of the complainant's label, as would be likely to mislead purchasers. Upon further consideration this impression has been removed. It is no unreasonable, in view of the defendant's purpose to deceive the public by adopting this label, to resolve any doubt which may remain in favor of the complainant.

The motion for an injunction is granted.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

GLEN COVE MANUFACTURING COMPANY

vs.

LUDEMAN.

DECIDED 2 JANUARY, 1885.

REPORTED 22 FEDERAL REP., 823.

“Maizena vs. Maizharina.”

1. The complainant registered in December, 1881, as a trade-mark for corn flour, the word “Maizena,” and an allegorical picture representing the cultivation of corn and the preparation of flour. In December, 1882, the defendant registered for the same purpose the word “Maizharina,” accompanied with a pictorial representation of a man carrying a quantity of maize under his arm. Prior to the last mentioned date, the complainant had acquired a good common law title to his trade-marks. **HELD:**

That as to the picture there is not, but that as to the word there is infringement.

2. To entitle to relief, it is not necessary that the imitation should be so close as to deceive persons seeing the two marks side by side. It is sufficient if there is such a degree of resemblance as would deceive ordinary purchasers using ordinary caution.

3. A word used as a trade-mark is addressed to the eye as well as to the ear, and cannot be disassociated from its surroundings when the inquiry is whether it is a colorable imitation.
4. Registration of a trade-mark is only *prima facie* evidence of ownership, and the validity of the title so evidenced is always open to judicial inquiry.

Mr. Francis Forbes, for the complainant.

Mr. Fred. Ingraham, for the defendant.

WALLACE, J.:

1. The complainant moves for a preliminary injunction restraining the defendant from violating its right to the exclusive use of two trade-marks used by it in commerce with foreign nations and applied to a preparation of corn flour for food, both of which it procured to be registered in the Patent Office, December 6, 1881, under the provision of the Act of Congress of March 3, 1881. The first consists of the word "Maizena," and the second is an allegorical picture representing the cultivation of the corn and the preparation and cooking of the flour by Indians. Both are applied by printing upon the packages in which the corn-flour is put up for sale.

The defendant is the registered owner of a trade-mark for corn-starch, which consists of the word "Maizharina," accompanied with a pictorial representation of a man carrying a quantity of maize in his arm, registered in the Patent Office, December 5, 1882.

Both parties are manufacturers here of the corn flour, and put it up here for sale in foreign countries, and both use their respective trade-mark upon the packages containing the flour or starch in the same way. The complainant or its predecessor in business was the originator of the trade-marks it has registered, had used them for many years to designate its corn flour, and had acquired a good common law title to them before the defendant undertook to employ either the word or the picture registered by him.

It is quite obvious that the defendant's word and picture as applied by him to the packages of his corn flour put up for export-

ation to Germany and Cuba in connection with the similarity of his packages in form, size, color-printing, and other characteristics to the complainant's are well calculated to lead purchasers to confuse the identity of the products of the respective parties. As thus used by him, it would seem clear that he has purposely simulated the complainant's devices for distinguishing its product from those of others, and if the case turned on the principles which obtain ordinarily in equity when the use of a common law right of property in a trade-mark is the subject of controversy, it would be the duty of the Court to order an injunction. Granting that the word and picture of the defendant are different from those of the complainant, a Court of Equity would enjoin the defendant from using them with such accessories as would lead purchasers to confound the one with the other, not because of the infringement of complainant's trade-mark, but because the defendant would not be allowed by any deceitful practice to impose upon the public to the prejudice and injury of the complainant.

But both parties are citizens of this State, and the jurisdiction invoked is therefore founded solely on the Act of Congress for the protection of trade-marks, and can only be exercised according to the statute which invests the Court with authority to hear the controversy. The complainant is here upon his statutory title to enforce his statutory rights in the enjoyment of his trade-marks, and the single question is, therefore, whether these have been invaded. If the defendant has appropriated either of these trade-marks, the complainant, as the party aggrieved, by the language of the Act (section 7), "shall have his remedy according to the course of equity to enjoin the wrongful use of such trade-mark."

The complainant's trade-mark in the picture has not been infringed. There is such a substantial dissimilarity between this picture and that used by the defendant as to eliminate from the case any theory of a colorable imitation. Whether its trade-mark in the word "Maizena" has been appropriated by defendant's use of the word "Maizharina" is a more doubtful question. Although the defendant uses the word "Maizharina" upon packages of his corn flour put up for the German market, it does not follow that the article will be sold exclusively in that market, and

the tendency of the word to mislead purchasers of the article into the belief that it is the complainant's product does not depend solely upon the inquiry whether it may mislead German purchasers. The defendant's act is committed here, and whether it is a wrong or is justifiable must be ascertained upon the principles of our jurisprudence, and not upon those of the law of Germany. Unless the complainant's trade-mark is used on goods intended to be transported to a foreign country, by the terms of the Act of Congress the Court can take no cognizance of the wrong in a suit between citizens of the same State. (Section 11). If it is so used, the Court will not be concluded by the result of an inquiry whether it is used with an intent to mislead purchasers in the country where the goods are to be ultimately sold, because the goods may be sold here or in some country other than the one where they are to be ultimately sold, and the Act of Congress contemplates a complete protection to the right which it creates.

If the decision were to depend solely upon the question of a substantial similarity in the sonorous properties between the word used by the complainant and that used by the defendant, decisions in analogous cases furnish sufficient authority for granting an injunction. Thus the word "Cocaine" has been held to be an infringement of a trade-mark in the word "Cocaine," (*Burnet v. Phalen*, 3 *Keyes*, 394); "Bovina" of the word "Boviline," (2 *Daly*, 521); the word "Appolinis" of the word "Appolinaris," (14 *Blatch.*, 380); "Hostetler" of the word "Hostetter," (1 *Dillon*, 329). The rule is well settled, that to entitle the proprietor of a trade-mark to relief against an illegal appropriation it is not necessary that the imitation should be so close as to deceive persons seeing the two marks side by side.

2. It is sufficient if there is such a degree of resemblance that ordinary purchasers using ordinary caution are likely to be deceived.

But the question whether the defendant has colorably imitated the complainant's trade-mark is not to be solved merely by considering the resemblance between the words themselves. If the defendant has dressed his word in such accessories that it may be

mistaken for the complainant's word, that circumstance is not to be overlooked.

3. A word used as a trade-mark is addressed to the eyes as well as to the ears of purchasers of the article to which it is applied. It cannot be disassociated from its surroundings when the inquiry is whether as used it is a colorable imitation of another's trade-mark. The defendant has artfully garbed and draped a word used by him bearing a close resemblance to the complainant's word, so that its identity is rendered more indistinguishable from that of the complainant's than it is intrinsically.

The defendant insists that his certificate of registry is a decision of the Commissioner of Patents that he is entitled to the word "Maizharina" in connection with his picture as a trade-mark, notwithstanding the complainant's trade-mark in the word "Maizena," which is a judicial determination, and is conclusive as between the parties. The sufficient answer to this proposition is that the Act of Congress makes the registration of a trade-mark only *prima facie* evidence of ownership. (Section 7). The inquiry is therefore always open as to the validity of the title to a trade-mark evidenced by the registration.

4. The registration could not confer a title to the trade-mark upon the complainant if some other corporation or individual had acquired a prior right by adoption and use, nor could it vest defendant with a title as against the complainant's common law title. In this view the only office of registration is to confer jurisdiction upon the Court to protect a trade-mark when the proprietor has obtained the statutory evidence of title, and the only function of the Commissioner of Patents is to determine whether an applicant has a presumptive right to the trade-mark.

An order is granted for an injunction in conformity with this opinion.

Estes, *et al.* vs. Worthington.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

ESTES, AND OTHERS,*v's.*WORTHINGTON.

DECIDED 5 JANUARY, 1885.

REPORTED 22 FEDERAL REP., 822.

“Chatterbox” Case.

1. TRADE-MARK—INJUNCTION—LACHES.—When delay of the owner of a trade-mark to prosecute infringers has been of a tendency to mislead the public, or the defendant sought to be enjoined, into a false security, and a sudden injunction would result injuriously, it ought not to be granted summarily, but the complainant should be left to his relief at final hearing.
2. SAME—USE OF TRADE-MARK BY OTHERS.—Where the extensive use of a trade-mark by others, with the implied acquiescence of the owner, has contributed to give a reputation and create a demand for the article to which it has been applied, which it would not otherwise have acquired, equity should not by any stringent intervention assist the owner to secure these fruits.
3. SAME—COMPLAINANT GUILTY OF FRAUD.—A complainant who has refused to recognize the rights of the original foreign proprietor of a

trade-mark until he thought it would be more profitable to purchase his rights in this country, and thus obtain a monopoly, reserving the right to annul the contract at his discretion, will not be entitled to a preliminary injunction against alleged infringers of the trade-mark, but be left to his rights at final hearing.

MOTION FOR PRELIMINARY INJUNCTION.

J. L. S. Roberts and *G. G. Frelinghuysen*, for complainants.
Scudder & Carter, for defendant.

WALLACE, J.:

The validity of the complainants' title to a trade-mark in the word "Chatterbox," as applied to juvenile books, and which they acquired by purchase from James Johnstone, of England, in the year 1880, has been established, and is not open to controversy upon the case made by defendants. *Estes v. Williams*, 21 *Fed. Rep.*, 189. The only doubt as to the complainants' right to a preliminary injunction is suggested by the fact that the various publishers of such books since 1876 have been permitted without prosecution to apply the word to their publication of juvenile books in this country, and have used it as a trade-mark in hostility to the real proprietors; and among them were the complainants themselves, who did so for two or three years before they purchased the right of Johnstone.

Laches in prosecuting infringers has always been recognized as a sufficient reason for denying a preliminary injunction; sometimes, apparently, by way of discipline to a complainant who has manifested reluctance to burden himself with the expense and vexation of a law-suit, and delayed legal proceeding until his patience was exhausted. See *Bovill v. Crate, L. R.*, 1 *Eq. Cas.*, 389. When delay of the owner of a patent or trade-mark to prosecute infringers has been of a tendency to mislead the public or the defendant sought to be enjoined into a false security, and a sudden injunction would result injuriously, it ought not to be granted summarily, but the complainant should be left to his relief at final hearing. So also where as in this instance the extensive use of

the trade-mark by others with the implied acquiescence of the owner has contributed to give a reputation and create a demand for the article to which it has been applied which it would not otherwise have acquired, equity should not by any stringent intervention assist the owner to secure these fruits. The complainants do not occupy a position that commends them to a Court of Equity; because they seem to have refused to recognize the rights of Johnstone, the original proprietor of the trade-mark, until they thought it would be more profitable to purchase his rights in this country and obtain a monopoly here in the use of the trade-mark. By their contract of purchase they reserved the right to annul the contract at their option. They should be left to their rights at final hearing according to the usual course of equity. The motion is denied.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

DE KUYPER, AND OTHERS,

vs.

WITTEMAN, AND OTHERS.

DECIDED 12 JANUARY, 1885.

REPORTED 28 FEDERAL REP., 871.

“De Kuyper Label” Case.

TRADE-MARK—INFRINGEMENT—PRINTING AND SELLING
IMITATION LABELS TO THIRD PARTIES.

Printing and selling labels in imitation of a trade-mark, with the purpose of enabling the parties to whom the labels are sold to palm off their goods upon the public as the goods of the owner of the trade-mark, is a violation of the rights of such owner.

Rowland Cox, for plaintiff.

B. B. Foster, for defendant.

WALLACE, J.:

The demurrer in this case is without merits. The complainants, upon the facts shown in the bill of complaint, have a good

title to their trade-mark, and a case for its protection irrespective of their statutory rights under the registration in the Patent Office. As the necessary diversity of citizenship exists between the parties, they are entitled to invoke the jurisdiction of this Court.

Upon the allegations of the bill the defendants are actively engaged in assisting third persons to use the complainants' trade-mark in violation of their rights. The mere act of printing and selling labels in imitation of the complainants' might be innocent, and, without evidence of an illicit purpose, would not be a violation of the complainants' rights. It is otherwise, however, when this is done with the obvious purpose of enabling others by the use of the labels to palm off their goods upon the public as the goods of the complainants.

The demurrer is overruled, with costs. Defendants may answer upon payment of costs.

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CIRCUIT COURT UNITED STATES, DISTRICT
OF MAINE. IN EQUITY.

STACHELBERG, AND OTHERS,

vs.

PONCE.

DECIDED 23 FEBRUARY, 1885.

REPORTED 23 FEDERAL REP., 430.

“*La Normandi*” Case.

1. TRADE-MARK—USE BY ASSIGNEE OR PURCHASER—DECEPTION—INFRINGEMENT—INJUNCTION.—A trade-mark must either by itself or by association, point to the origin or ownership of the article to which it is applied. *Canal Co. v. Clark*, 13 Wal., 311. It imports that the article is made by the original proprietor, not only as matter of justice, but to prevent imposition on the public. *Manhattan Medicine Co. v. Wood*, 108 U. S., 218.
2. An assignee or purchaser of a trade-mark from the original proprietor must in the use thereof indicate that he is assignee or purchaser, or he will not be entitled to protection in the use of the mark assigned.

Clarence Hale, for complainants.*William Henry Clifford*, for defendant.

COLT, J.:

In this suit the complainants claim the exclusive right to the use of the trade-mark "La Normandi," or "Normandi," which is applied to a brand of cigars, and charge the defendant with infringement in using the words "E. P. Normanda," or "Normanda," or "Normandie," upon a brand of cigars made and sold by him. The complainant Stachelberg obtained, by assignment from one Asher Bijur, of New York, the exclusive right to use this trade-mark, and he subsequently conveyed the right to the firm of Stachelberg & Co., the complainants. It appears that Bijur was the originator of the trade-mark, and had used it for some years, building up quite an extensive sale for this brand of cigars by reason of their good quality. The original trade-mark bore the name of the maker, "A. Bijur," and also the initials "A. B." Upon the assignment of the trade-mark to Stachelberg, he substituted his own name, "M. Stachelberg," and the initials "M. S." In this form the trade-mark was registered by Stachelberg & Co. in 1876, under the United States law, which has since been declared unconstitutional. *Trade-Mark Cases*, 100 U. S., 82. In this case, therefore, the complainants stand on their common law rights.

The defendant denies the charge of infringement, and rests his defence on various grounds. Whatever may be thought of the remaining defences, there is one point which we think is well taken, and therefore fatal to any relief prayed for in the bill. In the use of the trade-mark the complainants do not state it was obtained by assignment or purchase from A. Bijur. Bijur originated the trade-mark, and it thus became a sign of the quality of the article he sold, and an assurance to the public that it was the genuine product of his manufacture. A trade-mark must, either by itself or by association, point distinctively to the origin or ownership of the article to which it is applied. *Canal Co. vs. Clark*, 13 Wall., 311. It imports that the article is made by the original proprietor, and therefore genuine, and the law protects the original proprietor, not only as a matter of justice, but to prevent imposition on the public. *Manhattan Medicine Co. v. Wood*, 108 U. S., 218; S. C., 2 Sup. Ct. Rep., 436.

Now, in order that the public may not be deceived, it is essential that an assignee or purchaser of the original proprietor should indicate in the use of the trade-mark that he is assignee or purchaser,—*Sherwood v. Andrews*, 5 *Amer. Law Reg. (N. S.)*, 588, —otherwise the public are misled into purchasing the goods of another manufacturer or vendor as those of the original proprietor. If these complainants have any right of action against the defendant, it is upon the ground that, by copying the trade-mark “La Normandi” in substance, he is misleading the public by false representations into the purchase of his cigars as those made by A. Bijur, the original proprietor of the trade-mark. *Canal Co. v. Clark, supra*. And so these complainants, in failing to give notice that they are the purchasers and assignees of the trade-mark from A. Bijur, are practicing the same deception towards the public which they charge against the defendant. The fact that the name “M. Stachelberger,” is attached to the trade-mark can no more relieve the complainants of the charge of misrepresentation as to the public than the use of the name “E. Ponce” or “E. P.” can relieve the defendant of such a charge. It is the use of the fanciful words “La Normandi,” or words of substantial similarity, that is calculated to mislead. The Supreme Court, in *Manhattan Medicine Co. v. Wood, supra*, declare that the object of a trade-mark being to indicate by its meaning and association the origin or ownership of the article, it would seem that when a right to its use is transferred to others, either by act of the original manufacturer or by operation of law, the fact of transfer should be stated in connection with its use, otherwise a deception would be practiced upon the public, and the very fraud accomplished, to prevent which Courts of Equity interfere to protect the exclusive right of the original manufacturer.

Under the rule laid down in *Manhattan Medicine Co. v. Wood*, the complainants have no standing in a Court of Equity, and the bill must be dismissed.

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CIRCUIT COURT OF COOK COUNTY, ILLINOIS.
IN EQUITY.

MCVEAGH, ET AL.

vs.

VALENCIA CIGAR FACTORY, ET AL.

DECIDED ———, 1885.

REPORTED 32 O. G., 1124.

“Buck Cigar” Case.

TRADE-MARK—ASSIGNMENT OF.

A trade-mark cannot be assigned as a mere abstract right and independent of or disconnected from the business in which it is used.

Messrs. Kraus & Mayer and *Mr. John H. Hammond*, for the complainants.

Messrs. Moses, Newman & Reed and *Messrs. Banning & Banning*, for the defendants.

MORAN, J.:

(Orally:) The bill in this case was filed to restrain the use of what is claimed to be a trade-mark—that is, the use of the word

“Buck,” in connection with certain figures on a scroll. The bill alleges that for many years prior to 1884, a certain firm styled Louis Cohn & Son, was engaged in the business of manufacturing and selling cigars at wholesale, and that as early as 1862, the firm, or one of the members of the firm, invented and first used this trade-mark in connection with the manufacture of a certain brand of cigars; that about the year 1884, the firm of Cohn & Son made a contract with the complainants for the purpose of manufacturing for the exclusive use of the complainants and sale by them of this certain brand of cigars having a certain trade-mark hereinafter referred to; that under the contract the complainants sold great quantities of the cigars manufactured for them by said Cohn & Son under that trade-mark; that some time in July, 1884, the firm of Cohn & Son became insolvent, and failed for a large amount, and had no visible assets; that among the creditors of the firm was Henry Oppenheimer, and that for the purpose of making some payment to him, the firm of Cohn & Son made a contract with Oppenheimer, by which they attempted to transfer or assign all the firm's right, claim, and interest to the trade-mark, which is described in this way:

“To the following trade-mark and all rights and interests thereunder of the said firm of Louis Cohn & Son, to wit, the ‘Buck’ trade-mark. The said trade-mark having, as hereinbefore alleged, been used by the firm of Louis Cohn & Son in connection with and as the name of a certain brand of cigars.”

The bill further alleges that Cohn & Son also by the contract guaranteed said Oppenheimer the sole and exclusive right to use said trade-mark and all the figures, pictures, and designs, which the said firm of Cohn & Son had theretofore used in connection with the trade-mark, and they agreed that all the rights transferred to Oppenheimer by said contract should inure to and belong to Oppenheimer's executors, administrators, and assigns; that said Cohn & Son also sold to Oppenheimer the exclusive right to sell cigars in connection with said trade-mark; that a true and correct copy of said contract is hereto attached and marked “Exhibit A.” The bill then goes on to allege that shortly after that sale to Oppenheimer, Oppenheimer sold to Franklin McVeagh

& Co., who are the complainants in this bill, in consideration of \$500, and transferred to McVeagh & Co., all the rights that he gained by the contract with Cohn & Son. It is alleged that the complainants had, while the cigar manufactured under the trade-mark had been furnished to them by Louis Cohn & Son, sold great quantities of it, and advertised it extensively, and that it came to be a well-known brand of cigars substantially through the efforts of complainants. The bill goes on, then, to allege that the defendants have started a factory for the manufacture of cigars, and that they have taken the same word "Buck," and put it upon their cigar-boxes, and have used substantially the same symbols—that is, they have used the two animals bringing their heads together in a belligerent attitude, and so on, in every respect similar to the label or alleged trade-mark designed by Cohn & Son. The allegation in the bill that Cohn & Son sold to Oppenheimer, and engaged to give to Oppenheimer the sole and exclusive right to manufacture cigars under that brand is not borne out—that is, that allegation of the bill, the bill referring as it does to a correct copy of the contract, the copy of the contract being filed controls the allegations of the bill, and the contract contains no sale whatever to Oppenheimer of any right to sell or manufacture cigars. When we examine "Exhibit A," it is a sale of the two trade-marks known, the one as "Buck" and the other as "Punch"—"said trade-marks having been used by us in connection with and as the name of certain brands of cigars, and hereby grant to Oppenheimer the sole and exclusive right to the exclusive use of the said trade-marks, and do further sell, transfer and assign to said Oppenheimer all the figures, pictures, and designs which we have heretofore used in connection with said trade-marks, and all the rights and interests hereby conveyed and transferred to said Henry Oppenheimer, shall inure to and belong to said Henry Oppenheimer, his executors, administrators, and assigns."

The contract does not attempt to protect the manufacture by Oppenheimer of any particular brand of cigars or any cigars at all. In fact the contract is simply a bare sale or attempted sale of a word which is undoubtedly a word capable of being used as

a trade-mark—that is, it is a fanciful word, an arbitrary term, applied to and used in connection with a certain article manufactured and sold, which word is not descriptive of the article, and is not used to designate the place where the article is manufactured; simply an arbitrary fanciful name which, it is well established by the authorities, may be adopted by any person and applied to his goods, and used by him to designate the ownership or origin of a particular brand or quality, it might be, of goods, and those goods may become known and get a reputation under that fanciful and arbitrary name.

Now, the question arising in this suit is not whether such a name can be a trade-mark, nor whether Louis Cohn & Son, as they allege, originated this trade-mark, designed it, and used it in connection with their manufacture and sale of cigars. Whether or not they had got a good trade-mark is not the question. Manifestly for all the purposes of this cause, it may be assumed, that in the hands of Louis Cohn & Son and in their use, and as applied by them to a brand of cigars manufactured by them, this was a trade-mark, in the use of which they would be protected by the operation of an injunction issuing from a Court of Equity. The sole question in the case is whether such arbitrary sign or trade-mark can be assigned or sold, no matter what the consideration may be, or be transferred as a bare sign, as a bare trade-mark, a word, a fanciful term, to some other person regardless of the question whether that person is engaged in the business of manufacturing the article in connection with which the term has been used, or regardless of the fact whether that person takes the good-will of the business, buys out the entire business, and takes the business in connection with which the sign or arbitrary trade-mark had been used.

I have examined very carefully all the authorities cited by counsel in the case, and the question seems to me to be free from all doubt. There is no case that can be found, none cited by counsel at all, which in any manner supports the proposition that a bare trade-mark, aside from the property, can be assigned, sold, or a good title given to it. The philosophy underlying the history of the law in connection with trade-marks, and the final ab-

solute recognition of trade-mark property, forbids the conclusion that anything of that kind can obtain. It is not necessary for me to go farther in the matter of this opinion than the elementary books on this question of trade-marks. In one of the cases the Court say:

“Inasmuch as the Court protects the owner of trade-marks, he is entitled to authorize another when he hands over his business to him to place that mark on his goods. That is a right which should be protected by a Court in Chancery, may be disposed of for value, may be bought and sold, and is, therefore, in that sense of the word property.”

That is the language of Vice-Chancellor Wood in *Ainsworth v. Walmsley*, (*Law Reports, 1 Equity*, 618). That language states as fairly, perhaps, as it has been stated, although it has been repeated by various Courts, the extent to which the Courts go. “He is entitled to authorize another when he hands over his business to him to place that mark on his goods.” Now, of course, that does not mean that he is to sell out his whole business, but if he has some particular or special article manufactured in a special manner, for which he has a trade-mark and to which he has acquired a property, and he sells out the right to another person to manufacture that particular article and to supplant him in the business of carrying the manufacture of that particular article under the trade-mark which he obtained. It is not necessary that a man should sell out his whole establishment to do that, but it must be the manufacture and sale of an article where there is some special method with reference to it, which could not, in the nature of the case, apply to the manufacture of cigars. They are a general commodity, and may be manufactured by any and all persons, with reference to which there is no specialty. The only advantage that can be gained by a name, by the use of a trade-mark, is in the particular excellence of that cigar, or its particular cheapness, its particular flavor, the particular tobacco of which he sees fit to manufacture it, not mixing it and not reducing its quality, so that the smokers acquire a taste for that particular cigar which is manufactured under that name, and which the consumer purchases under that name. Any person,

however, may manufacture the same cigar in the same way, and the right to manufacture a cigar in that way is not the subject of transfer. That is, a man could have no property in the right to the manufacture of a cigar in that way at all. The same question has been in various other ways stated by Chancellors. In substance, says Vice-Chancellor James:

“There is no distinction between the sale of the business or good-will by a trader himself and the sale by his assignees in bankruptcy. Therefore in the sale of a business by a trader’s assignees in bankruptcy, the trader has no right to open a store after his discharge and use the trade-marks of his old business, or in any other way to represent himself as carrying on the identical business which was sold out, although he has a right to set up again in business of the same kind next door to his old place of business. In such a case it is one objection that a purchaser might come for the assistance of a Court in Chancery, alleging that he has continued to use the name of the old business which he found there—that is, the application of a trade-mark to a business that had some fanciful name. The property in a trade-mark passes by assignment and by the operation of law to any one who takes at the same time the right to manufacture and sell the particular merchandise to which said trade-mark has been attached. There is no property in it as a mere abstract right. (*Dixon Crucible Company v. Guggenheim*, 2 *Brewster*, 321). Property in a trade-mark may be obtained by transfer from one who has made the primary acquisition, though it is essential that the transferee should be possessed of the right either to manufacture or sell the merchandise to which the trade-mark has been attached.”

In *Browne on Trade-Marks*, the question has been treated, and the rule as it has been deduced from the cases is, “that the property or right to a trade-mark may be passed by assignment or by operation of law to any one who takes at the same time the right to manufacture and sell the particular merchandise to which such trade-mark has been attached. As a mere abstract right having no reference to any particular person or property, it is conceded that it cannot exist and so cannot pass by assignment or descend to a man’s legal representatives. A trade-mark and the right to a trade-mark accrue to the owner from its adoption and use for

the purpose of designating the particular goods which he manufactures or sells, and indeed has no separate abstract existence, but is appurtenant to the goods designated."

It is not necessary to multiply authorities on the rule. The authorities point all one way. The authorities supposed to deviate in any respect from this established rule, which I have read, will be found on a close examination to support the rule instead of to depart from it. Now, in this case there was no sale to either Oppenheimer or McVeagh & Co. of a factory where this "Buck" cigar was made, or of the business of Louis Cohn & Son. To say that the sale to McVeagh & Co. was a right to sell, under the name of "Buck," any cigars that they saw fit to put into the box under the name of "Buck," would be simply to say that the contract undertook to give to McVeagh & Co. the exclusive right to use that word "Buck" for the purpose of imposing upon the public, because to allow them to sell any brand of cigars under the name of "Buck," would be to allow them to use the reputation gained by Louis Cohn & Son under that name to sell something else, perhaps, which of course would not be supported at all by the authorities. So that it comes to this: The bill is based solely upon the transfer of a bare fanciful term or word in connection with the scroll and device that was used by Louis Cohn & Son, to a person for that person to sell and use as if it were his property. It might as well be sold to a doctor as to be sold to a man carrying on the grocery business. The transfer of it to a physician or surgeon or to a livery stable keeper, would pass it just as completely as it can possibly pass in an assignment by such a contract. It is not necessary in this opinion for the Court to say whether the defendants have any trade-mark or not. That is, outside of this case, and it is of no consequence. The point is whether there is any trade-mark now in existence that is the subject of property to any person which can be protected by any operation of a Court of Chancery. If there is any such property it is not in these assignees. They could not gain it under the circumstances, and, therefore, as the bill is demurred to the demurrer, must be sustained, and the injunction must be dissolved.

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SUPREME COURT, STATE OF WISCONSIN.
IN EQUITY.

HILL

vs.

LOCKWOOD, AND ANOTHER.

DECIDED 3 MARCH, 1885.

REPORTED 22 N. W. R., 581.

“Clysmic Water” Case.

1. Affidavits on which an order restraining defendant from acts alleged to be an infringement of plaintiff's trade-mark, and a breach of his contract, considered, and order affirmed, without deciding the case on its merits.
2. Preliminary injunction restraining the use of plaintiff's trade-mark will not be dissolved. Where plaintiff's legal title is clear and the infringement is manifest.

APPEAL from Circuit Court, Waukesha County.

Appeal from an order denying a motion to dissolve a temporary injunction, granted at the commencement of the action upon *ex parte* affidavits. The plaintiff owns a parcel of land in the

village of Waukesha, on which there is a spring, the water of which, as she alleges and the defendants admit, is valuable for its curative qualities. She purchased this land in January, 1879, of Warner and Showerman, at the instigation (as she alleges) of the defendant Lockwood, who then had a contract with her grantors for the purchase of the water from the spring, at a stipulated price, for exclusive sale by him in certain States. After plaintiff made the purchase she entered into a contract with Lockwood to sell him such water at the same price, and gave him the exclusive right to sell the same for 20 years. She agreed not to sell the water to any other person during that term. Lockwood did not expressly agree to purchase any specific quantity of the water. At the time the contract between Lockwood and the plaintiff's grantors was made, (which was in May, 1878), and before it was executed, the parties agreed that the spring should be named "Clysmic." It is described in such contract as the spring of Warren and Showerman, "now called and to be known as the Clysmic Spring." Under both contracts the owners of the spring shipped the water thereof from time to time, as required, to Lockwood, at New York City, in barrels labeled "Clysmic," and he carbonated and bottled the water, placing it upon the market, and made large sales thereof. The bottles containing it were marked "Clysmic," and Lockwood advertised it extensively as "Clysmic Water," from Waukesha Springs. He also duly registered that name as his trade-mark in the United States Patent Office, soon after he entered into such contract with the plaintiff. Afterwards Lockwood purchased a small piece of land adjoining the land of the plaintiff, dug a well thereon, found water, and in February, 1884, commenced shipping the same from such well to New York, which he there bottled and sold as "Clysmic Water," the same as he did the water from plaintiff's spring. From that date he shipped the same quantity from each source every alternate week, and when the action was commenced, had used 600 barrels from his own well. The contract price with plaintiff was one dollar per barrel.

The plaintiff maintains that the name "Clysmic" is a trade name applied to her spring, of which she is the proprietor; that

Lockwood has no legal right to use it in connection with the sale of water from his well, or from any source other than the spring on her land; and that his unauthorized use of it as aforesaid is a fraud upon her which ought to work a forfeiture of the contract. The demand for judgment is that the contract be declared forfeited and abandoned by Lockwood, by reason of such alleged fraud; also for damages and an injunction. An accounting is demanded as to the amount of water which he has sold from his own well under such trade name. The defendant French is the agent and manager of Lockwood's business at Waukesha, in charge of his well and the plaintiff's spring, and is made a party to the action solely for that reason. The Circuit Judge granted a temporary injunction restraining the defendants from using the name "Clysmic" in the sale of any water other than that drawn from the spring on plaintiff's land. The defendants moved, on verified answers and affidavits, that the injunction be dissolved. The motion was resisted, and many other affidavits were read in opposition thereto. The Court made an order denying the motion, which is the order appealed from.

Jenkins, Winkler and Smith and C. H. Van Alstine, for respondent.

Finches, Lynde and Miller, for appellants.

LYON, J.:

The chief purpose of this action is to procure the cancellation of the contract between the plaintiff and Lockwood. The claims for an accounting and for damages are merely incidental, and are comparatively of minor importance. Whether Lockwood has committed any fraud upon the plaintiff which may work a forfeiture of his contract with her, depends upon the question whether, under the contract he has the right to affix the name "Clysmic" to water from his own well for sale in the market. The contract does not, in express terms, confine his use of that name to water taken from plaintiff's spring; but the plaintiff maintains that to be the spirit of the contract, and the clear meaning and intention of the parties thereto, manifested by the

history of Lockwood's connection with the spring, by various provisions in such contract, as well as in his contract with Warner and Showerman, and by all the surrounding circumstances under which both contracts were made.

1. The case comes before us on *ex parte* affidavits alone, for the pleadings are nothing more. For this reason we are very reluctant to pass upon the merits of the controversy on this appeal. Indeed, it would be improper to go any further in that direction than we are compelled to go, in order to determine the appeal. Otherwise we might unjustly prejudice the rights of one or the other of the parties on the final hearing. Mere *ex parte* affidavits are, at best, a very unsafe basis for judicial action. They are usually drawn by counsel, and are frequently sworn to by affiants without a clear knowledge of their contents. Thus we have in the record before us an affidavit to a fact made by a person, and another affidavit of the same person denying the fact first sworn to, and stating that he did not understand the contents of his first affidavit. Besides, the affidavits here are in direct conflict on some points, which seem to us now to be quite material to a correct determination of the case on its merits. For example, the complaint alleges that the curative properties of the water of plaintiff's spring had been well known for several years before 1878, and the owners had shipped to, and sold the same in, different parts of the United States during all those years. Also that as early as 1877 the same was so shipped to New York City, in barrels, marked "Clysmic." All this is denied in the answers, and in the affidavits read in support of the motion to dissolve the injunction. It is stated therein that Lockwood first discovered the efficacious qualities of the water in the fall of 1877, and that in May, 1878, he "discovered, invented, adopted, and appropriated" as his own the word "Clysmic," as his trade-mark and symbol, to distinguish as his, and as sold and dealt in by him, all mineral waters which he might thereafter place upon the market.

It is further stated in some of the affidavits that Lockwood induced the plaintiff to purchase the spring, and enter into the contract with him, by promising to use his best effort to establish and

extend the business of selling the water, and by assuring her that when the contract should expire, she would have a spring with a name and reputation of great value. 'This is substantially denied in the opposing affidavits. The affidavits are so conflicting, inconclusive, and unsatisfactory, on what we now regard as material questions of fact in the case, that we deem it our duty, as an act of justice to all the parties, to abstain from determining the merits of the action on this interlocutory appeal any further than is absolutely necessary to the decision of the questions presented by such appeal. We must, of course, determine whether the complaint states sufficient facts to authorize the allowance of a temporary injunction.

2. The learned counsel for the defendant invokes the rule that "it is only when the legal title is clear that a Court of Equity will interfere by injunction to restrain the use or colorable infringement of a trade-mark." We are of the opinion that the allegations of the complaint show a clear legal right in the plaintiff to the exclusive use of the trade name "Clysmic," and hence that the injunction was properly allowed in the first instance.

We are not prepared to hold that the affidavits read on the hearing of the motion to dissolve the injunction, considering all of them on both sides, as well as the pleadings, sufficiently disprove the plaintiff's right to an injunction, so as to render it the duty of the Court to dissolve it. We believe it the safer and better course to let the injunction stand until the proofs are in. The Court can then determine the facts intelligently, but cannot do so on these affidavits alone. We come to the conclusion the more readily because the learned Circuit Judge so held, and because the injunction is of but little importance to Lockwood. He still has control of plaintiff's spring, and can continue to have all the water therefrom required in his business. There is no claim that the supply is insufficient. He is only restrained from selling the product of his own well as "Clysmic Water." If the trial of the cause results in establishing his right to do so, probably the cost of the water taken from plaintiff's spring, which, but for the injunction, he would have taken from his well, will be as-

essed as damages in proceedings on the undertaking for the injunction. True, Lockwood claims more serious injury, but the injury complained of is more properly the result of the effort to annul his contract.

The order of the Circuit Court denying the motion to dissolve the injunction is affirmed.

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CIRCUIT COURT UNITED STATES, NORTHERN
DISTRICT OF ILLINOIS. IN EQUITY.

LEHIGH VALLEY COAL COMPANY*vs.*

HAMBLEN, AND OTHERS.

DECIDED 9 MARCH, 1885.

REPORTED 23 FEDERAL REP., 252.

“*Lehigh Valley Coal Co.*” Case.

1. TRADE-NAME—FOREIGN CORPORATION ASSUMING SAME NAME—INJUNCTION.—A United States Circuit Court cannot interfere by injunction, at the instance of a corporation organized under the laws of another State, and prevent any necessary step from being taken, under the Statute of the State in which such Court is located, in the creation of a corporation bearing the same name as the foreign corporation.
2. SAME—RELIEF, WHEN GRANTED.—Whether relief could be granted after the creation of the corporation, and use of the name of the foreign corporation in fraud of its rights, is not determined.

F. Ullmann, for complainant.*Beck & Roberts*, for defendants.

GRESHAM, J.:

The complainant company was organized under the laws of Pennsylvania, in 1875, for the purpose of mining anthracite coal in that State, and selling the same there and elsewhere. It owns valuable coal mines in Pennsylvania, and does a large and lucrative business. For a number of years it has had an extensive and profitable business in the West and Northwest; and for convenience in the management of that business it has maintained an agency at Chicago, where it owns real estate, including a dock worth \$200,000, and has on hand coal worth \$400,000. The defendants in this suit, wishing to create a corporation in Illinois, bearing the same name as the complainant, to carry on the same business, filed their articles of association with the Secretary of State on the twenty-sixth of December, 1884, under the general laws of Illinois, authorizing the creation of corporations. The Secretary of State thereupon issued to the defendants a license as commissioners to open books for subscription to the capital stock of the new corporation, to be known as the Lehigh Valley Coal Company. This suit was brought to prevent the defendants, by injunction, from receiving stock subscriptions, or taking any other steps necessary to be taken under the statute, in the creation of the new corporation.

The object of the defendants in causing an Illinois corporation to be created, bearing the same name as the complainant company, is obvious. They hope, by this means, to secure the benefit of part, at least, of the patronage which the complainant has acquired. Unwilling to engage in open, manly competition with the complainant and others carrying on the same business, the defendants resort to a trick or scheme whereby they hope to deceive the public, and obtain an unfair advantage of the complainant. Such conduct might be fairly characterized more harshly; and it is with extreme reluctance that I deny the complainant the relief prayed for.

The complainant is a foreign corporation, and it is only by comity that it is doing business in Illinois at all. The State can say to it any day "Go!" and it must go. That being so, I do not see that the complainant has a legal right to say a corpora-

tion shall not be created in Illinois bearing its (the complainant's) name. If the State of Illinois may create a corporation bearing the same name as the complainant,—and it certainly can,—this Court has no right by injunction to prevent anything from being done under the State law which is necessary in the creation of such a corporation. The commissioners perform a function under the laws of the State in the formation of the corporation. If they are not officers of the State they are instrumentalities employed by the State. If they can be enjoined from receiving stock subscriptions under the license issued to them by the Secretary of State, I do not see why the latter might not be enjoined from issuing a license, or doing anything else under the State statute. The general law authorizing the Secretary of State to issue a license to commissioners to receive stock subscriptions provides that no license shall be issued to two or more companies having the same name. Before bringing this suit the complainant should have brought to the attention of the Secretary of State the matters alleged in the bill. He might, on a proper application, have revoked the license to the defendants, unless they adopted another name for their company. I do not think this Court can interfere by injunction, at the instance of a foreign corporation, and prevent any necessary step from being taken under the statute of this State in the creation of a corporation.

I do not say what may be done if the defendants succeed in creating their corporation bearing the complainant's name, and a suit shall be brought by the complainant to prevent individuals claiming to be officers or managers of such corporation from interfering with the complainant's business, as already stated.

The temporary injunction heretofore granted is dissolved, and the bill is dismissed.

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UNITED STATES CIRCUIT COURT, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

HOLT, ET AL.*vs.*MENENDEZ, ET AL.

DECIDED 13 MARCH, 1885.

REPORTED 32 O. G., 136.

“La Favorita” Case.

1. A junior partner retiring from a firm is held to have retained no interest in a trade-mark used by the firm and originated by its senior member, particularly when the weight of evidence indicates that he released all right to their brands.
2. A casual and fortuitous use of the trade-mark by another for a short time will not impair the right of one who subsequently adopted it and gave it celebrity.
3. The use of a trade-mark for flour by one who selects and sells flours manufactured by others is a valid use.
4. As the complainant here is in laches in bringing suit, (eleven years after knowledge of the infringement,) and as the circumstances justified the defendant in believing that he was licensed by silence, the relief granted must be limited to an injunction.

Mr. S. St. J. McCutchin and *Mr. Rowland Cox*, for the complainants.

Mr. John Henry Hull, for the defendants.

COXE, J.:

This is an action to restrain the infringement of a trade-mark. The complainants are engaged in the flour and commission business in the City of New York, under the firm-name of Holt & Company. The firm was organized forty years ago, and, with the inevitable changes wrought by time, has continued in the same business ever since. In 1861 they commenced to use, and have since continuously used, to distinguish a certain flour prepared by them, the trade-mark in question—"La Favorita." The trade-mark was registered in the Patent Office February 28, 1882.

The defendants, admitting the use of the name "La Favorita," contend that they are privileged to use it for the reason that the flour sold by them was procured from S. Oscar Ryder, who from 1861 to 1869 was a member of the firm of Holt & Company, and thus acquired a right to the trade-mark, which, in the absence of an express relinquishment, he retained after his withdrawal from the firm. The defendants insist, also, that the use of the words "La Favorita" as a brand for flour did not originate with the complainants; that as they use it to distinguish flour manufactured by others and merely selected by them, there can be nothing to support a trade-mark; and, finally, that whatever rights the complainants once had have been forfeited by inexcusable laches in asserting them.

1. The position that Ryder retained an interest in the trade-mark after his connection with the firm had been severed cannot be maintained. Holt & Company was a firm of character and influence. For years it had preserved its credit and good name unshaken and unimpaired. The trade-mark "La Favorita" was originated—so far, at least, as the New York market was concerned—by its senior member. The brand was inseparable from and almost synonymous with Holt & Company. Whatever value it had was due to the exertions and reputation of the members of the

firm. Its meaning as a brand for flour had been imparted to it by them. The moment its use became general, it ceased to be valuable. Ryder had been a clerk, and from that position was promoted to a partnership. His retirement was an event of but little more importance than the change of a book-keeper or salesman. The firm still lived. It was the intention of the remaining partners to continue to transact the old business in the old way. That Holt & Company, desiring to retain the good-will of the firm unimpaired, should have permitted Ryder to despoil them of the distinguishing brands upon which their success largely depended without a word of remonstrance is hardly creditable; but when to the presumption thus arising is added, the positive testimony that at the time of his withdrawal Ryder expressly released all right to the copartnership brands, followed by his equivocal denial, it is very clear that the defence based upon his title must fail. Proof and probability unite in pointing to this conclusion.

Regarding the defence of want of originality, it must be said, in addition to the fact that it is not pleaded, that the evidence relied on is not free from uncertainty and doubt. But even should the finding be made that a few years before it was adopted by Holt & Company the name "La Favorita" was used at St. Louis as a brand for flour, it must also be said that the use was casual and fortuitous and continued for a short period only.

2. As a distinguishing brand for flour at St. Louis it was soon abandoned and forgotten. There is no merit in the proposition that the complainants' trade-mark cannot be sustained for the reason that the flour is not manufactured by them.

The proof is uncontradicted that selection and classification require skill, judgment, and expert knowledge, and add value and reputation to the flour when made by those in whom purchasers have confidence. The case of *Godillot v. Harris*, (81 N. Y., 267), seems conclusive upon this point. Upon the question of laches, however, I am constrained to say that the complainants' conduct has been such that the relief granted must be limited to an injunction. Ryder commenced using the brand in 1869, and has used it continuously since. That the complainants knew

of this—certainly as early as 1871—is not disputed. That they protested at all is denied.

4. Certainly there was no vigor or courage shown by them until just prior to the commencement of this suit, in 1882. That they did not consent is true; but it is equally true that, for men who believed their rights invaded, their course was inconsistent and misleading. Ryder might well have imagined that they did not intend to call him to an account. The circumstances were such as to justify the belief on his part that he was licensed by silence to use the trade-mark. It would be inequitable to compel him to pay for its use during the long years that the complainants slept upon their rights. In endeavoring to reach a just result the Court should not overlook the fact that the delay in commencing the suit was unreasonable, and that some of the evils of which the complainants complain are attributable to their own laches in this regard. The facts seem to bring the case within the doctrine of *McLean v. Fleming*, (96 U. S., 245).

There should be a decree in favor of the complainants for an injunction, with costs.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

LECLANCHE BATTERY COMPANY

vs.

WESTERN ELECTRIC COMPANY.

DECIDED 27 MARCH, 1885.

REPORTED 23 FEDERAL REP., 275.

"Leclanche Battery Co." Case.

1. TRADE-MARK—NAME OF NEW ARTICLE—RIGHT TO USE OF.—When an article is made that was theretofore unknown, it must be christened with a name by which it can be recognized and dealt in; and the name thus given to it becomes public property, and all who deal in the article have the right to designate it by the name by which alone it is recognizable.
2. SAME—NAME, WHEN NOT A TRADE-MARK.—A name alone is not a trade-mark when it is applied to designate, not the article of a particular maker or seller, but the kind or description of thing sold.
3. SAME—IMITATION OF LABELS—INJUNCTION.—Although the name applied by a complainant to his goods may not afford protection as a trade-mark, where others are guilty of imitating the labels used by him in making sales thereof, they will be enjoined.

157 Leclanche Battery Co. *vs.* Western Electric Co.

Dickerson & Dickerson, for complainants.

Geo. P. Barton, for defendant.

WALLACE, J..

The complainants cannot maintain their claim to the exclusive right to use either the word "Disque" or "Pile Leclanche" as a trade-mark, when applied to the batteries manufactured and sold by them. As owners of the right to manufacture and sell the Leclanche batteries until the expiration of the patent granted to the assignee of Leclanche, they have been accustomed to use the word "Disque" on the labels pasted on the glass jar which forms part of the battery. and the word "Pile Leclanche" blown in the glass. Neither of these words are arbitrary names selected to denote the article as the production of a particular proprietor. They are appropriate, and are intended to indicate that the batteries are of a specified form, and are made according to the patent of Leclanche. "Disque" describes the form of the battery, and is used to distinguish it from the prism and other forms of porous-cup batteries. "Pile" is synonymous with battery, and "Pile Leclanche" is the designation in French of Leclanche's battery.

1. When an article is made that was theretofore unknown, it must be christened with a name by which it can be recognized and dealt in; and the name thus given to it becomes public property, and all who deal in the article have the right to designate it by the name by which it is recognizable. *Hostetter v. Fries*, 17 *Fed. Rep.*, 620; *Singer Manuf'g Co. v. Stanage*, 6 *Fed. Rep.*, 279. As soon as Leclanche invented his battery in France, it was necessarily given the name "Pile Leclanche," and that name could never again be appropriated exclusively as a trade-mark even by the inventor himself.

2. A name alone is not a trade-mark, when it is applied to designate, not the article of a particular maker or seller, but the kind or description of thing which is being sold. *Singer Manuf'g Co. v. Loog*, 15 *Reporter*, 538; *Wheeler & Wilson Manuf'g Co. v. Shakespear*, 39 *Law J. Ch.*, 36; *Young v. Macrae*, 9 *Jur.*, (N. S.), 322; *Canal Co. v. Clark*, 13 *Wall.*, 311.

3. The defendants have imitated the label of the complainant to the minutest details, except the signature at the bottom. The complainant is entitled to protection against the unlawful competition in trade thus engendered by the simulation of its label; and upon this ground a decree is ordered in its favor.

See *Willcox & Gibbs Sewing Machine Co. v. The Gibbens Frame*, 17 *Fed. Rep.*, 623; *Burton v. Stratton*, 12 *Fed. Rep.*, 696, and note, 704; and *Shaw Stocking Co. v. Mack, Id.*, 707, and note, 717.—ED.

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CIRCUIT COURT UNITED STATES, DISTRICT
OF RHODE ISLAND. IN EQUITY.

FLEISCHMANN, AND OTHERS,

vs.

STARKEY.

DECIDED 14 MAY, 1885.

REPORTED 25 FEDERAL REP., 127.

“Yellow Label” Case.

TRADE-MARK—COLOR OF LABEL APART FROM NAME OR
DEVICE.

The color of a label, apart from a name or device, cannot be the subject
matter of a trade-mark.

Chas. E. Mitchell and *Oscar Lapham*, for plaintiffs.

C. H. Johnson and *C. F. Parkhurst*, for defendant.

COLT, J.:

The complainants are the owners of certain trade-marks used upon their packages of compressed yeast, and they charge the defendant with an unlawful imitation of the same. It is clear,

on a comparison of the labels, that the defendant is not guilty of any infringement unless the use of a yellow colored label makes him chargeable. The petition is taken by the complainants that the essential part of their trade-marks consists of a label having a yellow color, and that, therefore, they cover all yellow colored labels used upon compressed yeast, and that the use by the defendant of a yellow colored label upon the compressed yeast made and sold by him constitute an unlawful imitation of their trade-marks. The defendant has taken no testimony. The evidence of the complainants goes to prove that yeast with a yellow label sells readily, while yeast with a white label, or any color other than yellow sells with difficulty,—the cause of this being the reputation acquired in the market of the article manufactured by the complainants; and, further, that the public are deceived into buying other and inferior yeast having a yellow label as the genuine yeast made by them. This case narrows itself down to the question whether a label of a single color, like the one in controversy, is the lawful subject of a trade-mark apart from any name, figure, or device with which it may be connected, so that a person who adopts a similar color upon his label may be charged with an unlawful imitation. Color often serves as the ground-work of a trade-mark, and it may be a very essential element in its composition. In determining the question of infringement it is often a very important circumstance. *Browne, Trade-Marks*, 263, 265, 267. But the term “mark” implies form rather than color, and it consists of some peculiar name, symbol, figure, letter, or device whereby one manufacturer distinguishes his goods from like goods sold by other persons. *Falkinburg v. Lucy*, 35 Cal., 52. The color of a label, apart from a name or device, can hardly be the subject-matter of a trade-mark. The effect would be that a single manufacturer might acquire the exclusive right to the use of labels of a certain color, or to the colored paper in which his goods might be wrapped. This might seriously interfere with trade and with legitimate competition. *Browne, Trade-Marks*, 127, 272. Whatever view may be taken by the French Courts in the cases referred to by the learned counsel for complainants, we know of no American or English authority which goes to this extent. On

the contrary, so far as the point has been touched upon in the adjudicated cases which have come to our notice, an opposite conclusion seems to have been reached. *Falkinburg v. Lucy, supra; Faber v. Faber, 49 Barb., 357.*

It follows that the defendant, in using a label of a yellow color, is not guilty of any infringement of complainants' trade-marks, and that the bill should be dismissed.

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CIRCUIT COURT UNITED STATES, NORTHERN
DISTRICT OF ILLINOIS. IN EQUITY.

SOUTHERN WHITE LEAD COMPANY

vs.

CARY, AND OTHERS.

DECIDED 10 OCTOBER, 1885.

REPORTED 25 FEDERAL REP., 125.

"Southern White Lead Co." Case.

1. TRADE-MARKS—INFRINGEMENT OF.—The complainant in a trade-mark suit is entitled to relief, if the marks or brands used by the defendants sufficiently resemble the complainants' marks or brands to be mistaken for them.
2. SAME—INJUNCTION.—An injunction should be granted if the defendants adopt the brand for the purpose of selling their goods as and for the goods of the complainant, or for the purpose of enabling others to do so, and the complainant has been injured or is likely to be injured thereby. In such case it will not be sufficient for the defendants to show that no deception is in fact practiced on those with whom they deal personally; but an injunction will be granted if consumers to whom the goods are intended to be resold are or may be deceived.
3. SAME—USING NAME OF PLACE TO DECEIVE.—Where manufacturers at one place falsely mark or brand their goods as manufactured at

another, for the purpose of inducing trade which would otherwise go to manufacturers at such other place, such false marking will be considered as fraudulent, and a "resort to a palpable trick," and, the complainant being injured thereby, the infringing manufacturers will be enjoined from thus using the name of the place where the complainant carries on its business.

Banning & Banning, for complainant.

Dent, Black & Cratty Bros., for defendants.

GRESHAM, J., (*orally*).

The complainant is a large manufacturer of white lead at St. Louis. It stamps or stencils upon the upper end or head of its kegs the words "Southern Company, St. Louis." These words encircle the head of the keg; St. Louis forming the lower half of the circle, and "Southern Company" the upper half; and they enclose the words "Warranted strictly pure white lead in pure linseed oil." The complainant uses another brand or mark, in addition to the one already described, by simply stenciling a red crescent upon the upper half of the head of the keg. St. Louis has an established reputation for the manufacture and sale of pure white lead, and the complainant has had and maintained for years a large trade at that place as a manufacturer of this article. The evidence clearly shows that the complainant's lead is pure. The defendants are manufacturers of white lead at Chicago. They brand upon the heads of their kegs "Southwestern, St. Louis;" surrounding the words "strictly pure white lead;" and the words "Southwestern, St. Louis," appear in the same form as the words "Southern Company, St. Louis," appear upon the complainant's keg, and the letters are the same in size and appearance. The crescent, however, does not appear on any of the defendants' kegs. The defendants also paste upon the sides of their kegs a label containing the words: "The white lead in this package is guaranteed strictly pure, ground in bleached oil, and for purity, whiteness and durability is not excelled by any lead manufactured."

It is shown by analysis, and not denied, that while the complainant's manufacture is unadulterated and free from impurities, the defendants' contains on an average only 50 per cent. of lead. The complainant claims a trade-mark in its two brands, one with-

out the red crescent, and the other with it; and this bill is filed to enjoin the defendants from infringing the first of these trade-marks.

I shall not stop to inquire whether the complainant's claim to trade-mark is or is not well-founded, as I think it is entitled to an injunction on another ground. The defendants so brand the heads of their kegs as to naturally mislead and induce persons purchasing for consumption to suppose they are purchasing the complainant's lead, when they are getting an inferior article. The brand used by the defendants is so like the complainant's as to induce the public to mistake the one for the other. The defendants sell their goods to retail dealers, and it may be that such dealers are not deceived, but they sell to consumers who are or may be deceived.

1. The complainant is entitled to relief if the brand used by the defendants sufficiently resembles the complainant's brand to be mistaken for it, and the defendants adopted their brand for the purpose of selling their kegs as the kegs of the complainant, or for the purpose of enabling retail dealers to do so, and the complainant has been injured by this fraud, or is likely to be injured by it.

The complainant manufactures its genuine white lead at St. Louis, and its reputation is already established as a manufacturer and dealer of this character.

3. The defendants manufacture their adulterated and greatly inferior lead at Chicago; and stamp upon their kegs a false brand in imitation of the complainant's brand. Why is this done unless it be in the hope of deceiving the public and injuring the complainant? Realizing that they could not engage in open, manly competition with the complainant, the defendants resort to a palpable trick. If this resulted in no injury to the complainant, or was likely to result in no injury to it, the bill would have to be dismissed. But the affidavits show that the defendants' kegs can and have been sold as the complainant's.

2. A temporary injunction will be granted restraining the defendants from branding upon their kegs the words "Southwestern" and "St. Louis."

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SUPREME COURT, STATE OF CONNECTICUT.
IN EQUITY.

ROGERS & BROTHER*vs.*C. ROGERS & BROTHERS.

DECIDED 30 OCTOBER, 1885.

REPORTED 1 NEW ENG. REP., 411.

"Rogers" Case.

1. Where, in a suit by persons using "Rogers & Bro. A 1," as a trade-mark, to restrain the use of "C. Rogers & Bros. A 1," by others, the *finding* of the Court below was that the word "Rogers" is the only misleading character, and that the manner of using the marks is that employed in the trade generally, the Appellate Court, being controlled as to the facts, by the findings, cannot say, as matter of law, that the use of the mark sought to be enjoined is misleading.
2. The fair and honest use of one's own name, in the ordinary course of business, in the manner in which other manufacturers of similar goods are accustomed to use their names, in the preparation for sale, or sale of goods, cannot be enjoined; although a possibility may exist that the goods of one will be purchased to some extent by persons who knew no distinction, or even supposed them to be the goods of another.

APPEAL from a judgment of the Superior Court, refusing an injunction.

The plaintiff is a Waterbury corporation having a partnership name. The defendants are a Meriden partnership in name and in fact, consisting of three brothers of the name of Rogers. The plaintiff makes silver-plated spoons, forks, and knives, stamping them in the usual way and places with the name in an abridged form, prefixed by a star and followed by a mark to indicate that they are "A No. 1" in quality, the whole mark being "*Rogers & Bro., A 1."

The defendants, having been for many years in the silver-plating business, have recently commenced making spoons and forks, which they stamp, in the usual way and place, with their own name and the customary mark of high quality employed by spoon and fork makers, their mark being "C. Rogers & Bros., A 1."

The complaint alleges that the plaintiff has a trade-mark, of which the name "Rogers" is the vital part, and charges a fraudulent infringement of the plaintiff's rights by the defendants.

The complaint was served August 8, 1883, together with an injunction issued by the Judge of the Hartford City Court. On motion, the injunction was suspended until the Superior Court, should be in session. A substituted complaint was filed on the opening of the Superior Court, other pleadings following. The case was then heard on the merits; the issues were found for the defendants; the complaint was dismissed; the injunction was dissolved. This appeal was thereupon taken.

Messrs. O. H. & J. P. Platt, for plaintiff.

"Rogers & Bro. A 1," stamped on the back of the shank of forks and spoons, and upon the blades of knives, has become and is a pure, technical, legal trade-mark, the right to use which is the plaintiff's property. That one may have a trade-mark in a specific and particular use of his name, either separately or in combination with words, symbols or devices, in connection with his goods, is abundantly sustained on principle and by the authorities. *Singer v. Wilson*, *Cox Man. Tr.-M.*, 477; *Cloth Co. v. Cloth Co.*, *Id.*, 223; *Upt. Tr.-M.*, 102.

What constitutes a trade-mark? It is the appropriation and use by a trader of some name, symbol, device, or combination, which he may lawfully appropriate and use to mark his goods, so that when people see the goods so marked they will know them to be his goods. *Bradbury v. Breton*, *Cox Man. Tr.-M.*, 320; *Singer v. Kimball*, *Id.*, 413; *Stokes v. Langraff*, *Id.*, 121; *U. S. v. Stiffens*, 100 *U. S.*, 82, (*XXV, Law Ed.*, 550).

By the English Act, the "Name of an individual or firm, printed, impressed or woven in some particular and distinctive manner," constitutes a trade-mark. *Sebast. Tr.-M.*, 18.

The recent English and American cases recognize the right of a trade-mark in a man's name, when the elements of the Trade-Mark Act are wanting. The whole progress of trade-mark law has been and still is toward more ample and complete protection. *Hall v. Barrows*, *Cox Man. Tr.-M.*, 215; *Cloth Co. v. Am. L. C. Co.*, *Id.*, 223; *Ainsworth v. Wamsley*, *Id.*, 257; *Fulton v. Sellers*, *Id.*, 279; *Rogers v. Rogers*, *Spurr & Co.*, 11 *Fed. Rep.*, 445; *Thorley v. Massam*, 42 *L. T. Rep.*, *N. S.*, 851; *Sebast. Tr.-M.*, 25.

In the case of *Meriden Britannia Co. v. Parker*, in which the defence insisted that a personal name could not be a trade-mark, expressly held that the combination "1847, Rogers Bros., A 1," constituted the plaintiff's trade-mark, and as expressly held that the use by Parker of the stamp "C. Rogers & Bros., A 1," was an infringement. The stamp of the present plaintiff, referred to in the opinion, is unhesitatingly called a trade-mark and decided to be entitled to protection. *Meriden Brit. Co. v. Parker*, 39 *Conn.*, 450.

There are cases holding that a geographical descriptive or generic name cannot be made a trade-mark, and it is largely upon the reasoning in such cases that the claim is urged that a personal name cannot become a trade-mark. *Canal Co. vs. Clark*, 13 *Wall.*, 311, is specially cited for this purpose, but there is no parallel between such cases and this case. The manufacturer's name is always used to inform the public by whom the goods are made; it necessarily implies origin and ownership; but a geographical, generic, or descriptive name can have primarily no such

significance. To stamp spoons "Waterbury," "German Silver," "Silver-Plated," would not primarily identify them as the goods of any particular maker, consequently such names want the first element of a trade-mark; but the use of the manufacturer's name is the strongest possible assertion that he is the maker of the goods on which it is stamped, consequently the best name for a trade-mark. But when a geographical, generic, or descriptive name comes by use and association to tell who makes the goods to which it is attached, it becomes a good trade-mark. Up to that moment it is true that any one may use it; after that moment no one may use it in a manner as to pass his goods as the goods of another. *Stokes v. Langraff, supra*; *Wotherspoon v. Currie, Cox, Man. Tr.-M.*, 329; *Newman v. Alvord, Id.*, 282; *McAndrew v. Bassett, Id.*, 234.

If a trade-mark in one's name is property, no one, whatever his name, whatever his business, whatever his intent, may take, appropriate or injure it. The fact that one bears a name, a certain use of which makes it easy to appropriate the property of another, is a specially valid reason why he should be carefully guarded in the use of his name, rather than be given special opportunity to possess himself of what truly belongs to us. It is a reason why the Court should be strict in the administration of equity. *Stokes v. Langraff, Cox, Man. Tr.-M.*, 131; *Blackwell v. Wright, Id.*, 466; *Bradbury v. Beeton, Id.*, 320; *Gilman v. Hunnewell, Id.*, 541; *Ainsworth v. Walmsley, Id.*, 257.

The true rule as to what a man in business may do under and with the name which he has chosen as a business designation, is well stated by Judge Lowell in *Rogers v. Rogers, Spurr & Co.*, 11 *Fed. Rep.*, 495: "Even if we grant all that has been said about the freedom to use names, and I grant upon that subject much more than has been argued for; I set no limits to that freedom, except interference with acquired rights; the books are full of cases in which defendants have been restrained from the use of their names in a way to appropriate the good-will of a business already established by others of that name."

The case is in this respect analogous to that of *Williams v. Brooks*, 50 *Conn.*, 278-280. There the trade-mark was the plaintiff's name.

“In combination with pink and yellow wrappers, well-known to the trade. * * * All manufacturers of hair-pins put them in ounce packages, combining the ounce into pound, and the pound into packages in pink and yellow paper.”

The defendants put up curvilinear hair-pins in pink, and plain hair-pins in yellow wrappers, and in ounce packages, and printed on such pink and yellow wrappers that the hair-pins were manufactured by L. B. Taylor & Co., Cheshire, Conn. The pink and yellow wrapper was certainly as common to the hair-pin trade as the stamping of the maker's name is to the spoon trade. They were not necessary to the hair-pin trade. Nor is stamping the owner's name necessary to the spoon trade.

Ch. J. Hargis, of the Kentucky Court of Appeals, concluding his opinion in the case of *Avery & Son v. Mickle & Co., March, 1883, 27 Official Gaz., No. 10, p. 1027*, comprehensively sums up the law applicable to this case and all cases: “In conclusion, we repeat, that this law grows out of the common principle of justice that the rights of each should be so used as not unnecessarily to injure those of others, whose skill has made their goods valuable in their reputation, that finally compensates them for their enterprise, industry and fidelity.”

There is nothing in the adjudged cases which authorize the defendants to stamp “C. Rogers & Bros. A 1,” on their articles, either because it inheres in their name, or because it is a necessity of their business, if the effect is the probable misleading of purchasers, and consequent injury of the plaintiff.

The defendants mainly rely on *Burgess v. Burgess*, 17 Eng. L. & E., 257; *Meneely v. Meneely*, 62 N. Y., 427; *Carmichael v. Latimer*, 11 R. I., 395; *McLean v. Fleming*, 96 U. S., 245, (XXIV, Law Ed., 822); *Clark v. Clark*, 25 Barb., 76; *Faber v. Faber*, 49 Barb., 358, *Comstock v. Moore*, 18 How. Pr., 424, and on the reporter's note to *Meriden Brit. Co. v. Parker*, 12 Am. Rep., 401.

A careful examination of these cases will show that none of them are cases in which the plaintiff seeks to have the defendant enjoined against the use of a stamp on goods claimed to infringe the plaintiffs' trade-mark stamp. 12 Am. Rep., 401, expressly

says that neither *Meneely v. Meneely*, nor *Faber v. Faber*, were trade-mark cases.

In addition to the cases already cited, in which Judges have distinctly said that a trader's name used in connection with his goods might become a good trade-mark, the following are cited in which the defendants have been enjoined against the use of their own names in a way calculated to deceive. *Croft v. Day*, 7 *Beav.*, 84; *Metzler v. Wood*, L. R., Ch. D., 606; *Fullwood v. Fullwood*, L. R., 9 Ch. D., 176; *Levy v. Walker*, L. R., 10 Ch. D., 436; *McLean v. Fleming*, *supra*; *Howe v. Howe Machine Co.*, 50 *Barb.*, 236; *Shaver v. Shaver*, 54 *Iowa*, 208; *Thorley Cattle Food Co. v. Massam*, 42 *L. T. Rep.*, N. S., 851.

In *Gilman v. Hunnewell*, 122 *Mass.*, 139, label and stamp are placed on the same footing. "A person may have a right in his own name as a trade-mark, as against a person of a different name, but he cannot have such a right against another of the same name, unless the defendant uses the form of a stamp or label so like that used by the plaintiff, as to represent that the defendant's goods are those of the plaintiff's manufacture."

McLean v. Fleming, *supra*, is directly to the point that proof of intentional fraudulent result is unnecessary, and if the case is understood to say that there was no legal trade-mark as against the defendants in that case, the fact that the injunction was granted, although no intention to defraud was shown, makes it perfectly conclusive. *Filley v. Fassett*, 44 *Mo.*, 173; *Dale v. Smithson*, 12 *Abb. Pr.*, 237; *Dixon C. Co. v. Guggenheim*, *Am. Tr.-M. Cas.*, 559; *Amoskeag Co. v. Spear*, 2 *Sandf. Super. C.*, 599.

The recent English cases are very clear on this question. *Thorley's Cattle Food Co. v. Massam*, *supra*; *Orr, Ewing & Co. v. Johnston & Co.*, 40 *L. T.*, (N. S.), 307.

Our Connecticut cases had reached the same point earlier, and hold that evidence of fraudulent design or intent is unnecessary. It is the result with which the Court deals; the act is the same, the injury the same. *Bradley v. Norton*, 33 *Conn.*, 157; *Holmes v. Holmes, etc. Mfg. Co.*, 37 *Conn.*, 278; *Meriden Brit. Co. v. Parker*, 39 *Conn.*, 450; *Williams v. Brooks*, 50 *Conn.*, 278.

The rule, and the just rule, is that whatever a defendant does to cause his goods to be mistaken for the goods of another will be prohibited. The defendant must sell his goods as his own, not as the goods of another. *Seixo v. Provezende*, 12 Jur. N. S., 215; *Kinnehan v. Bolton*, 15 Irish Ch., 75; *Harrison v. Taylor*, Am. Trade-Mark Cases, 675; *Gillott v. Esterbrook*, Am. Tr.-M. Cas., 340; *Ewing & Co. v. Johnston & Co.*, *supra*.

An apparently serious claim is made by the defence, that the plaintiff is not entitled to relief, because it has made representations with respect to its trade-mark which are untrue.

It would seem, after the decisions in *Meriden Brit. Co. v. Parker*, and *Rogers v. Rogers, Spurr & Co.*, to be unnecessary to dwell on this claim.

In the former case the claim was made that the mark itself told an untruth as to who manufactured the goods, and in the latter case the claim was based upon the assertion that the plaintiff, by circulars and advertisements, induced the public to believe that the original Rogers Brothers, or some of them, were still in the plaintiff's service.

It is not claimed, in this case, that the trade-mark in itself does now or ever did contain an untruth.

As to the matter of price-lists, circulars and advertisements, they contain nothing which is materially deceptive, and the rule respecting such statements is well expressed by Judge Lowell, in *Rogers v. Rogers, Spurr & Co.* See also, *Curtis v. Bryan*, 36 How. Pr., 33; note to *Pidding v. Howe*, Am. Tr.-Mark Cases, 640; *Davis v. Kennedy*, 13 Can. Ch., 523.

In *Holmes, Booth & Haydens v. Holmes, Booth & Atwood Mfg. Co.*, 37 Conn., 278, the Court practically held the latter corporation must take care, in the selection of its name, not to infringe upon the rights which a prior corporation had to use its corporate name in business. See also, *Newby v. Oregon Cent. R. Co.*, *Deady*, 609.

Mr. C. R. Ingersoll, for defendants.

There has not been adduced out of the multitude of trade-mark cases, in this country or Great Britain, a single one in which a

person has been enjoined, under any circumstances whatever, from stamping his own name, simply and in the ordinary way, upon the goods of his own manufacture. On the contrary, the cases are numerous where such an injunction has been refused, even where the purpose of the person so stamping his goods was manifested, by accompanying *indicia*, to be deceptive.

In *Holloway v. Holloway*, 13 *Beav.*, 209, there was a clear case of fraudulent purpose, but the Master of the Rolls limited his injunction to the misleading additions and refused an injunction against the name.

In *Burgess v. Burgess*, 17 *L. & Eq.*, 257, the defendant was clearly induced by the popularity of the old concern to go into the same business, and he was enjoined from certain misleading acts, but he was allowed to use his own name with whatever advantage might belong to it.

In *Meneely v. Meneely*, 62 *N. Y.*, 427, the Court says, that "If the evidence showed any attempt by the defendants by means of catalogues or by other contrivance to induce the belief that the firm of Meneely, or the managers of the plaintiff's foundry, these acts might have been restrained," but not the use of the name.

In *Clark v. Clark*, 25 *Barb.*, 79, there was a wrongful purpose evidenced by misleading devices accompanying the name, and the use of the device was enjoined, but not the use of the name.

And the law, in this respect, is correctly summed up by the annotator to *Meriden Brit. Co. v. Parker*, 12 *Am. Rep.*, 401. Although a deceptive purpose is shown by the use of misleading marks or devices or affirmative acts, accompanying the name, "The use of such mark or device or the practice of such acts will be restrained, but not the use of the name."

In *James v. James*, *L. R.*, 13 *Eq.*, 421, the label complained of was "Lieut. James' Horse Blister." The inventor of the article was Lieut. Robert James. The defendant was named Robert Joseph James. He made the article known as "Lieut. James' Horse Blister," put on it that label, with the name of Robert James, dropping the Joseph. The Court says: "The defendants must not lead the public to suppose that this is actually the manu-

fracture of Lieut. James himself; they must put the words Robert Joseph James on their labels, and they must not make the labels so much alike as to make them appear to denote that the article is made by Robert James. The expression in the plaintiffs' advertisement that none is genuine without the signature of the proprietors is on the top label of every pot, to counterfeit which is forgery. This is perfectly true. All that any other person is entitled to, is to put his own name on the top of the pot."

In *Fullwood v. Fullwood, L. R., Ch. Div., 176*, the plaintiff's firm was R. J. Fullwood & Co., and the defendants E. Fullwood & Co. They were both manufacturers of annatto. The descriptive cards and wrappers of the defendants were enjoined, but not the use of the name. The Court says: "Of course, I need not say that the defendants are entitled to carry on their business under the firm which they have adopted, if they are so minded, and to carry it on where and as they like, provided that they do not represent themselves to be carrying on the business which has descended to the plaintiff. But it appears to me that in the cards and wrappers which the defendants are proved to have used, they have been attempting to represent that the business which they carry is now the proprietor."

There is another class of cases referred to in this discussion, but which clearly have no bearing upon the question just considered. They are cases like *Meriden Brit. Co. v. Parker; Holmes, Booth & Haydens v. Holmes, Booth & Atwood; Rogers Co. v. Rogers and Spurr*. These are not cases of a defendant stamping his goods with his own name. On the contrary, in each of those cases, the defendants took for that purpose the name of the plaintiff, or a name resembling the plaintiff's, when they either had a different name of their own, or, as in the case of the corporations, they could just as conveniently have taken some other name than a name resembling the plaintiff's. The name which was thus taken, was for the party taking it a sham name, and therefore deceptive.

The "*Thorley's Cattle Food Case*," *Massam v. J. W. Thorley's Cattle Food Co.*, 42 *L. T., N. S.*, 851, combines the characteristics of several classes of cases already adverted to, where

the fraudulent method of a defendant in carrying on his business, so as to represent it to be the business of the plaintiff, has been restrained. A careful examination of that case will show those characteristics to be:

1. The assuming a name resembling the plaintiff's, for the purpose of carrying on a competing business, as in *Rogers v. Spurr*, and *Holmes, etc. v. Holmes, etc.* J. W. Thorley was taken into the defendant company for the purpose of a figure head.

2. The false representations by means of labels, advertisements and method of putting up the packages of goods, which accompanied the trade words, "Thorley's Cattle Food," by which the impression was given to the public that the "Thorley" in those words was the plaintiff and not the defendant, as in the class of cases represented by *Holloway v. Holloway*.

3. The fact that the term "Thorley's Food for Cattle" had come to have a commercial meaning, designating an article, which was only made at the plaintiff's factory, as in the "*Glenfield Starch Case*." James, L. J. says, "Thorley's Food for Cattle" meant that food which for many years was manufactured at works belonging to Joseph Thorley, and afterwards was manufactured by his executors carrying on his business at the same works. "Thorley's Food for Cattle never became an article of commerce as distinguished from the particular manufactory from which it had proceeded."

The "*Glenfield Starch Case*," *Wotherspoon v. Currie*, 5 (*L. R. Eng. and Irish App.*), *H. L.* 508, relied on by James, L. J., in the *Thorley Food Case*, is a case where a right of trade-mark was allowed in the name of a locality combined with the article.

The case is not entirely reconcilable with the decision by the Supreme Court of the United States, in the *Canal Co. v. Clark*, 13 *Wall.*, 311, (80 *U. S. Bk.* 20, *Law Ed.*, 581); but the differences do not concern us here.

There are two facts clearly found by the Court in this case, and upon them the decisions is based.

1. "The word 'Glenfield' had acquired a secondary signification or meaning in connection with a particular manufacture; in short, it had become the trade denomination of the starch made

by the appellants. It was wholly taken out of its ordinary meaning." It was "a name which had become exclusively a designation of an article manufactured by the appellants."

2. The defendant's use of the word was a sham, and as he used it, told a falsehood. His true place of business was in Paisley, not Glenfield.

And the Court enjoined the falsehood. It was the case of a man's assuming a name not his own, because it resembled the plaintiff's.

The decision has no application to the facts of the present case, because: 1. The word "Rogers" on a silver-plated spoon cannot have any other meaning than the ordinary meaning, that the spoon was manufactured by some person of that name. 2. The defendant, having no other name than "Rogers," cannot tell a falsehood when he stamps the spoons of his manufacture with that name.

One of the very latest trade-mark cases in the English Courts, *Singer Mfg. Co. v. Loog*, 1880, *L. R.*, 18 *Ch. Div.*, 399, plaintiff's counsel, who were among the most eminent at the English bar, made this concession in argument: "In order to justify the use by the defendant of the name of a rival trader, in connection with the articles which he sells, he must show either that he himself has a right individually to the name, or that the article in question is a specific article, known by a specific name, and that as in the case of Wellington boots or Hansom cabs, he is unable to designate the article in any other way than by its known name."

Messrs. Charles E. Mitchell and George A. Fay, also for defendants.

A trade-mark is a mark applied to articles of trade to tell the buyer who the maker is. A business man, or a business corporation having a personal name, instead of an arbitrary symbol, cannot be heard to complain, because other persons, having the same name, adopt the same business and conduct it in the usual way. See *Meneely v. Meneely*, 62 *N. Y.*, 427; *Carmichael v. Latimer*, 11 *R. I.*, 395; *McLean v. Fleming*, 96 *U. S.*, 245, (*Bk. 24, Law*

Ed., 822); *Burgess v. Burgess*, 3 *De G., M. & C.*, 904; *Croft v. Day*, 7 *Beav.*, 84; *Holloway v. Holloway*, 13 *Beav.*, 209; *Clark v. Clark*, 25 *Barb.*, 76; *Faber v. Faber*, 49 *Barb.*, 358; *Comstock v. Moore*, 18 *How. Pr.*, 424; *Decker v. Decker*, 52 *How. Pr.*, 218; *Devlin v. Devlin*, 67 *D.*, 176; *Stonebraker v. Stonebraker*, 33 *Md.*, 252; *Gilman v. Hunnewell*, 122 *Mass.*, 139; *Meriden Brit. Co. v. Parker*, 39 *Conn.*, 450; *Holmes, Booth & Haydens v. Holmes, Booth & Atwood Mfg. Co.*, 37 *Conn.*, 278; *Williams v. Brooks*, 50 *Conn.*, 280; *Wm. Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co.*, 11 *Fed. Rep.*, 495.

The affix "A 1" is a quality mark. The finding says: "The mark 'A 1' has been frequently used by manufacturers of such ware for many years as a mark of quality, and is so regarded in the trade." The finding is conclusive upon the question of fact, because: "When any mark, symbol, or device, is used merely to indicate the name, quality, style or size, of any article, it cannot be protected as a trade-mark." *Boardman v. Meriden Brit. Co.*, 35 *Conn.*, 413.

But the combination "A 1," cannot be lawfully appropriated for any other purpose than to indicate quality.

In *Shaw Stocking Co. v. Mack*, 12 *Fed. Rep.*, 711, Coxe, J., says: "It is very clear that no manufacturer would have the right exclusively to appropriate the figures 1, 2, 3 and 4, or the A, B, C and D, to distinguish the first, second, third and fourth quality of his goods respectively. Why? Because the general signification and common use of these letters and figures are such that no man is permitted to assign a personal and private meaning to that which has, by long usage and universal acceptance, acquired a public and generic meaning."

In *Candee v. Deere*, 54 *Ill.*, 439, it was held that no exclusive right could be claimed in the letters and figures "A No. 1," "A X No. 1," "No. 1," "X No. 1," "No. 3," and "B No. 1," used to designate the different qualities of the plows.

In *Mfg. Co. v. Trainer*, 101 *U. S.*, 55 (*Bk.* 25, *Law Ed.*, 995), the Court says of the letters A. C. A., used in addition to the manufacturer's name: "Used in that device to denote only quality, and so understood, they can be used by others for a simi-

lar purpose equally with the words 'superior' or 'superfine,' or other words, or letters or figures having a like signification."

Only numbers arbitrarily selected can be appropriated to indicate origin and thus become parts of lawful trade-marks.

In *Boardman v. Meriden Brit. Co.*, 35 Conn., 402, the numbers were arbitrarily selected and it was expressly found that the "spoons were known by their respective numbers, and more generally ordered, bought and sold by the numbers on the labels." See also, *Lawrence Mfg. Co. v. Lowell Hosiery Mills*, 129 Mass., 325, 327; *Gillott v. Esterbrook*, 48 N. Y., 374.

The plaintiff has no lawful trade-mark. The most satisfactory definition of a trade-mark is that contained in *High on Injunction*, 672. "A trade-mark is a particular sign or symbol, which by exclusive use, becomes recognized as the distinguishing mark of the owner's goods and for the protection of which the aid of equity may be invoked."

A mere possibility of mistake, no Court can guard against. "All that Courts of justice can do, in that regard, is to say that no trader can adopt a trade-mark, so resembling that of another trader, as that ordinary purchasers buying with ordinary caution are likely to be misled." *McLean v. Fleming*, 96 U. S., 251, (Bk. 24, Law Ed., 830).

Again: "We hold, therefore, that if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same; if the resemblance is such as to deceive an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other." *Gorham Co. v. White*, 14 Wall., 528, (81 U. S., XX, Law Ed., 737).

STODDARD, J., delivered the opinion of the Court :

As we understand the findings and rulings of the Superior Court, practically, the only question left for the determination of this Court is in respect to the plaintiff's exclusive right, as against these defendants, to stamp the word "Rogers" upon silver-plated flat ware, such as knives, forks, spoons, etc. In considering this subject it must constantly be borne in mind that all questions of

fact are finally disposed of by the Superior Court, and that this Court cannot, even by inference, supplement such finding, or supply omitted facts. Under our practice, this Court is controlled by the finding as it comes to us. The case stands upon an answer denying the material allegations of the complaint, and in so far as the Superior Court omitted to find the allegations and claims true they must be regarded as not proved.

The defendants stamped upon the shanks of spoons and forks manufactured by them the combination of words "C. Rogers & Bros. A 1." The plaintiff's stamp is "Rogers & Bro. A 1." The finding states in detail the use by several different partnerships or corporations of stamps all bearing the common distinctive word "Rogers," and differing from each other in all other material respects except in the use of this common and conspicuous word "Rogers," one concern using a stamp with the word "Rogers" alone. The finding then proceeds: "By reason of the numerous stamps on spoons, forks and knives, containing the word 'Rogers,' as before mentioned, and of the efforts of the various concerns who have used such stamps since 1847 to promote the sale of their goods as 'Rogers' goods,' the word 'Rogers' has become the conspicuous and familiar part of such stamps with a large class of retail buyers; and while jobbers and dealers and those retail buyers who are informed of the facts, readily distinguish between the stamps of the different manufactories by the words or symbols which such stamps do not possess in common, those retail buyers of the articles who buy by the stamps or the single article look only to the word 'Rogers,' and are for this reason liable to confound the various stamps; but generally the retail buyers who desire any information on the subject of the make of the goods rely upon the dealer for such information."

It appears from the extract that there are two governing facts: 1, that the word "Rogers" is the conspicuous, familiar, material and valuable thing in the various so-called trade-marks; 2, that the stamps of the defendant is liable to be mistaken for that of the plaintiff because of the use of the word "Rogers," and by that limited class alone who "look only to the word 'Rogers.'" And again the case states: "Between the stamps so used by the de-

endants and the stamps used by the plaintiff upon similar articles manufactured by them, respectively, the dealers and jobbers in such articles have no difficulty in distinguishing. And this is also true of those retail buyers who look beyond the word 'Rogers.' But those who regard the word 'Rogers' only, would be liable to confound one with the other, as is the case of the various 'Rogers' stamps before mentioned. Retail buyers sufficiently acquainted with the various 'Rogers' stamps in the market to distinguish between the same would have no difficulty in distinguishing between the two stamps of plaintiffs and defendants; but the general resemblance between the two stamps is such that a person knowing that of the plaintiff and not knowing that of the defendants might, upon referring to it, but not reading it attentively, mistake it for that of the plaintiff. Thus, with reiteration the Court below emphasizes the fact that the word 'Rogers' is the controlling word, the one thing that is the basis of all possible confusion or mistake in the use of two stamps."

There is no finding nor suggestion of fact that any other part of the defendants' stamp is answerable in any degree for that liability of mistake. If any other part of the stamp, in configuration, collocation or combination of words, figures or symbols, or in other respects, contributed, in any manner, to deceive possible purchasers, and enable the defendants to sell their goods as those of the plaintiffs, it should so have been found by the trial Court. This Court cannot find such facts, from an inspection of the stamp itself. This is not a case where this Court can pronounce as matter of law that the defendants' stamp in other particulars so resembles that of the plaintiff's as to amount to a representation that the goods are the plaintiff's goods. In this particular the case at bar differs from many of the cases cited in briefs of counsel. In some of the English cases relied upon, and in other instances, the Court determined from the evidence in the particular case whether the stamp was of objectionable character, thus exercising a combined jurisdiction over fact and law. In our Courts, as before stated, these jurisdictions are separated, the fact being committed to the Superior Court, and the law to this Court.

It is said that "this stamp, 'C. Rogers & Bros. A 1' is stamped upon the backs of the shanks of the spoons and forks in the same manner and place as plaintiff's goods are and have been stamped." This is undoubtedly an evidential fact, from which the trial Court might, in connection with other circumstances, have found a liability to deceive, on account of the location and peculiar characteristic of the defendants' stamp, but the Court has not so found; presumptively the evidence did not warrant that conclusion; and, on the contrary, the Court repeatedly tells us that the word "Rogers" alone is the only possible misleading character. And further; we are informed that "the method of stamping their name upon such articles manufactured by them, and the locality of the stamp upon the article, has been that commonly employed by manufacturers of such silver-plated articles for many years. The mark 'A 1' has been frequently used by manufacturers of such ware for many years as a mark of quality, and is so regarded in the trade." Manifestly, upon this condition of facts, in the absence of finding that the location of the stamp, combining with its form, might have a misleading effect, we cannot say, as matter of law, that it does have that possible effect, particularly in view of this finding, that the location of the stamp is common to the trade, and the addition of the mark of quality, "A 1," is commonly used by manufacturers as a quality mark. We feel constrained by the facts in the case to say that there is no foundation laid for the claim that we should rule as matter of law that the judgment of the Superior Court was erroneous, so far as that judgment relates to the stamp in question in other respects than the use of the word "Rogers."

This appeal raises the question of error or no error upon the facts found, and "When, therefore, on such appeal, the record omits to present facts essential to the case of the appellant, this Court can simply affirm the judgment, and cannot remand the case to the lower Court for amendment, or a further hearing or finding." *Schlesinger v. Chapman*, 52 Conn., 273.

Has this plaintiff, as against this defendant, an exclusive right to the use, in its stamp, of the word "Rogers?" Upon this branch of the case there is one further fact stated as follows: "The

purpose of the defendants in stamping their firm-name upon the spoons, forks and knives so manufactured by them, has been to indicate to the public that they are the manufacturers of the goods so stamped. But the defendants, in commencing the manufacture of such articles, had in view the popularity in the market of such goods bearing a stamp containing the word 'Rogers,' and an inducement to commencing such manufacture was the advantage they might derive from having their goods so stamped." And then the Court finds: "The allegations of fraudulent design and acts on their, defendants', part, contained in Articles 11, 12, 13, 14, 15, and 16 of the complaint, are found to be not true." The 11th Article contains an allegation that the defendants, "with intent to defraud" the plaintiffs sent their goods into the market with marks closely resembling the claimed trade-marks of the plaintiff. By Article 12 it is stated that by the external shape and appearance of the goods, together with the stamp and mode of selling, the defendants caused their goods to resemble the plaintiffs'. Article 13 contains an allegation that the defendants' stamp is a close imitation of plaintiffs', and is an infringement of their trade-mark and is well calculated to mislead and deceive and does deceive purchasers and induces them to buy the defendants' goods, supposing them to be of plaintiffs' manufacture. Article 14 alleges that the defendants' goods will become known as "Rogers'" goods, and that thereby purchasers will be led to buy the defendants' goods, believing them to be plaintiffs'; and by Article 15 it is alleged that the defendants fraudulently stamp the word "Rogers'" on their goods, intending it to operate as a fraud upon the public, upon unwary purchasers and upon the plaintiffs, in the ways above set forth, etc. So far the trial Court has wholly negatived the claim of the plaintiffs that the defendants were actually fraudulent in the use of their stamp, and that such stamp was intentionally used to personate the plaintiffs' goods, notwithstanding popularity of goods marked "Rogers," and that derived from so stamping their goods. But in saying that the allegations of fraudulent design and acts on their part, contained in Article 16 of the complaint, are found to be not true, the trial Court goes further than to deny the assertion of active, personal, intentional,

fraudulent design and counterfeiting, and negatives the statement contained in that article.

Article 16 is as follows: "That, by reason of the facts aforesaid the use of the word 'Rogers,' either as a whole or a part of their stamp upon spoons, forks and knives must and will, under the fixed circumstances inevitably infringe upon the plaintiffs' lawful enjoyment of the use and benefit of its trade-marks aforesaid, and must and will induce and cause unwary purchasers and others to purchase the spoons, forks and knives of the defendants, stamped with the word 'Rogers,' either as the whole or as a part of their stamp, in place of and supposing them to be spoons, forks and knives manufactured by the plaintiff, to the great injury of the plaintiff and in fraud of its rights." In this article there is no statement of active fraud, or intention of misrepresenting the defendants' goods to be those of the plaintiff, but only a statement that, inevitably, any use, no matter how honest and customary, of the word "Rogers" in the stamp, will induce and cause unwary purchasers to purchase goods of the defendants' make, but supposing them to be plaintiffs', and therefore any use of the word "Rogers" in such stamp, by the defendants, is thus constructively fraudulent. This conclusion and assertion of the plaintiffs, so stated, is denied by the trial Court. The plaintiffs' case is stripped, by the finding, of every fact collateral or additional to the mere use of the word "Rogers" in the stamp.

The plaintiffs' claim, as thus stated, is surely not warranted by any decided case or the authority of any text writer brought to our attention. Substantially all the leading and governing facts and characteristics of the recent English case of *Massam v. Thorley's Cattle Food Co., L. R., 14 Ch. Div., 748*, a case that is largely relied upon by the plaintiffs, are eliminated from the plaintiffs' case. A few citations from the several opinions in *Massam v. Thorley's Cattle Food Co.* will indicate how fundamentally different was that case from the case with which we are dealing. And it should be borne in mind that this English Court was considering questions of fact upon the evidence in the case. P. 155: "Thorley's Food for Cattle" meant that food which for many years was manufactured at works belonging to Joseph

Thorley, and afterwards was manufactured by his executors carrying on his business at the same works. P. 156: We have heard nothing like a satisfactory explanation of how J. W. Thorley's Company came into existence, unless it was that the promoters thought that Thorley's food was a very profitable thing and had got a great reputation, and that they should like to steal the reputation which it had acquired. In order to do that they somehow or other got into communication with a brother of the late Joseph Thorley, who for some years had been in the service of Joseph Thorley, and during those years, according to his own account, which I take to be true, had acquired a knowledge of the recipe and of the manufacture, but who, for several years previous to the existence of this company, had never had anything to do with the manufacture of food for cattle. Having the name of Thorley, which was the distinguishing mark of the food for cattle, he either tendered himself for sale, or was found for purchase by some persons, in order that his name might be got into a joint stock company formed for the sake of selling these goods. Why was that name got in there except for the purpose of inducing the world to believe that it was the same concern or that it was the Thorley; that it was the same Thorley, or a continuation of the same Thorley, whose name was the principal characteristic of the name of the article? The name of the company is, to my mind, a fiction. The meaning which the name of "J. W. Thorley & Co., Limited," would convey to any person's mind is that there had been a partnership of J. W. Thorley & Co., a real partnership, which had been carrying on business in the manufacture of this food for cattle, and that, for some reason or other, such as we have seen constantly in our experience in this Court, the partnership had been minded to convert itself into a limited company for the more convenient transaction of its business. * * * I am, therefore, of opinion that in this case what the defendant company have done has been calculated to deceive, and I am bound to say, in my judgment, I have no doubt was from the first intended to deceive the persons purchasing the article which Joseph Thorley had formerly manufactured at the works which had attained the great reputation which Thorley's manufacture appears to have obtained.

Baggallay, L. J., said: "I do not profess to say whether J. W. Thorley, if honestly carrying on business on his own account in the manufacture and sale of this article, might not call it 'Thorley's Food for Cattle,' provided he took proper precaution to prevent it being supposed that the article he was so manufacturing was manufactured by the representatives of Joseph Thorley, but I feel satisfied that the company has no right whatever to use that name. I am strongly inclined to the opinion, though it is unnecessary to decide that, according to the view of Lord Westbury in '*Glenfield Starch*' Case: the expression 'Thorley's Food for Cattle,' indicates the trade denomination of the article manufactured by the particular person; but even on the assumption that the defendant company had not only the right to manufacture this article, but to call it 'Thorley's Food for Cattle,' I have come to the conclusion on the evidence, that they adopted such a mode of endeavoring to push that article in the market, as to induce many persons to entertain the reasonable belief that the article they were so putting upon the market had been manufactured by the representatives of Joseph Thorley."

Bramwell, L. J., said: "The complaint of the plaintiffs is not that the defendants made and sold the same article that the plaintiffs made, but that it was sold in such a way as to induce purchasers to believe that it was the article manufactured by the establishment which was Joseph Thorley's and now is carried on by his executors. The learned counsel for the defendants admit that if that is so there is a cause of action against them and that they must be restrained from doing it. The question, therefore, is one of fact: was the trade so carried on by the defendants as to give rise to that belief? It appears to me almost impossible to entertain a doubt upon that question."

James, L. J., finally announced that an injunction would issue, and Mr. Glasse, who was of counsel, said: "But it is not the substance of your Lordship's judgment that they are not to use the word Thorley in connection with their cattle food?" James, L. J.: "We cannot prohibit their using the name if they use it in a way not calculated to mislead the public."

Quotations are made at such length from this case because of the importance apparently attached to it by the plaintiffs. It will be seen that the case was regarded as one where a joint stock company had assumed the name of "Thorley" with the preconceived design of inducing the public to believe that their manufacture was that of the plaintiff, with the intent to pirate the marks of origin of the plaintiff's goods. In this view the English case goes no further than this Court in *Holmes, Booth & Hayden v. Holmes, Booth & Atwood Mfg. Co.*, 37 Conn., 278. Further, as indicated by their opinions, the Judges strongly leaned to the position that "Thorley's Food for Cattle" had, under the evidence in the case, come to indicate the trade denomination of the article manufactured by secondary meaning, wholly apart from its ordinary and apparent meaning, assimilating, in this particular, to the *Glenfield Starch Case* in *Wotherspoon v. Currie*, 5 H. L., 508.

Lastly, the English case, as the final and determinate view of the case, was treated as a case of intentional false representation by the defendants, in their method of advertisement by labels, and method of packing goods and carrying on their business. This is shown by the refusal of the Court to enjoin the use of the word "Thorley" absolutely in the cattle food business, and permitting its use so long as that use was not calculated to mislead. The rationale of the decision of *Massam v. Thorley's Cattle Food Co.* is that it was a case of actual intentional misrepresentation. The scope and limit of the ruling in *Massam v. Thorley*, in regard to the use of the name Thorley, is fixed by the decision of the same Court in *Thorley's Cattle Food Co. v. Massam*, in which the Court protected by injunction the "Thorley's Cattle Food Company" in the prosecution of its business in that name against circulars and advertisements of the defendants, the executors of Joseph Thorley.

Both James and Baggally, L. J's, in *Massam v. Thorley's Cattle Food Co.*, refer approvingly and as containing the gist of the law, to the language of Lord Justice Turner in *Burgess v. Burgess*, 3 D. M. & G., 896: "No man can have any right to represent his goods as the goods of another person; but in applications of this

kind it must be made out that the defendant is selling his own goods as the goods of another. Where a person is selling goods under a particular name, and another person not having that name is using it. It may be presumed that he so uses it to represent the goods sold by himself as the goods of the person whose name he uses; but where the defendant sells goods under his own name, and it happens that the plaintiff has the same name, it does not follow that the defendant is selling his goods as the goods of the plaintiff. It is a question of evidence, in each case, whether there is false representation or not."

Considered in the ordinary course of trade, it is a contradiction of terms to say that a man selling goods under his own name sells them as the goods of another, even if that other have the same name. The cases seem to require some element of false representation other than that implied in the fair, honest and ordinary use of a person's own name.

An examination of the following and kindred cases, wherein the use of a person's name has been regulated, will show that in most instances conscious, intentional, fraudulent misrepresentation, on the part of the defendant had been resorted to; in others, there was such a combined use of the name with other marks, characters, figures, or form and arrangement of circulars, advertisements, etc., as to amount to a false representation, and the combination only was enjoined. No instance can be found where the use of the name only, in good faith, has been stopped. See *Croft v. Day*, 7 Beav., 84-90; *Holloway v. Holloway*, 13 Beav., 213; *Clark v. Clark*, 25 Barb., 78; *Sykes v. Sykes*, 3 Barn. & C., 541; *Metzler v. Wood*, L. R., 8 Ch. D., 179; *Devlin v. Devlin*, 69 N. Y., 214; *Landreth v. Landreth*, 22 Fed. Rep., 41; *Shaver v. Shaver*, 54 Iowa, 213; *Stonebraker v. Stonebraker*, 33 Md., 268; *Williams v. Brooks*, 50 Conn., 278; *Meriden Brit. Co. v. Parker*, 39 Conn., 450.

Upon the other hand there has been, from the first to the present time, a general consensus of judicial opinion that the use of a personal name in a fair, honest and ordinary business manner, could not be prevented, even if damage resulted therefrom. *Croft v. Day*, 7 Beav., 84; *Holloway v. Holloway*, *supra*; *Bur-*

gess v. Burgess, 3 *D. M. & G.*, 896; *Faber v. Faber*, 49 *Barb.*, 357; *Clark v. Clark*, 25 *Barb.*, 80; *Meneely v. Meneely*, 62 *N. Y.*, 427; *Comstock v. Moore*, 18 *How. Pr.*, 424; *Gilman v. Hunnewell*, 122 *Mass.*, 139; *McLean v. Fleming*, 96 *U. S.*, 252, (*Bk.* 24, *Law Ed.*, 831); *Carmichael v. Latimer*, 11 *R. I.*, 395; *Landreth v. Landreth*, 22 *Fed. Rep.*, 41; *Singer Mfg. Co. v. Loog*, *L. R.*, 18 *Ch. Dig.*, 412.

Other cases and *dicta* might be cited, but it is deemed unnecessary.

In one brief filed for the plaintiffs it is said that they make no exclusive claim to the word "Rogers;" but he couples with that disclaimer a statement that the word "Rogers" is the conspicuous and valuable part of their mark; and that any use of it by the defendant, in the ordinary way of manufacturers, by stamping their goods with it, either alone or in any combination, will indubitably produce results which they are now striving to prevent; and in the brief filed by the other counsel, the broad claim is made that the word "Rogers" used as a stamp should be stopped. And, as we have before said, this is the only contention left to the plaintiff by the finding of the Court below.

In conclusion, we think there is neither authority nor reason in support of the doctrine that the fair, honest use of the name can be enjoined, when it is used in the ordinary course of business, in the way and manner in which other manufacturers of similar goods are accustomed to use their own name in the preparation for sale, or sale of goods; that such a rule would operate in restraint of trade and prohibit a person from using the ordinary means that all are entitled to use in the prosecution of business enterprises; that such use contains no element of false representation or personation in any just and true sense; and that while it may be true that a possibility exists that the goods of one will be purchased to some extent by persons who either know no distinction, or even by the occasional few who suppose them to be the goods of another; this condition of things is inevitable in trade and commerce, inherent in the nature of things and attaches in kind, if not in degree, in all cases where a manufacturer, sending goods of any particular description, but without distinguishing mark, into a

district or country where such goods were before that time unknown, and establishing a reputation in that district or country as the manufacturer and vendor of such goods. Any new comer in the same district with similar goods would undoubtedly profit by the reputation of the former's goods; yet the benefit to the public generally of free competition and the natural rights of all to seek any and all markets, would render ineffectual all attempts to shut out such new comer.

Since the preparation of the foregoing opinion the second edition of "*Browne on Trade-Marks*" has been distributed. That author upon a review of the cases lays down this proposition: "A manufacturer has a right to affix his own name to an article of his own production. And any injury which another manufacturer, having the same surname, may suffer in consequence thereof is *damnum absque injuria*." 420.

And in his "commentary" upon *Howe v. Howe Machine Co.* 50 *Barb.*, 236, he says: "This case is apt to mislead the superficial observer, and even for a moment stagger the preconceived notions of one used to critical examination. It has been cited more than once in support of this absurd proposition, to wit: when two men in the same trade have the same surname, one may employ that surname as a trade-mark, to the exclusion of any such right by the other; that is, when the two brothers have made and sold sewing machines, the one who first stamped his surname upon a machine was the sole possessor of the right to stamp his workmanship with his true name. This conclusion has no warrant from any authoritative source." 423.

There is no error in the judgment of the Superior Court.

LOOMIS, J., dissenting:

The able argument in support of the majority opinion is so well calculated to produce the impression that the finding of the Superior Court leaves no possible basis for granting any relief to the plaintiff, that it will be necessary to examine the pleadings and finding somewhat carefully, to show the grounds for my dissent. If we exclude from paragraphs eleven to sixteen of the complaint all allegations of fraudulent designs and acts, there will

remain the averments that the plaintiff is a corporation duly organized under the laws of this State, and that since 1859 it has been and now is extensively engaged in the manufacture of silver-plated spoons, forks and knives, and has large capital invested in that business; that in 1858 Asa H. and Simeon S. Rogers formed a partnership under the name of "Rogers & Brother," and engaged in the business of manufacturing and selling silver-plated spoons and forks and knives, which was continued till December 18, 1859, when the plaintiff corporation was organized and purchased the property, and succeeded to the business and all the rights of said partnership; that said partnership had adopted and used in its business the trade-mark "Rogers & Bro.," sometimes adding the suffix "A 1" and that plaintiff upon succeeding to the business of said partnership lawfully continued to use and has ever since lawfully used and intends in the future to use in its business said trade-mark with said suffix, stamping the same upon the spoons, forks and knives manufactured by it; that the sale of the plaintiff's goods so stamped has been widely extended, and that owing to the skill and integrity of the plaintiff in their manufacture they have constantly maintained a special, peculiar, good and valuable reputation among the trade and among purchasers generally, and that the business of the plaintiff has been largely built up and extended by such reputation, and is now largely dependent for its profitable continuance upon the reputation so attached to its goods by the use of such stamp thereon; that said trade-mark is of great value to the plaintiff and will continue to be so if the wrongful acts of the defendants shall be stopped; that the defendants, well knowing the premises and knowing that if they could send spoons, forks and knives into market bearing a stamp that would cause them to be called "Rogers' goods," or by any of the names whereof the word "Rogers" is the specially conspicuous part, they could sell them much more readily and for a higher price than if the stamp did not contain the word "Rogers;" and intending to cause their goods to be called by some name of which the word "Rogers" forms the conspicuous part and so obtain advantage of the reputation which attaches to goods bearing the plaintiff's trade-mark

“Rogers & Bro. A 1,” did, on or about the 15th day of June, 1883, begin the business of making and selling silver-plated spoons, forks and knives, and stamped upon them marks resembling said trade-marks of the plaintiff, and in particular the following, to wit: “C. Rogers & Bros. A 1,” and to send into the market and sell, spoons, forks and knives so stamped, and have ever since continued to do so; that by reason of said facts the use by the defendants of the word “Rogers” as a stamp upon spoons, forks and knives will cause unwary purchasers to purchase the goods of the defendants so stamped, supposing them to be manufactured by the plaintiff, to the injury of the plaintiff; and that the plaintiff, on August 1, 1883, requested the defendants to cease using the stamp aforesaid, but they then refused and still refuse.

Of the material allegations, stated above, the defendants admit that in 1858, Asa H. and Simeon S. Rogers formed a partnership under the name of “Rogers & Brother,” and under that name engaged in the manufacture of silver-plated ware, that in 1859 the plaintiff corporation was organized under the name of “Rogers & Brother,” purchased the property of said co-partnership and succeeded to its business and has ever since been engaged in the manufacture of silver-plated spoons, forks, and knives, and has a large amount of capital engaged in the business; and that the partnership “Rogers & Brother” during its existence stamped the goods of its manufacture with the name of said co-partnership, either in full or in the abbreviated form of “Rogers & Bro.,” and that the corporation stamped the goods of its manufacture with its corporate name, either in full or abbreviated, and that said co-partnership and corporation sometimes added to their mark “A 1.” They also admit the use of the star, and that the plaintiff’s goods while so stamped have had a good and valuable reputation in the public markets.

The defendants aver that they have been extensively engaged in business as manufacturers and sellers under their partnership name of “C. Rogers & Bros.,” since 1866; their manufacture being principally that of silver-plated coffin trimmings, and in that business their partnership name has acquired a high reputation and been of great value to them. And in reply to paragraphs eleven and six-

teen of the complaint, they aver that they have been engaged in and are intending to carry on, in connection with their other silver-plated manufacture, the manufacture and sale of electro-silver-plated spoons, forks and knives, and have made a large investment therein; and that they have stamped upon the articles so manufactured their partnership name for the sole purpose of indicating that such articles are manufactured by them, and of availing themselves of the reputation which they, the defendants, have acquired in the public markets as before mentioned.

This the defendants "insist" that they have a lawful right to do, and that the doing thereof can afford no lawful ground of complaint to the plaintiff.

The Court finds, among other things, that when the plaintiff corporation was formed in 1859, both members of the partnership formed in 1858, Asa H. and Simeon S. Rogers, were associates in such formation and became stockholders and officers in such corporation and that the corporation so formed "acquired by purchase all the property and business of said firm, including its said stamp and good-will, and has ever since used said stamp in its business, always stamping the same upon the back of the shank of the forks and spoons, and that the use of said stamp was never objected to by any of said brothers; that the goods made by the plaintiff and stamped as aforesaid, have always been equal to, or better than the goods made by said three Rogers Brothers; and have always had a high reputation in the market; that the standard of quality has not only been maintained, but the amount of silver put upon the goods has been increased from time to time, and the quantity of silver now used by the plaintiff is 25 per cent. in excess of that used by Rogers Brothers; that the plaintiff has also from time to time made improvements in the style and workmanship of the goods; has greatly improved the quality of its spoons by thickening the shanks; that the reputation of the plaintiff's goods is very much higher than was that of the goods made by said partnership; and that the plaintiff's knives, forks and spoons are of a quality much superior to those made by said partnership or any other party prior to the organization of the plaintiff; that said stamp of the plaintiff has never been used except upon first

quality goods, and the use of the same has been and is of great value to the plaintiff; that prior to the acts complained of, the spoons, knives and forks dealt in by the defendants were wholly of the manufacture of other parties than themselves, except as they were at one time connected with Chas. Parker, under an arrangement which appears in the case of *Meriden Britannia Co. v. Parker*, 39 Conn., 450; that the defendants have never stamped any of their goods with any mark, name or trade-mark except as the spoons, forks and knives made by them recently have been stamped as herein stated; and that their stamp "C. Rogers & Bros. A 1" is stamped upon the backs of the spoons and forks in the same manner and place as the plaintiff's goods are and have been stamped.

The majority of the Court, in their opinion, after referring to various uses of the name "Rogers," by one or other of the brothers, most of which have been abandoned for many years and which do not seem to have any material bearing upon any question in this case, say: "Thus with reiteration the Court below emphasizes the fact that the word 'Rogers' is the controlling word, the one thing that is the basis of all possible confusion or mistake in the use of the two stamps. * * * There is no finding or suggestion of that fact that any other part of the defendants' stamp is answerable in any degree for that liability to mistake. * * * If any other part of the stamp, in configuration, collocation, or combination of words, figures or symbols, or in any other respect, contributed in any manner to deceive possible purchasers and enable the defendants to sell their goods as those of the plaintiff, it should so have been found by the trial Court."

To this construction of the finding, that confines the resemblance between the stamps entirely to the word "Rogers," excluding every other possible misleading similarity, I do not assent, because it entirely ignores the distinct finding that "The general resemblance between the stamps is such that a person knowing that of the plaintiff and not knowing that of the defendants might, upon referring to it but not reading it attentively, mistake it for that of the plaintiff." This finding, and the construction I give it, are both emphasized by the fact that the trial Court made

the exhibits a part of the finding to be submitted for inspection and comparison by the Judges of this Court, surely not for the futile and foolish purpose of enabling us to see that the word "Rogers" in one stamp was like the word "Rogers" in the other, but that we might see how striking was the resemblance between the two stamps in their entirety: "*Rogers & Bro. A 1," and "C. Rogers & Bros. A 1," as actually impressed upon the metal in characters identical in style, size and space occupied; making the closeness of the resemblance and the probable effect in misleading purchasers more apparent than would appear from any mere verbal description.

In order to illustrate the use and benefit of exhibits in questions of this kind, it may be allowable to compare the impression actually made by the star prefix of the plaintiff's stamp with the "C." of the defendants' stamp. As they appear on the printed page, nothing could well be more dissimilar, and yet such is not the fact as seen in the exhibits, for both consist of very small circular indentations in the metal, and owing to the small size the distinguishing points are obscure, so that as addressed to the eye upon casual or ordinary examination there is great similarity, even where we would not expect to find it.

But it is not my purpose to supplement the finding by adding my own inferences of fact. The exhibits, however, being legitimately before us as a part of the case, it was our duty to examine them.

For the purposes of this discussion, however, I have no occasion to use the exhibits for any other purpose than to aid the interpretation and to make more clear the purpose and meaning of that part of the finding which in a measure seems to have escaped the attention of the majority of the Court, notwithstanding the great thoroughness and ability of their argument. That the plaintiff has a good and a very valuable trade-mark is beyond all question. As a property right it is as sacred as any other. The stamp adopted by the defendants to some extent operates to personate the plaintiffs and to mislead at least incautious and unwary purchasers; so that profits of right belonging to the plaintiff may fall into the hands of the defendants to whom they do not belong.

For such a state of things there ought to be a remedy, and I think there is one founded upon the authority of numerous decisions, some of which were referred to by this Court, with approval, in the late cases of *Williams v. Brooks*, 50 Conn., 278, and *Meriden Britannia Co. v. Parker*, 39 Conn., 450.

In *Williams v. Brooks*, 283, this Court, remarking upon the finding that those liable to be deceived "were only careless and unwary purchasers," says: "The purpose to be effected by this proceeding is not primarily to protect the consumer, but to secure to the plaintiffs the profit to be derived from the sale of hair-pins of their manufacture to all who desire and intend to purchase them. It is a matter of common knowledge that many persons are in a greater or less degree careless and unwary in the matter of purchasing articles for their own use; but their patronage is not for that reason less profitable to the manufacturer; and when such persons have knowledge of the good qualities of the plaintiffs' hair-pins, and desire to purchase them, the law will not permit the defendants to mislead them." The Court then quotes the following from the opinion of the Court in *Singer v. Wilson*, L. R., 3 App. Cas., 376: "There are multitudes who are ignorant and unwary, and they should be regarded in considering the interests of traders who may be injured by their mistakes. If one man will use a name the use of which has been validly appropriated by another, he ought to use it under such circumstances and with such sufficient precaution that the reasonable probability of error should be avoided, notwithstanding the want of care and caution which is so commonly exhibited in the course of human affairs."

In *Meriden Britannia Co. v. Parker*, it was found "that the stamp of the defendant, 'C. Rogers & Bros. A 1,' resembled the petitioners' trade-mark '1847, Rogers Bros. A 1,' to that degree that it was calculated to deceive unwary purchasers and those who buy such goods hastily and with but little examination of the trade-mark; but purchasers who read the entire trade-mark on the respondent's goods and who know the petitioners' trade-mark cannot be deceived, nor can they mistake the respondent's goods for those of the petitioners." 39 Conn., 455.

Upon the finding in that case the Court remarked that "the fact that careful buyers, who scrutinize trade-marks closely, are not deceived, does not materially affect the question. It only shows that the injury is less, not that there is no injury." *Id.*, 460.

But if the resemblance be found sufficient to mislead, as in the *Parker Case*, it is still contended that as the defendants here only use their own partnership name, they may, upon the pleadings and finding in this case, lawfully appropriate to themselves the entire advantage which in that case, was to be divided between themselves and Parker, and that this plaintiff must continue to suffer, without relief, all the damage from which the plaintiffs in that case were protected by injunction.

But in deciding this question of infringement the only difference between the case of one who uses a name not his own, as a stamp, and one who uses his own name, is that, in favor of the owner of the stamp claimed to have been imitated and infringed, the former is presumed to use it for a fraudulent purpose, while, as to the latter, such purpose must be proved.

Here it is found, that "The defendants, in commencing the manufacture of such articles, had in view the popularity in the market of such goods bearing a stamp containing the word Rogers, and one inducement to commencing such manufacture was the advantage they might derive from having their goods so stamped."

This is clearly sufficient for the plaintiff, unless the fact that such "popularity" was not the sole property of the plaintiff prevents the maintenance of this suit without joinder as co-plaintiffs of the other parties interested in the reputation and popularity which the defendant intended to appropriate.

That question arose in the case of *William Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co.*, and was then disposed of by Judge Lowell as follows: "It is further argued that the Rogerses are so many that the Court cannot find any intent to appropriate the reputation of one of them more than another, and that if any suit will lie, it must be by all those who use any trade-mark whose distinctive feature is the name 'Rogers.' I believe it to be true that the Greenfield Rogerses did not inquire, nor did the defend-

ants care, whose reputation they were making available; but I am of opinion that any one of those who rightly use the name may enjoin the interfering use by others." 11 *Fed. Rep.*, 500.

That the plaintiff has built up the reputation, and established the popularity in the markets of goods stamped with a stamp, the conspicuous word of which is "Rogers," and is a principal, if not the sole owner of such reputation, is alleged and clearly found; also, that the defendant intended to appropriate the advantage to be derived from securing such reputation for their goods to their profit, and that this was an inducement to commencing the business.

As was said by Baggallay, L. J., in the *Thorley Cattle Food Case*, "I am satisfied on the whole transaction, as set forth in the finding, that the object was to obtain a large slice of the business previously carried on by the plaintiffs." *L. R.*, 14 *Ch. Div.*, 748. But in our reasoning we are confronted with the proposition that, notwithstanding the positive findings of the Court to which we have referred, the case of the plaintiffs, as set forth in the complaint, is so met and controlled by the negations in the finding as to prevent the plaintiff from obtaining any relief. The pleadings are reviewed somewhat briefly in the majority opinion, and the claim is made that the trial Court has wholly negatived the allegations that the defendants were actually and intentionally fraudulent in the use of their stamp, and that "in saying that the allegations of fraudulent design contained in article sixteen of the complaint are found not true, goes further and negatives also the constructive fraudulent design implied in that article." But upon careful examination the finding, when applied to the pleadings (the substance of which we have given) brings me to a different result.

The principal contention between the parties in the pleadings grow out of the allegations of positive fraudulent acts, or of constructive fraud, necessarily resulting from the acts set forth in paragraphs eleven to sixteen, inclusive, of the complaint. The defendants, without in terms denying the fraudulent intent and acts charged, aver that, as those paragraphs, they have been en-

gaged in and are intending to carry on the manufacture and sale, as set forth, "for the sole purpose of indicating that such articles are manufactured by them, and of availing themselves of the reputation which they (the defendants) have acquired in the markets, as before mentioned."

The affirmative allegations of the plaintiff are met by the affirmative counter and inconsistent averment of the defendants, thus creating an issue to be passed upon by the trier, who distinctly negatives the claim of the defendants by finding, in effect, that the "popularity which the defendants had in view," and from which they wished "to derive advantage," was not the "reputation which they, the defendants, had acquired in the markets in their business." The defendants' previous business expressly found not to have included the manufacture of silver-plated spoons, forks and knives, stamped with the name "Rogers." On the contrary, this was the business found to have been established by the plaintiff and others under whom the defendants do not claim.

In dissenting from the views of the majority of the Court I do not find it necessary to hold that the fair and honest use of a name can be enjoined when it is used in the ordinary course of business in the way and manner in which other manufacturers of similar goods are accustomed to use their own names in the preparation and sale of goods, for I do not regard this as such a case. It belongs rather to the class of cases referred to by Judge Lowell in the cases before cited, (11 *Fed. Rep.*, 495,) where he says: "The books are full of cases in which defendants have been restrained from using their own names in a way to appropriate the good-will of a business already established by others of that name."

I think there was error in the judgment complained of.

If any decree of injunction was to be passed, I would prefer to give it more careful consideration before fixing its precise terms. I will merely add that my impression is that the defendants should have been enjoined from such use of the combination of words, "C. Rogers & Bros.," on silver-plated knives, spoons and forks,

and from such use of the word "Rogers'" as part of any stamp or mark on the shank of silver-plated spoons and forks in connection with or without the suffix "A 1," as that purchasers will be liable to believe that spoons, forks and knives so marked and made by the defendants, were made by the plaintiff.

In this opinion PARK, Ch. J., concurred.

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CIRCUIT COURT UNITED STATES, EASTERN
DISTRICT OF TEXAS. IN EQUITY.

CARBOLIC SOAP COMPANY

v's.

THOMPSON, AND ANOTHER.

DECIDED NOVEMBER, 1885.

REPORTED 25 FEDERAL REP., 625.

“Cresylic Ointment” Case.

1. A word that is descriptive of the nature and quality of a compound, cannot be claimed and allowed as an exclusive trade-mark.
2. IMITATIONS OF PACKAGES AND LABELS.—Parties will be protected from the imitation of their packages so far as they are peculiarly designed and shaped for the purpose of distinguishing their goods, and from the imitation in color, design, style and lettering combined of the labels used to mark said packages.

COMPLAINANTS allege that they are proprietors of an article called “Buchan’s Cresylic Ointment,” an article designed and used as a remedy for cattle affected by the screw-worm, and for other purposes, and that they put it up for sale in peculiar-shaped bottles and distinctive labels, printed in colors, both of which had been

used by them and their predecessors in business for upwards of 16 years; that defendants, who had also been largely engaged in the business of selling complainants' goods, had recently put upon the market, and were selling in opposition thereto, another and different kind of ointment represented to be for similar uses, and prepared and put up in imitation of complainants', so as to resemble the same in respect to name, form, and size of packages, labels, and general external appearance, and sold under the general name of "Cresylic Ointment," to the great detriment and injury of the complainants; and they prayed for an account of all sales made by the defendants of the alleged imitation article, that they be condemned to pay over their profits, and for all loss and damage sustained by complainants, and that they be enjoined from using the word "Cresylic," and from using packages, labels, etc., similar to complainants'.

McLemore & Campbell, for complainants.

Hune & Shepard, for defendant.

PARDEE, J.:

When the original bill was before the Court for a restraining order, and afterwards, when on bill and affidavits the Court directed the restraining order to stand over until hearing on the merits, it was considered, on the showing made, as plain that the complainants and their predecessors had adopted as a trade-mark the word "Cresylic," and the particular set of packages and labels described in the bill to identify and distinguish their goods, and had, by energy and outlay, built up a valuable trade, that the defendants were engaged in introducing and selling goods that had purposely been put up in particular packages identical in size and shape, and with closely imitated labels, with the intention of taking advantage of the reputation complainants' goods had acquired, and with the further intention of deceiving purchasers. At the same time it seemed, from the showing made by affidavits, that, while there was doubt on the subject, the word "Cresylic," claimed as a trade-mark by complainants, was a word arbitrary and fancifully used by the complainants, not indicative or descriptive of

the quality or nature of the article to which it was applied, and therefore a legitimate trade-mark.

Under this state of the case, and distinctly reserving the questions involved until the hearing on the merits, the Court allowed the restraining order to stand as an injunction *pendente lite*. It is deemed proper to make this statement, as counsel in briefs have partly assumed that the merits of the case have been already decided by the Court. Now, on the hearing, the case is submitted upon a mass of evidence taken contradictorily in a suit tried in the Supreme Court of New York, involving exactly the same issues. We have examined this evidence carefully, and while there is much conflict as to many facts, and more as to chemical theories, we have no trouble in sifting out a few leading and clearly proven facts, which, in our view, control the case.

1. There is an article—a product of coal tar—known in commerce and in manufactures as “cresylic acid.” Whether among chemists and scientific people this distinctive cresylic acid is regarded as only impure carbolic acid, or crude carbolic acid, or whether it should be called “cresol,” “cresylic alcohol,” “hydrate of cresyl,” “hydrate of oxide of cresyl,” “cresylic acid,” or “cresylol,” is immaterial for this case.

2. This article known in commerce as “cresylic acid” is one of the principal ingredients in the ointment manufactured by the complainants, and called “Buchan’s Cresylic Ointment,” and in the ointment manufactured by Narnett, and called “Lowe’s Cresylic Ointment,” and substantially furnishes the said ointment with the curative and valuable properties they have.

3. The word “cresylic,” when applied to distinguish an ointment made of soap and the article known in commerce as cresylic acid, is descriptive of the nature and quality of the compound.

4. The manufacturers of Lowe’s Cresylic Ointment introduced and sold in Texas by the defendants, and with the design to take advantage of the good reputation and standing of and the public demand for Buchan’s Cresylic Ointment, honestly, laboriously, and expensively acquired, and with the design and effect of deceiving the purchasers and consumers of cresylic ointment, have closely imitated the size, shape, form, and appearance of the

several packages, and the color, style and appearance of the labels designed and used by complainants in putting Buchan's Cresylic Ointment on the market.

5. That the imitation of complainants' packages and labels for Buchan's Cresylic Ointment was with the knowledge of, and partly at the suggestion and instigation of, the defendants.

From these facts it follows that the complainants have no right to the exclusive use of the word "cresylic" as a trade-mark, or to distinguish Buchan's Cresylic Ointment, or any compounds of which the "cresylic acid" of commerce is an ingredient, but complainants ought in equity and good conscience to be protected from the imitation of its packages, so far as they are peculiarly designed and shaped for the purpose of distinguishing complainants' goods, and from the imitation in color, design, style, and lettering combined of the labels used to make said packages, when put on the market; and that complainants ought to be protected, as against the present defendants, from the introduction and sale of all such goods as are put up in such imitated packages, and marked with such deceptive labels. Decree accordingly.

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CIRCUIT COURT UNITED STATES, EASTERN
DISTRICT OF MICHIGAN. IN EQUITY.

THE ROYAL BAKING POWDER COMPANY

vs.

JOHN DAVIS, ET AL.

DECIDED 5 NOVEMBER, 1885.

REPORTED 33 O. G. 1391.

“Royal Baking Powder” Case.

BILL TO RESTRAIN THE USE OF THE WORD “CORAL,” IN
CONNECTION WITH BAKING POWDER.

Defendants use cans of precisely the same size and shape of those of plaintiff, to which are affixed labels of same colors and general design, with the words Coral Baking Powder thereon. **HELD:**

1. That the words “Coral Baking Powder” is not in itself an infringement of plaintiff’s trade-mark, “Royal Baking Powder,” but the general arrangement of the words being the same, the devices upon the can being very much alike, and the labels of the same color and general appearance, purchasers might be easily deceived into buying the one for the other.
2. Injunction granted not to extend to the use of the words “Coral Baking Powder,” but to their use in connection with cans and labels of the same general appearance as those of the plaintiff.

THE bill of complaint in this case sets forth the incorporation of the complainant, and the manufacture and sale by it of baking powder; that it gave to, adopted, affixed and used as a name for the article so manufactured, the name "Royal," as a trade-mark, and has ever since continued to use the same.

That such corporation, for the purpose of introducing and selling such baking powder, put up the same in cans, with such trade-mark affixed thereto, and procured labels to be placed upon such cans, and did place the same thereon.

The bill of complaint then describes, minutely, the colors in which such labels are printed and used, the ornaments and devices thereon, the size and appearance thereof, as fully and accurately as the same could be set forth, and made profert to the Court of one of such cans, with the labels described thereon.

It was farther in such bill alleged, "that the said package with the said labels, colors, wording and devices, combined together, constitute a trade-mark, or trading device, distinguishing the baking powder manufactured and sold by complainant from that of others engaged in similar lines of business. That the baking powder so manufactured, put up and sold by complainant is absolutely pure, healthful and of superior quality. That, put up in such form and manner, it has had a very large sale in all parts of the United States, and the same has become well known to the public throughout the United States by the name or trade-mark, 'Royal Baking Powder,' so that dealers in and consumers of baking powder well know that the said term 'Royal,' prefixed to the word baking powder, and that baking powder put up in such cans, with such labels, printing and devices thereon, indicate that the baking powder, so-called and so put up, is manufactured by the complainant, and sold by it, and that said complainant has, by reason of the premises, the sole and exclusive right to the use of such trade-mark, name and devices, and is entitled to be protected in the sole and exclusive use thereof."

The bill farther alleged that defendants, under the firm-name of John Davis & Co., are, and have, in the City or Detroit, been manufacturing from burnt alum, and other cheap ingredients, detrimental to health, a, by them, so-called baking powder. That

the same is put up in cans, in general size and appearance like unto the said cans used by the complainant; "that defendants, upon each of their said cans, affix and place printed labels, which, in color and general appearance, are like unto the labels used by complainant, as described and set forth in this bill," with the words "Coral Baking Powder" thereon, and profert was made of a can, with the label, devices, printing, etc., thereon, put up by said defendants.

The prayer of the bill was, among other things, that defendants be perpetually enjoined from affixing, using or placing on any can, box or package of baking powder manufactured by them, a label or labels, like in color or appearance to the said labels used and affixed by said complainant.

The defendants put in separate answers, that of John Davis being full, the others admitting they were members of the firm of John Davis & Co., but disclaiming all knowledge touching the matters set forth in the bill of complaint. Mr. Davis' answer set forth, "That the shape and size of the can described in complainant's bill is a common mercantile article in the market, and is made by different manufacturers for holding baking powders. Such cans are made expressly for that purpose, and have been used for that purpose for years by baking powder manufacturers. The colors on the labels are also in common use by baking powder manufacturers," and denied, "that the colors and devices mentioned in complainant's bill, apparently, or in combination with each other, or in combination with any other matter or thing, constitute a trade-mark of complainant, and denied that the complainant has, or ever has had, any sole or exclusive right in said colors or devices, separately or in combination with each other, or in combination with any other matter or thing."

The answer farther alleged, that the firm of John Davis & Co. had, for a long time, been manufacturing various brands of baking powders; that "The baking powder of defendants is sold cheaper than the baking powder of complainant. It is put up in cans in size like the cans in which the Royal Baking Powder is put up. The labels by the defendants' firm resemble the labels used by

complainant in their color, to the extent that one-half of the label is a red ground and the other half is a yellow ground. The corner ornamentation upon the red half is the same, but the words on the corner ornamentation differ. The word "Royal" on complainant's red ground is in good sized letters. The word "Coral" on defendants' is in larger letters. In the center of the complainant's red ground, the ornament is a picture of a 'Royal Baking Powder' can, in a circle. In the centre of defendants' red ground the ornament is a circle, containing therein the words 'trade-mark,' with a large picture below of a piece of coral. The red half of defendants' label is plainly distinguishable from the red half of complainant's label, by the different words in the corner ornamentation, by the word 'Coral,' and by the larger size of the word 'Coral,' and by the totally different character of central ornament. No person would be likely to mistake the one for the other." "The yellow side of defendants' label has the word 'Coral' in very large letters, and in letters much larger than the word 'Royal' on the yellow side of complainant's label, and is readily distinguishable from the yellow side of complainant's label." Other features, which it was alleged were distinctive, were, in like manner, specifically set forth.

Upon the motion for a preliminary injunction upon the bill and answers, cans with complainant's labels and defendants' labels thereon, were produced, and upon argument, a preliminary injunction was granted, as prayed for.

It appeared that defendants had been using such labels for a period of about four months. In view of this fact, and of the granting of a preliminary injunction, which prohibited the farther use thereof, counsel for complainant announced that he had no desire to pursue the litigation for the purpose of recovering damages, and it was thereupon agreed that the matter should be submitted to the Court for final adjudication upon the bill and answers, and production, as evidence, of cans, with labels thereon, of the respective parties, whereupon the following opinion was delivered by the Court, and injunction issued in accordance therewith:

OPINION.

BROWN, J.:

This is a bill in equity for the infringement of plaintiff's trade-mark, which consists of the words "Royal Baking Powder," used in connection with labels of a particular design and color, applied to the cans containing the article manufactured by plaintiff.

The defendants make use of cans precisely the same size and shape, to which are affixed labels of the same colors and general design as those of the plaintiff, with the words "Coral Baking Powder" thereon. The answer avers "that the shape and size of the can described in the bill is a common mercantile article in the market, and is made by different manufacturers for holding baking powder;" that "the colors on the labels are also in common use by baking powder manufacturers," and denies that the colors and devices mentioned in the bill, in combination with each other or with any other matter or thing constitute a trade-mark. The labels used by defendants' firm are similar to those used by the plaintiff's in their color, and to the extent that one-half of the label has a red ground with white letters, and the other half a yellow ground with black letters. The corner ornamentations upon the red half are the same, but the words upon this ornamentation differ. The word "Royal" on plaintiff's red ground is in good sized letters. The word "Coral" on defendants' is in larger letters. In the centre of plaintiff's red ground the ornamentation is a picture of a Royal Baking Powder can in a circle. In the centre of defendants' red ground is a circle containing therein the words "Trade-Mark," with a large picture below of a piece of coral.

1. I do not think the use of the words "Coral Baking Powder" is in itself an infringement of plaintiff's trade-mark—"Royal Baking Powder." The difficulty is with the similarity of the labels of the cans upon which the words are used. The general arrangement of the words being the same, the devices upon the cans being very much alike, and the labels of the same color and general appearance, I think purchasers might be very easily deceived into buying the one for the other.

The injunction then will not extend to the use of the words "Coral Baking Powder," but to their use in connection with cans and labels of the same general appearance as those of the plaintiff.

DECREE NO. 2,976.

The Royal Baking Powder Company v. John Davis, et al.

At a session of said Court, held at the Court room in the City of Detroit in said District, on the 5th day of November, A. D., 1885.

HENRY B. BROWN, *District Judge* :

This cause came on to be heard at this term, and was argued by counsel, and thereupon, upon consideration thereof, it was ordered, adjudged and decreed as follows:

That complainant is entitled to the exclusive use of the labels affixed to baking powder manufactured by it, as described and set forth in said bill of complaint, and that the use by said defendants of the label described in said bill as being used by said defendants, upon cans containing baking powder manufactured by them, is in violation of complainant's rights.

It is further ordered, adjudged and decreed that said defendants and each of them, their clerks, agents, attorneys, servants and workmen, be, and they are hereby perpetually enjoined, under the pains and penalties that may be inflicted upon them for contempt, from using the labels, or either of them, described in the bill of complaint, on or around or in connection with any cans, boxes or other packages, of any nature or kind whatsoever, containing, or purporting to contain, baking powder, and from selling, or offering to sell, or disposing of baking powder with such label or labels thereon or attached thereto.

Said complainant, by its counsel, waiving all claim for damages for or on account of the use of such labels heretofore used by said defendants, it is further ordered, adjudged and decreed, that said complainant do recover its costs and expenses in this behalf incurred against said defendants.

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CIRCUIT COURT UNITED STATES, EASTERN
DISTRICT OF MICHIGAN. IN EQUITY.

O'ROUKE

vs.

CENTRAL CITY SOAP COMPANY.

DECIDED 7 DECEMBER, 1885.

REPORTED 35 O. G., 875.

"Anti-Washboard Soap" Case.

1. The words "anti-washboard," as applied to a manufacture of soap, are suggestive rather than descriptive, and may be lawfully claimed as a trade-mark.
2. A person cannot appropriate a trade-mark belonging to another without his consent and afterward acquire a good title by the abandonment thereof by the first proprietor, but if the trade-mark has been long abandoned and disused by one party, another may by adoption and use acquire property rights in it.
3. DEFECT OF TITLE.—A defendant who has no title may take advantage of a defect of title on the part of the plaintiff.

THIS was a bill in equity for the infringement of a trade-mark claimed by the plaintiff in the use of the words "anti-washboard," as applied to a manufacture of soap.

The facts of the case were substantially as follows: In 1872, one Thornton R. Walker took out a patent for a composition of matter said to constitute soap, but which did not designate the compound by any name except "improved soap." About that time Walker and his partners, doing business under the name of "Anti-Washboard Soap Company," at Cary, Ohio, made and sold a soap which they called "Anti-Washboard Soap," and which was described as possessing such qualities as would make rubbing unnecessary in the process of washing clothes. Whether it was made according to the formula patented by Walker did not appear. This firm ceased business about 1874, and in that year sold its kettles and apparatus to Clark & Benefiel, of Mattoon, Illinois, by whom soap was made and sold under that name at Mattoon until August, 1875, when the business was sold by them to one Stephens, who, after carrying it on for three or four months died. With his death, the business, and the use of the name "Anti-Washboard" by any one succeeding to the business of the "Anti-Washboard Soap Company," ceased. One of the members of the original firm, doing business at Cary, had in the meantime moved to Kansas, and on May 12, 1884, after this suit was begun, executed to the defendant an assignment of the right to use the words "Anti-Washboard" as a trade-mark. This was the only right claimed by the defendant to the use of these words. The defendant was shown to be a manufacturer of soap in large quantities at Jackson, in this State, with the words "Anti-Washboard" impressed upon the bar and wrapper.

The soap manufactured by the Anti-Washboard Soap Company, at Cary, Ohio, was sold extensively throughout the country, and in January, 1875, one Winger, who, it was shown, had seen this soap and knew of the trade-mark, began the manufacture of a soap at Sturgis, in this State, under the name of "Winger's Anti-Washboard Soap." He claimed, however, to have been informed that the business of the Anti-Washboard Soap Company had been discontinued. This was about the time that the Anti-Washboard Soap Company had sold out to Clark & Benefiel, of Mattoon, and about a year before their business was discontinued and the trade-mark abandoned by them. Winger carried on business at

Sturgis in a very small way from 1874 to September, 1883, when he deposited his trade-mark, "Winger's Anti-Washboard Soap," for registration in the Patent Office, and it was duly registered October 23, 1883. A few days thereafter he assigned to the plaintiff the "exclusive right to use, in the manufacture and sale of soap," this trade-mark. He also turned over to them his receipt for making soap, but no part or interest in his business. His kettles, staves, cutting-boxes, and other apparatus used in making soap, he removed to Kansas, where he took up his residence. Soon thereafter the plaintiff began an extensive manufacture of soap at Fort Wayne, Indiana, under the name of the trade-mark, and in 1885 began this suit for an injunction and an accounting. The defendant began the use of this trade-mark in July, 1880, but Winger was not informed of it until March, 1881.

Mr. R. S. Taylor, for the plaintiff.

Mr. R. Mason, for defendant.

BROWN, J.:

Two prominent objections are made in this case to the monopoly by the plaintiff of the words "anti-washboard" as applied to soap: First, that the words are descriptive of the quality of the article, and hence cannot be made the subject of a trade-mark; and, second, that they are not original with the plaintiff, but were unlawfully appropriated by him.

1. As a general rule, there is no doubt that in order that mere words may be upheld as a trade-mark, they must be purely arbitrary, or must indicate the origin or ownership of the article or fabric to which they are affixed. Words expressive of the character or composition of an article, or of the name by which it is generally known in the market, cannot be made the subject of monopoly. (*Burton v. Stratton*, 12 *Fed. Rep.*, 696, 700, and cases cited). There is, however, a class of words, which, though not descriptive of the article, are suggestive of some supposed advantage to be derived from using it, or some effect produced by its use. These have been ordinarily, though not always, upheld as valid trade-marks. Examples of such as have been sustained, are "Painkiller," as applied to a medical compound, (*Davis v.*

Kendill, 2 R. I., 566; *S. C., Cox Trade-Mark Cas.*, 103); "Invigorator," as applied to a bed-bottom, (*Ex parte Heyman*, 18 O. G., 922); "Samson Brace," as applied to suspenders; "Blood Searcher" and "Annihilator," as applied to medicines, (*Fulton v. Sellers*, 4 *Brewst.*, 42); "Zero," to a water-cooler; "Arctic," to a soda-fountain; "Daylight," "Sunlight," and "Gaslight," to illuminating oils. (*Browne, Trade-Marks*, sec. 273).

The words anti-washboard are not objectionable as indicating the composition or quality of the article, although the natural inference from them is that by the use of the soap the necessity of rubbing clothes is obviated. Upon the whole, we incline to the opinion that they are rather suggestive than descriptive, and that they may be properly claimed as a trade-mark.

2. The second objection presents a question of somewhat more difficulty. It has been sometimes said that the owner of a valid trade-mark must have been the first to appropriate the name to that particular article, and this, to a certain extent, is true; but if the trade-mark be abandoned, or the use of it intentionally discontinued by the original proprietor, it may be re-adopted and appropriated by another, provided it has not become a mere description of quality or kind of product. (*Browne, Trade-Marks*, secs. 690, 252; *Durham Smoking Tobacco Case*, 3 *Hughes*, 151; *Atlantic Milling Co. v. Robinson*, 20 *Fed. Rep.*, 217).

In the case under consideration, however, the question is presented whether a person may appropriate a trade-mark belonging to another, and subsequently acquire a good title thereto by the abandonment thereof by the first proprietor. The testimony shows, and it is not disputed, that when Winger began manufacturing soap at Sturgis, under the name of "Winger's Anti-Washboard Soap," the firm of Clark & Benefiel was manufacturing soap at Mattoon, Illinois, under the same name, and continued so to do for nearly a year after Winger commenced business. During this time he was an admitted trespasser upon their rights. The fact that he supposed the Ohio firm had gone out of business is no defence, if in fact they had an exclusive right to the trade-mark. (*Millington v. Fox*, 3 *Mylne & C.*, 338; *Welch v. Knott*, 4 *Kay & J.*, 747; *Leather Cloth Co. Case*, *Cox Trade-Mark Cas.*, 223).

There is no evidence in this case that his competition interfered with the business of Clark & Benefiel, or Stephens, their successor, or that he was the cause of the subsequent abandonment of the business by them; but if it be once conceded that a person may acquire a good title to a trade-mark by appropriation, without the consent of the lawful owner, it would enable a manufacturer, by the use of large capital or superior energy, to drive competitors out of business by seizing their trade-marks, and using them for that very purpose, provided the lawful owner is unable or unwilling to assert his rights by resort to the Courts. We think that no Court would hesitate to pronounce against a title so obtained. We find it difficult to distinguish such a case in principle from the one under consideration, as it might be impossible to prove that the lawful owner was compelled to discontinue by reason of such competition. We see no objection to the defendant availing itself of this defence. To maintain his bill for an infringement, the plaintiff is bound to show an exclusive right to the use of this trade-mark. If it appear that the words were in common use to designate the article manufactured, or if the exclusive right to use them was vested in another, we apprehend that the plaintiff is no more entitled to an injunction than is the patentee of an invention who fails to show that he is the first and original inventor of the thing patented. (*Wolfe v. Goulard*, 18 How. Pr., 64; *Manhattan Medicine Co. v. Wood*, 14 O. G., 519; *Congress & E. S. Co. v. High Rock Co.*, 57 Barb., 526). In this respect, both stand in the position of a plaintiff in ejectment, who must recover upon the strength of his own title, and not upon the weakness of the defendant's. Indeed, it is a good defence to an ordinary action of replevin, that the right to the possession of the property is in a third person. (*Dermott v. Wallach*, 1 Black., 96; *Schulenberg v. Harriman*, 21 Wall., 44). The fact that defendant has no better right to the use of the trade-mark than the plaintiff, would certainly not entitle the latter to an injunction.

Upon the whole, we have come to the conclusion, that the plaintiff never acquired an exclusive right to the use of the words "anti-washboard," and that his bill should be dismissed.

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COURT OF APPEALS OF ST. LOUIS, MISSOURI.
IN EQUITY.

ROBERT T. SANDERS, RESPONDENT,

vs.

DANIEL JACOB, APPELLANT.

DECIDED 22 DECEMBER, 1885.

REPORTED 2 WEST. REP., 408.

“New York Dental Rooms” Case.

1. The use of a trade name to designate a business, so like that of another person in the same business, as to raise a strong probability of misleading and deceiving the public or to show a design to so mislead and deceive will be restrained.
2. Laches of the plaintiff will not avail as a defence in a proceeding to restrain the use of a trade name where the defendant adopted the name with a fraudulent intent.

APPEAL from the St. Louis Circuit Court. *Affirmed.*

The facts are stated in the opinion.

Messrs. L. D. Stewart and Presley N. Jones, for appellant.

The names must bear such a resemblance as is calculated to mislead the public generally.

The resemblance must be such that ordinary persons proceeding with ordinary care would be deceived. *McCartney v. Garnhart*, 45 Mo., 593; *High, Inj.*, 691, 1088; *Gilman v. Hunnewell*, 122 Mass., 139; *Wolfe v. Goulard*, 18 How. Pr., 64; *Singer Mfg. Co. v. Wilson*, 3 C. L. J., 706; *Colladay v. Baird*, 4 Phila., 139; *S. C., Cox, Am. T.-M. Cas.*, 257; *Swift v. Dey, Cox, Am. T.-M. Cas.*, 319; *Walton v. Crowley*, 3 Blatch., 440.

When ordinary attention on the part of the customers will enable them to discriminate, the Courts will not interfere. *Popham v. Cole*, 66 N. Y., 69.

Reasonable diligence must be used for making the application for relief, and proceedings should be instituted at once. *High, Inj.*, 681; *Isaacson v. Thompson*, 20 Week. Rep., 196; *Del. & Hud. Canal Co. v. Clark*, 7 Blatch., 112; *Amoskeag Mfg. Co. v. Garner, Cox, Am. T.-M. Cas.*, 541.

Messrs. C. P. & J. D. Johnson, for respondent.

The resemblance between the two names "is sufficiently clear to raise the probability of mistake upon the part of the public, or design and purpose to mislead and deceive upon the part of the defendant;" for which reason the injunction was properly granted. *McCartney v. Garnhart*, 45 Mo., 595; *Sanders v. Utt*, 16 Mo. App., 322; *McLean v. Fleming*, 96 U. S., 251, 253, (Bk. 24, L. Ed., 831).

THOMPSON, J., delivered the opinion of the Court.

In 1871 the plaintiff began the practice of dentistry at No. 820 Washington Avenue in St. Louis, under the business name and style of "New York Dental Rooms." In 1872 he caused the words "New York Dental Rooms" to be registered as the trade name by which he designated his business. He advertised his business extensively under this name, and, in the course of time, built up a large and lucrative practice at a cheap scale of prices, principally among laboring people.

In 1880 or 1881 the defendant opened a dental establishment as No. 808 Washington Avenue, a few doors east of the plaintiff's, on the same side of the street, under the name of the "Newark Dental Rooms." About two months prior to the bringing of the

present action, the defendant removed from that number to a place but two doors from the place of business of the plaintiff, a single shop or store separating them. He displayed a sign bearing the words "Newark Dental Rooms," similar in appearance to the signs of the plaintiff. He used a printed form of contract with his customers which bore a marked resemblance to that used by the plaintiff. Persons in search of the plaintiff's establishment for the purpose of having work done, sometimes went into the Newark Dental Rooms by mistake, and had the work done there. After the defendant established this business with this sign and trade name near the plaintiff, the plaintiff's business fell off to an appreciable extent. Aside from the resemblance of the defendant's trade name and sign to that of the plaintiff, the evidence gives us the impression that it was adopted for the purpose of deceiving the public and attracting the customers of the plaintiff into the establishment of the defendant, and that this purpose was known and participated in, not only by the defendant, but by some of his employees. These facts were shown by the plaintiff's witnesses, and the defendant offered no evidence of any kind.

Upon this state of case, upon a petition in equity by the plaintiff, a decree was rendered perpetually enjoining the defendant from in any manner using the word "Newark," or any word similar in sound or appearance to the word "New York," in or upon any sign, card or advertisement, or otherwise, in connection with or in carrying on the practice of dentistry in the City of St. Louis. From this decree the defendant prosecutes this appeal, urging that there is no equity on the face of the petition; that the facts do not justify the relief granted, and that the plaintiff's right to relief is barred by his laches in not making objection sooner.

1. We are of opinion that the decree is right, and that it should be affirmed. The case falls within the rule stated in *McGartney v. Garnhart*, 45 Mo., 593, that, to justify an injunction in such a case, it should appear that the resemblance between the two trade names is sufficiently close to raise a probability of mistake on the part of the public, or to show a design to mislead and deceive on the part of the defendant. In the case of the "*What*

Cheer Restaurant," which was analogous to the present case, we applied this rule and sustained an injunction. *Gamble v. Stevenson*, 10 Mo. App., 581; see also *Sanders v. Utt*, No. 3052, of this Court.

In the present case both of these elements concur. There was sufficient resemblance between the two signs to raise a probability of mistake on the part of the class of customers that frequented the plaintiff's place of business. The evidence further shows that such mistakes actually occurred. It further satisfies us that the defendant intended that they should occur.

The question of laches would be a serious one if there were no element of fraud in the case on the part of the defendant. The Statute of Limitations does not in terms apply to a case of this kind, nor in applying the doctrine of laches is the analogy of the Statute of Limitations necessarily to afford the rule of decision. If the defendant had adopted this trade name innocently, and had gone on honestly practicing his trade under that name for four years, without objection on the part of the plaintiff, and had built up an extensive business under that name, we should say that it would be contrary to the maxims of equity to enjoin him from further practicing under that name at the suit of the plaintiff at this late day.

2. But where the element of fraud supervenes, lapse of time does not purge the defendant's conduct of this taint. The wrong is a continuing one; the injury done to the plaintiff and the deception practiced upon the public, both of which the law takes into consideration in these cases, accumulate. Then, if the defendant at a recent period of time aggravates the wrong, as he is shown to have done in this case, by moving his place of business still nearer to that of the plaintiff, and by there erecting signs similar in appearance to those of the plaintiff, it makes, we think, a plain case for equitable interposition.

The judgment of the Circuit Court will be affirmed. It is so ordered.

All the Judges concur.

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CIRCUIT COURT UNITED STATES, DISTRICT
OF MARYLAND. IN EQUITY.

ANHEUSER BUSCH BREWING ASSOCIATION*vs.*CLARKE.

DECIDED 20 JANUARY, 1886.

REPORTED 26 FEDERAL REP., 410.

Beer Label with Red Band.

Where a manufacturer has applied a peculiar and distinctive label to designate his goods, and has so used it that his goods are identified by it, a Court of Equity will restrain another party from adopting and using one so similar that its use is likely to lead to confusion by purchasers exercising the ordinary degree of caution which purchasers are in the habit of exercising with respect to such goods.

ON motion for preliminary injunction.

Rowland Cox, for motion.

William Pinkney Whyte, for defendant.

MORRIS, J.:

The general rule of law applicable to this case is that if a manufacturer has applied a peculiar and distinctive label to design-

nate his goods, and has so used it that his goods are identified by it, a Court of Equity will restrain another party from adopting and using one so similar that its use is likely to lead to confusion by purchasers exercising the ordinary degree of caution which purchasers are in the habit of exercising with respect to such goods.

McLean v. Fleming, 96 U. S., 245.

The complainant's affidavits show that the complainant was the first to use for bottled beer a label with a diagonal red band, with the name of the kind of beer appearing in white letters on the red band, and that he has been habitually using this label for two years. The label is a very noticeable and distinctive one by reason of the diagonal red band. The result of the effect upon the eye from seeing a number of bottles is that it is a beer labeled with a diagonal red band, and the more frequently one sees it the more this one effect is deepened. It does appear altogether probable that a consumer who had been used to getting bottles labeled with complainant's label would more and more rely on the diagonal red band as its distinctive mark, and would be likely to accept the respondent's beer with his diagonal red label on it as supplying what he was in the habit of getting. There is nothing in the difference in the labels calculated to counteract this, and I think it is a strong case of similarity likely to deceive.

The respondent's statements and explanations of how he came to hit upon this label for his own use are not satisfactory. It appears that it was suggested to him by a bottler in Washington, named Christian Abner, who was a rival of a bottler of complainant's beer, and using complainant's label in the same city, named Edward Abner. Nothing is shown by the affidavits to repel the suspicion which naturally arises, that the subsequent adoption of such a very similar label by one of the two rivals in the same city could not be accidental, but must have been for the purpose of confusion.

On the case, as shown by the affidavits, I think the complainant is entitled to the injunction as prayed.

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COURT OF APPEALS OF MISSOURI. IN EQUITY.

G. H. McCANN, ET AL., APPELLANTS,*vs.*G. H. ANTHONY, RESPONDENT.

DECIDED 23 FEBRUARY, 1886.

REPORTED 3 WESTERN REP., 436.

“Old Coon vs. Old Bachelor” Case.

1. A label bearing six distinct points of resemblance to a label used by another person in the same business whose goods had acquired a market reputation, is such an imitation of the latter label as should be enjoined, where it appears that at least two persons were deceived thereby, and where the defendant's sales have increased, without other cause being shown, since the adoption of the label by the defendant.
2. Appellate Courts, in equity proceedings, defer to the conclusions of fact arising in the cause, but not necessarily to its conclusions on questions of law.

APPEAL from the Greene County Circuit Court. Reversed.

Suit in Equity for an injunction.

The case is stated in the opinion.

Messrs. Bakewell & Bakewell, for appellants.

Courts of Equity will with great jealousy protect a manufacturer or trader from unlawful competition in his business, and will override all technicalities to reach justice in a particular case.

Avery v. Meikle, 27 *Off. Gaz.*, 1027; *Williams v. Johnson*, 2 *Bosw.*, 1; *Wamsutta Mills v. Allen*, *Cox's Manual*, No. 660; *Harrison v. Taylor*, 11 *Jur.*, *N. S.*, 408; *Morgan v. Schwachhofer*, 5 *Abb. Prac.*, *N. C.*, 265; *Gamble v. Stephenson*, 10 *Mo. App.*, 581.

The principle of *Perry v. Truefitt*, 6 *Beav.*, 66-73, that no one has a right to put off his goods as the goods of a rival dealer, and that "he cannot therefore be allowed to use name, marks, letters or *indicia*, by which he may induce purchasers to believe that the goods that he is selling are the goods of another person," is constantly recognized by the Courts as applicable in cases not strictly of technical trade-mark.

Croft v. Day, 7 *Beav.*, 84; *Holloway v. Holloway*, 13 *Beav.*, 209; *Dixon Crucible Co. v. Guggenheim*, 2 *Brewst.*, 321; *Stonebraker v. Stonebraker*, 33 *Md.*, 252; *McLean v. Fleming*, 96 *U. S.*, 245, (*Bk. 24, L. Ed.* 828); *Knott v. Morgan*, 2 *Keene*, 213-219; *Lager Beer Case*, *Fed. Rep.*, 28 *July*, 1885, *p.* 149; *Seixo v. Provezende*, *L. R.*, 1 *Ch. App.*, 192; *Landreth v. Landreth*, 29 *Pat. Off. Gaz.*, 1131.

The jurisdiction rests on fraud on the part of the defendant. The fact that actual fraudulent intent is not shown, or that it is disproved, does not defeat the remedy injunction.

Story, Eq., sections 951, 95h; *High, Inj.*, sections 676-680, 675 n; 678; *n. Browne, Trade-M.*, section 188; *Perry v. Truefitt*, 6 *Beav.*, 66; *Brooklyn Water Lead Co. v. Masury*, 25 *Barb.*, 416; *Hostetter v. Vowinkle*, 1 *Dill.*, 329; *Prowett v. Mortimer*, 2 *Jur. N. S.*, 414; *Ingram v. Stiff*, 5 *Jur. N. S.*, 947; *Amoskeag Mfg. Co. v. Spear*, 2 *Sanfd. Super. Ct.*, 599; *Filley v. Fassett*, 44 *Mo.*, 173; *Field v. Lenn*, *Seton*, 237; *Taylor v. Taylor*, 23 *Eng. L. & Eq.*, 281; *Wotherspoon v. Currie*, *L. R.*, 5 *Eng. & Ir. App.*, 508; *Peterson v. Humphrey*, 4 *Abb. Pr.*, 394.

Nor is it material that the simulated label or package has not been shown actually to have deceived any one. If the simulated

label is likely to deceive, evidence of actual deception is unnecessary.

High, Inj., sections 675, 691 n; *Codd. Tr.-M.*, 282, 201-207, 482; *Moorman v. Hoge*, 2 *Sawyer*, 78; *Glen Cove Mfg. Co. v. Ludemann*, U. S. C. C., S. D. N. Y., *Jany.* 2, 1885, 32 *Pat. Off. Gaz.*, No. 2; *Edelsten v. Edelsten*, 1 *De G., J. & S.* 185; *McAndrew v. Bassett*, 10 *Jur. N. S.*, 550; 33 *L. J. Ch.*, 561; *Filley v. Fasset*, 44 *Mo.*, 173; *L. T. Notes of Cases*, 1871, p. 199; *Lockwood v. Bostwick*, 2 *Daly*, 521; *Freeze v. Bachoff*, 13 *U. S. Pat. Off. Gaz.*, 635 (U. S. C. C., S. D. N. Y.)

Nor need the fraudulent label be parallel with that which it imitates. Nor is it material that, seen side by side, the two labels, or the two packages, would not deceive the ordinary purchaser.

Browne, sections 223, 234, 267, 268, 397; *High, Inj.*, sections 675, 690 n; *Coleman v. Crump*, 70 *N. Y.*, 573; *Chappell v. Sheard*, 2 *Kay & J.*, 117; *Cook v. Starkweather*, 13 *Abb. Pr. N. S.*, 392; *Millington v. Fox*, 3 *Myl. & Cr.*, 338; *Sohl v. Geisendorf*, 1 *Wilson*, (Ind.), 60; *Glenny v. Smith*, 2 *Drew. & Sm.*, 476; *Walton v. Crowley*, 3 *Blatchf.*, 440-447; *Lea v. Wolf*, 13 *Abb. Pr. N. S.*, 389; 46 *How. Pr.*, 157.

Nor is it material that defendant may have ceased to deceive since the beginning of the trial.

Walker Patents, 464; *Landreth v. Landreth*, 29 *Pat. Off. Gaz.*, 1131.

Nor need the plaintiff show a registered trade-mark.

Trade-Mark Cases, 100 *U. S.*, 82 (*Bk.* 25, *L. Ed.*, 550); *McLean v. Fleming*, 96 *U. S.*, 245, *supra*; *Lee v. Haley*, *L. R.*, 5 *Ch.*, 155; *Wotherspoon v. Currie*, *L. R.* 5 *H. L.*, 508; *Massam v. Thorley's Food*, 6 *L. R.*, *Ch. D.*, 574.

Mr. Francis H. Sheppard, for respondent.

The Appellate Court will not reverse on weight of evidence in law cases. The reason for this rule applies in equity, and the Appellate Court is unwilling to disturb the decision of the Chancellor below, except in cases free from doubt.

Dogget v. Lane, 12 *Mo.*, 215; *Wilson v. Maxwell*, 57 *Mo.*, 146; *Davis v. Fox*, 59 *Mo.*, 125; *Cornett v. Bertelsmann*, 61

Mo., 126; *Gimbel v. Pignero*, 62 *Mo.*, 243; *Sharpe v. McPike*, 62 *Mo.*, 307; *Chouteau v. Allen*, 70 *Mo.*, 336; *Hodges v. Black*, 76 *Mo.*, 537; *Hodges v. Black*, 8 *Mo. App.*, 393; *Royle v. Jones*, 78 *Mo.*, 406; *Judy v. Farmer's & Traders' Bank*, 81 *Mo.*, 410.

Nor every imitation will be enjoined, but only such as are likely to do harm. Is it a colorable imitation? Is it likely to deceive buyers? Does it give to the imitator an unfair advantage? These are the questions the Court asks, and it "does not decide cases in favor of fools and idiots."

Singer Mfg. Co. v. Wilson, 3 *C. L. J.*, last two paragraphs on p. 707, and first on p. 708; *Magee Furnace Co. v. Le Barrow*, 8 *C. L. J.*, 198; 2 *Kent Com.*, 12th Ed., 336, 481, note 1, B. 2; *High, Inj.*, 2d Ed., 713, section 1088; *McLean v. Fleming*, 96 *U. S.*, 245, (24 *L. Ed.*, 828); *Conrad v. Uhrig Brewing Co.*, 8 *Mo. App.*, 277.

Smoking tobacco is the general name of a kind of goods, and every manufacturer is free to use it.

2 *High, Inj.*, 2d Ed., 689, section 1063; *Filley v. Fassett*, 44 *Mo.*, 176; *Armstrong v. Kleinhens*, 1 *C. L. J.*, 180.

Old Bachelor,—*Old Coon*. *Old* is a generic word. *Rising Moon* no infringement of *Rising Sun*.

Morse v. Carroll, 1 *C. L. J.*, 612.

The word *Old* and the *red color* have been used by respondent unrestrained for a number of years.

Filley v. Child, 8 *Reporter*, 230; 2 *High, Inj.*, 2d Ed., 721, section 1100.

The difference in detail and in general appearance between the two labels is marked and striking (with or without the notice, *Not Old Caon*), and appellants are not entitled to relief.

2 *High, Inj.*, 2d Ed., p. 712, sec. 1086; *Conrad v. J. Uhrig Brewing Co.*, 8 *Mo. App.*, 282.

One may even use another's trade name, if he do it in good faith and so as to show that the goods are his own and not the others.

2 *High, Inj.*, 2d Ed., 700, sec. 1075; *Id.*, 715, sec. 1091.

THOMPSON, J., delivered the opinion of the Court.

This is a suit in equity to enjoin a colorable imitation of a label by which the plaintiffs have long marked an article of smok-

ing tobacco of their manufacture, called "Old Coon Smoking Tobacco," which has acquired a valuable reputation in the market. This label is in form, size and color substantially as follows:



REGISTERED MAY 4th, 1880.

The plaintiffs have used this label continuously since the year 1874, and have built up a large trade in this brand of tobacco. Their business has always been carried on at Springfield, Missouri. The defendant has also been engaged in manufacturing smoking tobacco at Springfield, Missouri, for several years past, and has for several years manufactured a brand of smoking tobacco called "Old Bachelor Smoking Tobacco." In the year 1883, the plaintiffs began putting their "Old Coon Smoking Tobacco" in cloth bags, retaining the above label, which they had previously used on the paper bags in which they had been accustomed to put up the same tobacco. Soon afterwards, namely, in the fall of 1883, the defendant began putting up his "Old Bachelor Smoking Tobacco" in cloth bags of the same size, at the same time changing his label, which previously had borne no colorable resemblance to

the above label of the plaintiffs, to a label of the form, size and color substantially as follows, with the exception of the words, "Not Old Coon;"



Printed in same color as the other (except that "Not Old Coon" is in black) same process, on white paper, not varnished.

As soon as the plaintiffs discovered that the defendant was putting up his tobacco with this label, they took the advice of counsel, and, under their instructions, a letter was written by their attorney to the defendant on the 29th of December, 1883, notifying him that his label deceived the public. The defendant replied that if that was so he would make some change in his label so that the public would not be deceived; and accordingly he made a change by printing on his label in large black letters the words "Not Old Coon," as above shown. The defendant sent one of these labels to the plaintiffs' attorney, who replied that the change did not amount to anything, and afterwards commenced this action. Two witnesses for the plaintiffs gave evidence to the effect that they had been deceived by the defendant's label into a supposition that the tobacco was the plaintiffs' tobacco known as

“Old Coon.” On the other hand the defendant introduced several witnesses, residents of Springfield, who testified under objection, after being shown these two labels, that they could not be deceived into taking one for the other, and that in their opinion no one would be deceived into purchasing one for the other at a different time or place.

We do not think it necessary to rule upon the question of the propriety of admitting this last testimony, because the counsel for both parties were so candid as to state on the argument, what seems very obvious to us, that the whole case must be decided upon a comparison of the two labels, there being no conflict in the testimony. We may also say at this point, that in our view, that portion of the argument advanced in favor of the defendant, which presses upon our attention a consideration of the presumptions which obtain in support of the judgment of the Circuit Court and of the consideration to which the finding of that Court is entitled in a cause in equity, is entirely misapplied here. In a suit in equity, where the facts are in dispute, an Appellate Court will, according to the settled practice in this State, defer very considerably to the finding of the Court below. Nor is it doubted that, where the question for decision is merely a question of law, the conclusions of the learned Judges of the Circuit Courts are entitled to respectful and considerate attention at the hands of the Appellate Courts; but nevertheless, in such cases, the Appellate Courts are bound to give judgment according to their views of the law.

2. Here, the facts being undisputed, the sole question is, what conclusion of law is to be applied to the facts; and deferring very considerably to the opinion of the learned Judge who decided this case, we nevertheless think that the plaintiffs are entitled to the substantial relief prayed for. We have had several cases of this general nature before us; the principles upon which they are to be determined are pretty well settled and understood; and there is no very serious difference as to those principles between the counsel of the opposing parties and the Court. The governing principle is, that one manufacturer shall not be allowed to impose his goods upon the public as the goods of another manu-

facturer, and so derive a profit from the reputation of that other. It is not necessary that the trade-mark, trade name, sign, label or other device which is employed by one merchant for that purpose shall be an exact imitation or counterfeit of the trade-mark, trade name, sign, label or other device employed by the other manufacturer. Nor is it required that the imitation be so close as to deceive cautious and prudent persons, it is sufficient that it be so close as to deceive the incautious and unwary, and thereby work substantial injury to the other manufacturer. Nor is it necessary to prove that actual fraud was intended by the manufacturer employing the simulated trade-mark, trade name, sign, label or other device, in order to entitle the other manufacturer to relief in equity, or to an action for damages at law. Here, as in most other civil actions, the law does not attempt to penetrate the secret motives or intent with which the act is done, but contents itself with the conclusion that the party intended the natural and probable consequence of the act, and gives its judgment accordingly. These principles are embodied and discussed with more or less distinctness in the following cases: *Filley v. Fasset*, 44 Mo., 168; *Conrad v. Joseph Uhrig Brewing Co.*, 8 Mo. App., 277; *Gamble v. Stephenson*, 10 Mo. App., 581; *Sanders v. Jacobs*, No. 3388 of this Court.

Applying these principles to the case before us, it is perceived that the defendants' label resembles the plaintiffs in three distinct particulars of form, size and color. 1. In form, it is an oblong like that of plaintiffs. It also has an oval vignette in the centre, and the plaintiffs' has a circular vignette in the upper centre. It also has the words designating the number of the factory printed in the left hand margin on a white field, the letters reading from the top downwards, as in the plaintiffs'. It also has the notice required by the Internal Revenue Law printed on a corresponding white field on the right hand margin, the letters reaching from the bottom upwards, as in the plaintiffs'. 2. In size it is the same as the plaintiffs'. 3. In color the whole background is red, the most conspicuous of the colors, as in the plaintiffs'. Leaving out of view the fact that defendant began putting up his tobacco in cloth bags soon after the plaintiffs began putting up their tobacco

in the same kind of packages, which the defendant explains by stating that smoking tobacco could no longer be sold in paper packages, we find that there are no less than six distinct points of resemblance between the two labels: 1. The general form; 2. The oval vignettes; 3. The lettering on the white field on the left-hand side; 4. The lettering on the white field on right-hand side; 5. The size; 6. The general color. In view of these points of resemblance it is scarcely probable that when the defendant designed this label he did not have in his mind the distinct purpose of making as close an imitation of the plaintiffs' label as he felt it safe to do. Now, as he admits in his testimony that since he adopted this label his trade has increased, and does not state any facts which lead to the inference that this increase has been due to any other cause than his success in making this colorable imitation of the plaintiffs' label, we think it a fair conclusion that he had the purpose in view of banking, so to speak, on the plaintiffs' reputation, and that he has measurably succeeded in so doing. We do not think that the printing of the words "Not Old Coon" upon the defendant's label affords a sufficient reparation of the wrong. The defendant can easily repair the wrong without much expense to himself, and without destroying the plate upon which his label is printed, by adopting a color upon the background distinctly different from red, or by making a new plate and changing the other distinctive characteristics of form and size above pointed out.

The judgment of the Circuit Court will be reversed, and the cause remanded with directions to enter a decree perpetually enjoining the defendant, his agents and servants, from manufacturing, selling or offering for sale any smoking tobacco manufactured by him, or by any other than the plaintiffs, having affixed upon the packages or bags containing the same the label described in the petition as used by the plaintiffs, or any other label having such characteristic features as to constitute a colorable resemblance of the plaintiffs' label. It is so ordered.

All the Judges concur.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

ATLANTIC MILLING COMPANY

vs.

ROWLAND, AND OTHERS.

DECIDED FEBRUARY, 1886.

REPORTED 27 FEDERAL REP., 24.

“Champion Flour” Case.

TRADE-MARK—INFRINGEMENT—DAMAGES—PROFITS.

Where a party has made profits by the sale of goods in violation of the rights of another in a trade-mark, the owner of the trade-mark is entitled to them, whether the same profits would have been made by him or not, and not to any more if they would, for the same profit could not be made by both.

Antonio Knauth, for orator.

Fred'k P. Foster, for defendants.

WHEELER, J.:

The final decree establishes the right of the orator to the use of the word “Champion” as a trade-mark for flour; that the defendants have infringed upon that right; and that the orator is entitled to recover of them the profits to the defendants and damages to

the orator, due to the infringement. The Master has reported that the defendants have used the trade-mark in the sale of 900 barrels of flour, and have made a profit of 25 cents per barrel through that infringement, amounting to \$225, and that the orator has suffered damages to that amount thereby. The defendants except to this finding only. The principal question is whether it is warranted by the evidence. The evidence tended to show that flour of the orator's having that mark was in the same market, that it would bring 25 cents more per barrel on account of that mark, and that the defendants used the mark in making the sales. The defendants' evidence tended to show that the flour would not bring any more on account of the mark, and that they lost, on all the lots making up the 900 barrels, except one, \$43, and on that one made only \$7.50. All questions as to the weight of conflicting evidence were for the Master. The defendants might get 25 cents per barrel more on account of the trade-mark, and still lose on the whole transaction. The profits due to the trade-mark only, and not the profits of the whole business were the subject of inquiry. *Garretson v. Clark*, 15 *Blatchf.*, 70; *S. C.*, 111 *U. S.*, 120, and 4 *Sup. Ct. Rep.*, 291. The general loss would be less on account of what the trade-mark brought more.

It is argued that the evidence does not show that the orator would have made this profit if the defendants had not. This might be true, and not affect the rights of the parties. If the defendants made profits by their invasion of the orator's rights, the orator is entitled to them whether the same profits would have been made by the orator or not, and not to any more if they would, for the same profits could not be made by both. But the Master seems to have inferred that they would, and therefore to have found that the orator was damaged by the loss of profits to the same extent that the defendants saved by them. The fact that the flour of the orators bearing this mark was in the same market would seem to be sufficient to warrant this finding. *Faber v. Hovey*, 1 *Wkly. Dig.*, 529; *S. C.*, 73 *N. Y.*, 592.

Exceptions overruled, report accepted and confirmed, and decree to be entered accordingly.

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CIRCUIT COURT UNITED STATES, NORTHERN
DISTRICT OF OHIO, EASTERN DIVISION. IN
EQUITY.*

THE ROYAL BAKING POWDER COMPANY

vs.

JOHN H. VOUWIE, AND HENRY J. VOUWIE, Partners
as VOUWIE BROS.

DECIDED MARCH, 1886.

“Royal Baking Powder” Case.

BILL OF COMPLAINT WITH PRAYER FOR INJUNCTION—
LABEL.

1. There must be a general resemblance, similarity of form, color, design, identity and arrangement of words, so as to mislead persons who exercise ordinary caution in purchasing articles on which such label is placed.
2. The label of respondents, by reason of such general similarity and resemblance to that of complainant, would readily impose upon buyers of ordinary care and prudence.
3. It is therefore an infringement, and its further use in such resembling form enjoined.

* Not reported.

THE bill of complaint sets forth the incorporation of complainant, and the manufacture and sale by it of baking powder; that it adopted, affixed and used as a name for the article manufactured, the name "Royal" as a trade-mark.

That such corporation for the purpose of introducing and selling powder, put the same up in cylindrical cans, with the said name affixed thereto, and also placed thereon labels of a peculiar color, wording, device and design, and has continued to so use and affix said name and labels.

The complaint then sets forth and describes minutely and particularly the color, wording, device and design of the said label, and makes profert of such cans with the labels described affixed thereto.

It further alleges that the said package or cans, with the said label, colors, wording, device and design, combined together, constitute a trade-mark or trading device, distinguishing the baking powder manufactured and sold by complainant from that of others engaged in similar lines of business, that the baking powder so manufactured, put up, and sold by complainant is absolutely pure, healthful and of superior quality; that, put up in such form and manner, it has had a very large sale in all parts of the United States, and has become well known to the public throughout the United States by the peculiar color, wording, device and design of the labels affixed to the cans or packages containing said baking powder, so that dealers in and consumers of baking powder well knew that baking powder put up in said cans with the labels of the peculiar color, wording, devices and design affixed thereto indicated that the baking powder so put up and distinguished was manufactured and sold by complainant. The complainant further sets forth that the defendants are engaged in the manufacture of a so-called baking powder; that the article manufactured by them is not pure, healthful and of good quality, but is manufactured from burnt alum and other impure, deleterious and cheap ingredients detrimental to the health; that the article manufactured by defendants is put up in cans, in general size and appearance like the cans used by complainant; that defendants have so reproduced, copied and imitated the label of complainant "that their label

resembles that of complainant, except in the centre piece and name of manufacturers; and in color, design, general arrangement of words and in general appearance, the label of said defendants is largely similar to the said label of complainant and could not be readily distinguished therefrom." And complainant then alleges that defendants affix their labels to cans of baking powder manufactured by them, and makes profert of such cans with defendants' label affixed thereto.

The bill prays, among other things, that defendants may be perpetually enjoined from using their said label on, around, or in connection with any cans, boxes, or packages of any kind containing baking powder, or from selling baking powder with such labels attached.

OPINION.

WELKER, J.:

The complainant alleges that it had adopted as a tradé-mark a certain label, and for a long time had affixed the same to cans and other packages of baking powder manufactured by it; that the article manufactured by it is identified and distinguished by the label so affixed; and it complains that the respondents are using a certain label in connection with similar cans and packages of baking powder manufactured by them, and in violation of the complainant's right to the exclusive use of its said label, or trade-mark. Both of these labels are described and set forth in the complainant's bill.

The respondents do not controvert the right of the complainant to the exclusive use of its label.

The only question is whether the respondents' label is an infringement of that of the complainant. These labels are not exactly alike. In cases where the infringed label or trade-mark is not a *fac simile* of the infringed in all respects, the rule for determining whether there is an infringement seems to be this :

1. There must be a general resemblance, similarity of form, color, design, identity, and arrangement of words, so as to mislead persons who exercise ordinary caution in purchasing articles on which such label is placed, and prevent such persons from

readily distinguishing between the original and imitation label, and so buy the one for the other. It is well said that "a sufficient distinctive individuality must be presented as to procure for the person himself the benefit of that deception which generally resemblance is calculated to produce."

In this case, upon examination and comparison of the alleged imitation label of the respondents with that of the complainant's genuine label, it appears that it is an exact imitation, save the centre figure and the name of the company and manufacturer—the one using the words "Forest City Baking Powder Company" and the name of respondents, "Vouwie Bros.," the other "Royal Baking Powder Company." The color, wording, the arrangement of words and designs, with the above exception, of the two labels are identical—the general form and appearance the same.

2. The label of the respondents, by reason of such general similarity and resemblance to that of the complainant, would readily impose upon buyers of ordinary care and prudence. The general effect of it is misleading, and calculated to deceive, and thus secures to the respondents the benefits growing out of such general resemblance to the label of the complainant.

3. It is therefore an infringement of complainant's right, and its further use by the respondents in such resembling form should be enjoined. And it is so ordered.

DECREE.

In the case of the *Royal Baking Powder Company v. John H. Vouwie and Henry J. Vouwie, partners, as Vouwie Bros.*

This cause came to be heard at this Term, Tuesday, March 2, 1886, in the City of Cleveland, in the said District, Present, Hon. MARTIN WELKER, District Judge, and was argued by counsel, and thereupon, upon consideration thereof, it was ordered, adjudged and decreed as follows:

That the sole and exclusive right to use the label affixed by complainant to cans and other packages of baking powder manufactured by it, as described and set forth in the bill of complaint, is in the said complainant, and the use by said defendants of the label described in said bill as being used on, around and in con-

nection with cans, boxes or other packages containing baking powder manufactured by defendants, is in violation of the said exclusive right of complainant.

It is further ordered, adjudged and decreed that a perpetual injunction be and hereby is issued against said defendants and each of them, their agents, attorneys, clerks, servants and workmen, enjoining and restraining them from using in any manner whatever, on, around or in connection with cans, boxes or other packages containing, or purporting to contain baking powder, either of the said labels described and set forth in said bill; and from offering to sell, selling or in any manner disposing of cans, boxes or other packages containing, or purporting to contain baking powder with the said labels or either of them affixed thereto.

The said complainant having waived all claim for damages for or on account of the use by defendants of the labels described in said bill, it is further ordered, adjudged and decreed that said complainant do recover of said defendants its costs and expenses herein, to be taxed at \$——— for which execution may issue as upon judgment at law.

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COURT OF APPEALS OF MARYLAND.
IN EQUITY.

ADOLPH C. MEYER

vs.

CHRISTIAN DEVRIES, ET AL.

DECIDED 9 MARCH, 1886.

REPORTED 64 MD., 532.

“Salvation Oil vs. St. Jacobs Oil.

1. An appeal lies from an order of Court which so modifies and changes an injunction, as to effectually extinguish it to the extent of its operation.
2. One may publish the fact of the pendency of proceedings in Court, if no reference is made to any discussion of the question involved or to anything tending in any way to anticipate or hinder the administration of justice at the hearing, and an injunction restraining such publication of legal proceedings, may be modified so as to permit the publication within this limit.

APPEAL from the order of the Circuit Court of Baltimore City, modifying an injunction. *Affirmed.*

The facts sufficiently appear in the opinion.

Argued before ALVEY, Ch. J., and MILLER, IRVING, ROBINSON, RITCHIE, STONE, and BRYAN, JJ.

Mr. Thomas R. Clendenin, for appellant.

Prior to an adjudication, the appellees had neither the right to advertise the case which they had brought, nor their remedy by means of or in connection with the case, if such advertisements were calculated to act injuriously to the appellant.

That it is improper to make publications in reference to a case prior to its conclusion and that such publications may be restrained by injunction will be shown by the following citations and authorities.

Reports of preliminary proceedings are regarded as having a tendency to pervert the public mind, and it is libelous to publish them. *Rex v. Fisher*, 2 *Camp.*, 563.

It is a contempt of Court to publish preliminary proceedings. *Rex v. Clement*, 4 *Barn. & Ald.*, 218; *Holt, Libel*, 158, chap. 9; *Recheltenham, etc., Wagon Co.* 17 *W. R.*, 463.

It is libelous to publish the preliminary examinations before a magistrate. *Holt, Libel*, 161.

The mere publication of *ex parte* evidence before a trial was highly criminal. *Holt, Libel*, 162, *note*.

It is improper to make publications before the hearing of a cause. *Tichborne v. Mostyn*, *L. R.*, 7 *Eq.*, 55.

Pending litigation, the Court will restrain publication of account calculated to prejudice the case of the opponent. *Coleman v. West Hart. R. Co.*, 8 *W. R.*, 734.

In *Stiles v. Nokes*, 7 *East*, 503, Lord Ellenborough observes: "It must not be taken for granted that the publication of every matter which passes in a Court of justice, however truly represented, is, under all circumstances and with whatever motive, justifiable; but that doctrine must be taken with grains of allowance." *Holt, Libel*, 160, *notes*.

Lord Hardwicke considered persons concerned in the business of the Court as being under the protection of the Court, and not

to be driven to other remedies against libels upon them in this respect. *Ex parte Jones*, 13 *Ves.*, 238.

In order to obtain an injunction in an action to restrain the issue by defendants of trade circular, which the plaintiff alleged to be libelous, and injurious, to his trade, it is sufficient if the plaintiff shows that the libel is calculated to injure his trade. It is not necessary that he should prove actual damage. *Thomas v. William*, L. R., 14 *Ch. D.*, 864.

The case of *Thorley's Cattle Food Co. v. Massam*, L. R., 14 *Ch. D.*, 773, is an important one, where an injunction was asked for, decided among other things the following:

1. That the Court can interfere by injunction.
2. That such a statement as there was made was calculated to injure the plaintiff.
3. That evidence of injury was unnecessary, but if the Court can see that the advertisement in itself is calculated to injure, that is quite sufficient, without any positive evidence that injury has been sustained.

The Court has power to issue an injunction restraining the defendant from publishing concerning the plaintiff, to the injury of his trade, matter which a jury would have found to be libelous, and this power may be exercised by the Judge who tries the case. *Saxby v. Esterbrook*, L. R., 3 *C. P. Div.*, 339.

"A full and adequate remedy at law" means such a remedy at law as ousts the jurisdiction of Court of Equity. *Kunkel v. Fitzhugh*, 22 *Md.*, 567; *Webb v. Ridgely*, 38 *Md.*, 364.

Difficulty of adequate redress at law and the probability of a multitude of suits authorize injunction. Also irreparable injury; and it is granted more liberally than formerly. *Lucas v. McBlair*, 12 *Gill & J.*, 12.

Courts of Equity decline to lay down any rule which shall limit their power and discretion as to the particular cases on which injunctions shall be granted or withheld. And there is wisdom in this course, for it is impossible to foresee all the exigencies of society which may require their aid and assistance to protect rights or redress wrongs. *Story, Eq. Jur.*, 156.

That publications may be restrained, see, *Quartz Hill Conn. Gold Min. Co. v. Beall*, L. R., 20 Ch. D., 501; *Hermann Loog v. Bean*, L. R., 26 Ch. D., 306; *Little v. Thompson*, 2 Bear., 129.

Messrs. Charles Marshall and Thomas W. Hall, for appellees.

BRYAN, J., delivered the opinion of the Court:

The appellant filed a bill in equity against the appellees, in which it was alleged that they had published a certain statement in the *Baltimore American*, and that it was their purpose to disseminate and distribute it universally, as well in this State as elsewhere. This statement purported to be an abstract of a bill of complaint, charging that he had infringed their trade-mark by which they designated a certain medical preparation which they manufactured under the name of St. Jacob's Oil.

The appellant's bill of complaint averred, with a particularity not necessary now to repeat, that he would sustain irreparable damage unless the appellees were restrained from their proceedings, and prayed an injunction. The Circuit Court enjoined the appellees from the further publication and dissemination of the said statement, and from any other publication in reference to the suit brought by them.

Afterwards, during the succeeding term, on the petition of the appellees, the Court modified the injunction so as to permit them to make known to all persons who might be interested, that a suit had been instituted by them to restrain the appellant from selling "Salvation Oil," upon the claim by them that the manufacture and sale thereof was an infringement of their trade-mark "St. Jacob's Oil," and that they intended to endeavor to prevent all dealers from selling "Salvation Oil," and to hold them responsible for violation of said trade-mark.

This order changed and limited the original injunction. It effectually extinguished it to the extent of its operation. Nothing more could be effected within its limits, by the most formal orders of dissolution.

We think that an appeal properly lies from it. But we think that the Circuit Court did not err in passing it. There is no appeal from the original order for an injunction, and its propriety is not a question before us; but the modification subsequently made by the Court merely gave the appellees permission to exercise a right which seems to us very clearly to belong to them. The order merely authorizes the notification of a fact, to wit: the pendency of proceedings in Court; no reference is made to any discussion of the question involved, or anything tending in any way to anticipate or hinder the administration of justice at the hearing.

Order affirmed with costs, and cause remanded.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

APOLLINARIS COMPANY, LIMITED,

vs.

SCHERER.

DECIDED 16 MARCH, 1886.

REPORTED 16 FEDERAL REP., 18.

“Hunyadi Janos” Case.

TRADE-MARK—INFRINGEMENT—CONTRACT FOR EXCLUSIVE
RIGHT TO SELL “HUNYADI JANOS” WATER—PURCHASE
FROM PARTIES TO WHOM OWNER RIGHTFULLY SOLD—
RESELLING.

The owner of a spring of mineral water in Hungary, entered into a contract with complainant giving him the exclusive right to export and sell the water under its name of “Hunyadi Janos,” which he adopted as a trade-mark in Great Britain and America. Defendant applied to the owner to purchase the bottled water but was refused, and purchased it from those to whom it had been sold in Germany, and sold it in the United States in bottles with the same label as that used by complainant, except that defendant’s bottles, like all those sold by the owner, were stamped with the words “Caution. This bottle is not intended

for export, and if exported for sale in * * * America, * * * the public is cautioned against purchasing it;" while complainant's bottles were stamped "Sole Exporters." HELD:

That complainant was not entitled to an injunction to restrain defendant from selling the water.

Roscoe Conkling and *Henry Melville*, for complainant.

Wayne MacVeagh and *Emile Beneville*, for defendant.

WALLACE, J.:

The complainant has applied for an injunction *pendente lite* to restrain the defendant from importing into the United States or selling here any water under the name or designation "Hunyadi Janos," or offering to sell any water in bottles with that name upon them, or with labels like those adopted and used by the complainant to designate and distinguish the water from other mineral waters. The defendant is importing and selling here the water of a certain mineral spring of Hungary owned by one Andreas Saxlehner. The waters are known as "Hunyadi Janos," the spring having been christened by that name by Saxlehner, and the name as applied to the water having been adopted by him as a trade-mark. Prior to the time of the acts complained of Saxlehner transferred to the complainant the sole right to export the waters from Hungary to Great Britain and America, and to sell them in these countries and use the trade-mark. For the more effectual protection of their respective rights Saxlehner and the complainant adopted labels to be affixed to the bottles of water to be sold by each bearing the name "Hunyadi Janos" and other distinguishing devices. The labels used by Saxlehner contained the following printed notice:

"Caution. This bottle is not intended for export, and if exported for sale in Great Britain, her colonies, America, or other transmarine places, the public is cautioned against purchasing it. Andreas Saxlehner."

The labels used by the complainant contained in the place of this notice the following:

“Sole exporters. The Apollinaris Company, Limited, London.”

Thereafter all water sold by Saxlehner to purchasers in Germany and other parts of Continental Europe was sold in bottles with the label which had been adopted for him, and all the water sold by the complainant in Great Britain and the United States was sold in bottles with the label adopted for its use.

The complainant established an agency for the sale of the water in this country, but, as it now asserts, is unable to maintain its own prices for the article because the defendant purchases the water in Germany from persons to whom it has been sold by Saxlehner, imports it, and sells it here at lower prices. It is shown that the defendant purchases the water in bottles under the label adopted by Saxlehner containing the cautionary notice, and that he does this after having applied to Saxlehner to sell him the water and been refused and informed by Saxlehner of the complainant's rights.

The bill of complaint proceeds in part upon the theory that defendant is infringing the complainant's trade-mark in the name and label applied to the water, but all the averments in this behalf may be disregarded as irrelevant to the real question in the case. No doubt is entertained that the name when applied to the water is a valid trade-mark, and that the complainant should be protected against the unauthorized use of the trade-mark by another. The complainant would be entitled to this protection entirely irrespective of the registration of its trade-mark in the Patent Office. The same observations apply to the use of the label. The complainant has a common law right to the name and the label as a trade-mark by which its mineral waters are identified; and as the necessary diversity of citizenship exists between the parties to confer jurisdiction upon this Court, the only effect of registration is to afford and perpetuate the evidence of the complainant's title. But the defendant is selling the genuine water, and therefore the trade-mark is not infringed. There is no exclusive right to the use of a name or symbol or emblematic device except to denote the authenticity of the article with which

it has become identical by association. The name has no office except to vouch for the genuineness of the thing which it distinguishes from all counterfeits; and until it is sought to be used as a false token to denote that the product or commodity to which it is applied is the product or commodity which it properly authenticates, the law of trade-mark cannot be invoked.

The real question in the case is whether the defendant is unlawfully interfering with any exclusive right of the complainant to control the sale of the water in the territory ceded to the complainant for that purpose by Saxlehner. It is manifest that the acts of the defendant tend to deprive the complainant of the substantial advantages which it expected to obtain from the privilege transferred to it by Saxlehner. It can no longer maintain its own prices for the mineral water, or hold out the inducement it formerly could to the agents it has selected to introduce the article to the patronage of the public, and build up a trade. It can no longer protect itself as efficiently against the chances of a spurious article being palmed off upon the public as its own. It is therefore measurably deprived by the acts of the defendant of the profits and benefits which it contemplated when it purchased from Saxlehner the exclusive right of importing the water into this country and selling it here. If the complainant could acquire an exclusive right to sell the water here the case would be plain. If it could not, it still remains to consider whether the defendant has violated any duty which the law recognizes in his relations to the transaction. There would seem to be no doubt that the agreement between Saxlehner and the complainant was a valid one. He had the right to dispose of his property in the product of his spring as he saw fit, and it is not apparent how the transfer of a part of his exclusive right to vend the water, by which a territorial division in its enjoyment was created, can be deemed obnoxious to any principle of public policy as tending to create a monopoly or an unlawful restraint of trade. If Saxlehner were now endeavoring to compete with the complainant in the sale of the water in the ceded territory, his conduct would furnish a ground for equitable jurisdiction and the remedy of an injunction because of the inadequacy of a remedy at law. *Bisp.*

Eq., 463. It is equally clear that if the defendant were co-operating with Saxlehner collusively to violate the complainant's right to the exclusive sale of the water he also would be restrained. In such a case the foundation of equitable redress would be the breach of covenant on the part of Saxlehner, and the defendant when acting in aid would be identified with Saxlehner and amenable to the remedy as though he were Saxlehner himself. But it is important to bear in mind that the case would be one for equitable cognizance and the remedy of an injunction, merely upon the ground that the complainant's damages arising from the breach of covenant could not be reparably redressed at law.

It was not possible by any contract or grant between Saxlehner and the complainant to create a territorial title to the products of the spring; no such title is known to the law of personal property. No analogy can be drawn from the law of patents for inventions, because the title to this species of property is purely statutory; and it is by force of arbitrary law alone that the title in the incorporeal property can be sub-divided into territorial parts. The decisions which have been relied on in argument as sustaining the right of the owner of a patent to prevent a sale or use of the patented thing outside of the territorial limits for which a license has been granted, although the license authorized a sale and the sale was made within the territorial limits of the license, have therefore no application to the present case. The rights of complainant rest purely in covenant. If Saxlehner himself should sell the water here the purchaser would acquire title to the article with all the rights of a proprietor to use it or to do with it as he might see fit. Suppose the purchaser should be fully aware at the time of buying that Saxlehner had covenanted with the complainant that the latter alone should have the privilege of selling the water here, could it be seriously questioned that the purchaser would nevertheless acquire a perfect title? Although the defendant was fully aware when he bought the water which he has imported from those to whom Saxlehner had sold it of the terms of the agreement between Saxlehner and the complainant, that circumstance does not help the complainant's case. There was no

breach of covenant on the part of Saxlehner; on the contrary, he did all that was in his power to carry out the agreement between himself and the complainant. The defendant did not expressly or impliedly assume not to sell the water within the territory ceded to the complainant; on the contrary, he repudiated any recognition of such an obligation. The insuperable difficulty in the way of the complainant is that any purchaser of the water, wherever he purchases it, acquires a valid title to treat it as his own property.

Upon the first impression it would seem that the defendant cannot be justified in a course of conduct which is calculated if not deliberately prompted by the design to deprive the complainant of the benefit of its contract with Saxlehner, and that there must be some principle of equity which can be invoked to prevent him from doing that which Saxlehner himself would not be permitted to do. The interposition of a Court of equity is frequently invoked and always successfully to restrain unlawful competition in trade. All practices between rivals in business which tend to engender unfair competition are odious and will be suppressed by injunction. *Croft v. Day*, 7 *Beav.*, 84; *Harper v. Pearson*, 3 *Law T.*, (*N. S.*), 547; *Stevens v. Paine*, 18 *Law T.*, (*N. S.*), 600; *Glenny v. Smith*, 11 *Jur.*, (*N. S.*), 964; *Mack v. Petter*, 41 *Law J. Ch.*, 781; *Burgess v. Burgess*, 3 *De Gex, M. & G.*, 896; *Glen & H. Manufacturing Co. v. Hall*, 61 *N. Y.*, 226; *Goodyear Rubber Co. v. Goodyear's Manufacturing Co.*, 21 *Fed. Rep.*, 276; *Genin v. Chadsey*, 2 *Brewst.*, 330; *Avery v. Meikle*, 17 *West. Jur.*, 292; *Bell v. Locke*, 8 *Paige*, 75. But the adjudications which illustrate the principle rest upon the ground that a merchant or trader is entitled to protection only against dishonest or perfidious rivalry in his business. He will be protected against the fraudulent or deceitful simulations by a competitor of tokens which tend to confuse the identity or business of the one with the other, and against the false representation of facts which tend to mislead the public and divert custom from the one to the other. Anything short of this, however, is lawful competition. Accordingly the Courts will not attempt to prevent the sending of circulars or advertisements by one to the

customers of a competitor in business although designed to alienate patronage, if they contain no deceitful or misleading statements.

The law does not deal with motives which are not accompanied by a wrongful overt act. If the defendant is legally justified in buying where he can and selling as he chooses, it is not material whether he is actuated by a desire to annoy the complainant or to promote his own pecuniary interests.

The complainant is without remedy and the motion for an injunction must be denied.

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IN THE UNITED STATES PATENT OFFICE.

EX PARTE WIESEL.

DECIDED 30 MARCH, 1886.

REPORTED 36 O. G., 689.

“Kollerina Label” Case.

The Act of June 18, 1874, providing for the registration of labels in the Patent Office, did not intend to provide for such registration of a label which was in fact a trade-mark. Where a label which “bears such distinguishing marks as entitle it to registration as a trade-mark” is proposed for registration, the “function of the Commissioner” is not “merely ministerial,” and he is at liberty to refuse such registration.

APPEAL from Principal Examiner.

LABEL.—Application of John M. Wiesel, filed November 12, 1885.

Messrs. Dodge & Son, for the applicant.

MONTGOMERY, *Commissioner* :

The principal Examiner refuses to register as a label the word “Kollerina.” From such refusal applicant appeals to the Commissioner. On the argument it was admitted by counsel for ap-

plicant that this word "might be a trade-mark," and it was said that it was in fact "a true label bearing a trade-mark." In the written argument of counsel it is said that no dispute is made, but that the word "Kollerina," if it were presented alone, and if the necessary adoption and use had occurred, might be registered as a trade-mark.

In the case of *The United States, ex rel. The Willcox & Gibbs Sewing Machine Company, V. E. M. Marble*, (1882, C. D., 445), the Supreme Court of the District of Columbia held that under the old statute, which was in force prior to and at the time of the passage of the Act of June 18, 1874, the owner of a label bearing distinguishing marks, was entitled to have recorded in the Patent Office as a trade-mark, or "if he preferred to do so, to have it registered in the office of the Librarian of Congress as a mere print."

It was further held that the Librarian of Congress had no discretion to refuse to recognize it as a print, because it could be recognized by the Commissioner of Patents as a trade-mark; and further, that whether it should be treated as the one or the other depended wholly upon the will of its proprietor.

It was further held that such Act of June 18, 1874, transferring the registration of prints which were designed to be used as labels from the Librarian of Congress to the Patent Office, did not deprive such proprietor of this right to choose, but simply "changed the place of registry."

And, further, that the "function of the Commissioner of Patents was merely ministerial," and he was bound to register a label when proposed, even though it "bear such distinguishing marks as entitled it to registration as a trade-mark."

In the case of *The United States, ex rel. Theodore Schumacher and Ettlinger, V. E. M. Marble, Commissioner*, (3 Mackey, 32), the same Court substantially reaffirmed the doctrine of the foregoing case.

In both cases a *mandamus* issued to compel the registration.

It seems to me very clear that the Act of June 18, 1874, did not intend to provide for the registration of a label which was in fact a trade-mark. Still, I should feel impelled to respect

and follow the doctrine of these cases, were it not for what has since transpired in the case of *Ex parte Moodie*, (28 O. G., 1271), or unless I was impressed, as my immediate predecessor seems to have been, that the Court in the first two cases above mentioned, had not given the subject careful consideration. I am free to say, however, that the course which was pursued in the *Moodie Case* above cited, seems to have relieved the Commissioner from any obligation which might have rested upon him to follow the doctrine of such two cases.

In the *Moodie Case*, Commissioner Butterworth held that a label which was in fact a trade-mark, *was not entitled* to registration as a label, and he therefore refused such registration. Applicant applied to this same Court for a *mandamus*, and the Court denied the writ. It follows, therefore, that *Ex parte Moodie* stands in this office to-day as the latest determination and ruling upon this subject, which ruling stands unreversed and not vacated.

I feel compelled to say that the doctrine laid down by my predecessor in this *Moodie Case*, entirely meets my own views. The action of the Examiner must therefore be affirmed, and the registration refused.

In conclusion, I take occasion to say, that should applicant desire to secure a review of this case in the Supreme Court of the District of Columbia, upon application for *mandamus*, or otherwise, I should be very glad to afford all facilities in my power, and to aid as much as possible in securing a decision of the distinct question upon the merits, and in case of such determination, whatever may be the ruling of the Court, it will be followed and observed in this office.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

ESTES, AND OTHERS,

vs.

LESLIE, AND OTHERS,

DECIDED 8 APRIL, 1886.

REPORTED 27 FEDERAL REP., 22.

“Chatterbox” Case.

TRADE NAME—CHATTERBOX—INFRINGEMENT.

The use of the word “Chatterbox,” in connection with the same method of selection and illustration of stories, form of binding and vignette, by defendants, HELD, an infringement of complainant’s right in the name.

John L. S. Roberts, for orators.

Charles E. Rushmore, for defendants.

WHEELER, J.:

This case is similar to *Estes v. Williams*, 21 *Fed. Rep.*, 189, in respect to the right of the orators to the exclusive use of the name “Chatterbox” upon their series of juvenile publications in

this country. No occasion appears for repeating what was there said. The question of laches is more relied upon here as a defence than it was there. There is a question as to the effect of a decree in favor of the defendants against the orators, entered by consent in the Court of Common Pleas of New York in 1881; and a question whether the use of that name by the defendants, upon their publication, amounts to any misrepresentation as to their source.

Mr. Johnston, from whom the orators derive their right, appears to have had the exclusive use of this name for his series of publications, both in England and this country, without interference, from 1866 to 1876, and his works to have become well-known by that name in both countries. By that means he had acquired a clear right to that name for the admittance of his works among customers. So far as is shown, he vindicated this right as often as it was invaded to his knowledge until the time when he conveyed it to the orators in 1880. Since then they have not, for any length of time, abandoned it, but have continually asserted it in one way or another, although not against all trespassers at once. No right as against these defendants appears to have been lost in this manner. *Collins Co. v. Ames*, 20 *Blatchf.*, 542; *S. C.*, 18 *Fed Rep.*, 561.

The operative part of the decree of the Court of Common Pleas restrained the orators from selling any publication called the "Chatterbox" or "Frank Leslie's Chatterbox," with the name "Frank Leslie," or the address "Frank Leslie's Publishing House, 53, 55 and 57 Park Place, New York," thereon. This did not extend to the name "Chatterbox," and no right to its use was decreed to either party, or affected by the decree in any manner.

Whether the use which defendants make of the name is calculated to put their publications in the place which those of the orators would otherwise take, is principally a question of fact, and is the most important one open in this case. The publication of Johnstone were composed of selections of stories, sketches, and poems, with pictorial illustrations intended for, and interesting to, the young; printed with a head-line, "Chatterbox," on each

page; bound in square form, in illuminated boards, with vignette slightly varying in style from one number to another, and the name "Chatterbox" prominently on the front, and with a plain cloth back. The selections had been made with such care and skill, and the illustrations and style of binding made so attractive, that they had acquired great popularity, and found large sales, as well in this country as elsewhere. The same method of selection and illustration, square form, style of binding, and vignette, as well as name on the cover, have been taken by the defendants. The name is the only thing in question in this case, but the adoption of so many other features tends to show the intent with which the name is used. All these things together lead plainly to the conclusion that the name has been appropriated to gain an advantage from the reputation and popularity which Johnstone's work had acquired under it, and that this appropriation of it is calculated to make the works of the defendants pass for his to some extent. It is true that the name "Frank Leslie" is added, so that the title is "Frank Leslie's Chatterbox," and the address of the publishing house is put on. This appears to be done, however, for the purpose of adding the reputation of Frank Leslie and of that publishing house to that of the Chatterbox, rather than for that of building up a new reputation under that name. If nothing had been wanted of the popularity which had been acquired under it, and which it stood for, it could have been left, and another name taken to build up. The defendants do not copy the orators' publications, but imitate them, and apply the name of the orators' publications to their imitations.

Let a decree be entered for orators for an injunction and an account, with costs.

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CIRCUIT COURT UNITED STATES, WESTERN
DISTRICT OF PENNSYLVANIA. IN EQUITY.

PRATT MANUFACTURING COMPANY

vs.

ASTRAL REFINING CO., LIMITED, AND OTHERS.

DECIDED 30 APRIL, 1886.

REPORTED 27 FEDERAL REP., 492.

“Pratt's Astral Oil” Case.

1. TRADE-MARK—“ASTRAL OIL.”—The appearance of the word “Astral,” in a combination of words constituting a trade-mark, does not preclude its use in all other combinations formed for the like purpose.
HELD, therefore,

That the plaintiff's trade-mark, “Pratt's Astral Oil,” applied to refined petroleum, was not infringed by the use of the words “Standard White Astral Oil,” to designate the defendants' refined petroleum.

2. SAME—KNOWN USE OF WORD.—An oil burning lamp called “Astral Lamp,” having been long well known and in common use, *semble*, that the word “Astral” was without the range of lawful appropriation as a trade-mark for refined petroleum.
3. SAME—RELIEF REFUSED.—Relief will not be granted against the use of a brand which points unequivocally to origin, and except in the common use of the words “Astral Oil,” so differs from the plaintiff's brand that purchasers will not mistake the one for the other.

178 Pratt Manufacturing Co. *vs.* Astral Refining Co., *et al.*

C. Heydrick, for complainant.

J. W. Lee and *Martin Carey*, for respondents.

ACHESON, J.:

This is a suit by the Pratt Manufacturing Company, a corporation of the State of New York, against the Astral Refining Company, Limited, a partnership association formed under the laws of the State of Pennsylvania, and the managers thereof, to restrain the defendants from using the words "Astral Oil," either alone or in connection with other words, as a brand or mark upon packages of refined petroleum, and from the use of the word "Astral" as part of their partnership name; and also to compel the defendants to account for the profits of refined petroleum so branded, sold by them; the plaintiff alleging such use of said words or word to be an infringement of its trade-mark.

It appears that Charles Pratt, who carried on the business of refining petroleum in the State of New York, in the year 1869 adopted as a trade-mark in his business the words "Pratt's Astral Oil" which he continued so to use until the year 1874, when he transferred his business and his right and title to said trade-mark to the plaintiff company, which has since continued the said business, and the use therein of said trade-mark,—the plaintiff having, on October 25, 1881, obtained registration of said trade-mark agreeably to the provisions of the Act of Congress of March 3, 1881. The bill alleges that the plaintiff "has, at great expense, introduced the particular grade and quality of refined petroleum manufactured by it into the market, not only of this country, but of foreign countries, under the name 'Pratt's Astral Oil,' by which name your orator's product long since became and now is widely known." The evidence, however, shows that in actual practice the plaintiff does not designate its refined petroleum by the words "Pratt's Astral Oil" simply, but by a brand of this character, viz: Within a circular border, and following the upper arc of the circle, are the words "Pratt's Astral Oil;" within and following the lower arc of the circle is the word "New York;" above "New York" are the figures and word "46 Broadway;" and in the

center of the circle is a peculiar device or design, beneath which is the word "trade-mark."

The refinery of the defendant company, which is situated on the Allegheny Valley Railroad, near Oil City, Pennsylvania, was built, and the name "Astral" given to it, about January or February, 1881. While the works were in course of erection, the railroad company established a station at that point, and called it Astral; and on April 28, 1884, a post office of the same name was established there. About April 1, 1884, the limited partnership of defendant was organized, and purchased said works, and has since operated them. It is satisfactorily shown that neither the parties who originally applied the word "Astral" to these works, nor the defendants when they adopted it as part of their partnership name, had any knowledge whatever that the word was used by the plaintiff. Upon the heads of their petroleum barrels the defendants' brand, in circular form, the words "The Astral Refining Company, Limited, Oil City, Pa.;" and in the centre of such circle are the words, "Standard White Astral Oil." This is the entire brand, and the whole is in large and conspicuous letters.

Such being the material facts of the case, is the plaintiff entitled to the relief sought? It will be observed that the plaintiff in effect claims an exclusive property in the use of the words "Astral Oil," as applied to refined petroleum; and also in the use of the word "Astral," as applied to the business of refining petroleum. Can this pretension be sustained? I think not. In the first place, I strongly incline to the opinion that the word "Astral" was without the range of lawful appropriation as a trade-mark for refined petroleum by reason of the fact that long before it was employed by Charles Pratt the appellation had been given to an oil-burning lamp well known and in common use. Now, very naturally, the public might associate the words "Astral Oil" with the "Astral Lamp," and thus the exclusive use of those words as a trade-mark would have a tendency to give the plaintiff an unfair and hurtful monopoly in contravention of that rule of law which forbids the use of anything as a trade-mark which would destroy competition. *Canal Co. v. Clark*, 13 Wall., 323. Then in the second place, the appropriation of the word "Astral" in one combination of

173 Pratt Manufacturing Co. vs. Astral Refining Co., et al.

words does not preclude its use in all other combinations. Such was the determination of the Supreme Court of Pennsylvania in respect to the word "Samaritan," as applied to compound medicines. *Desmond's Appeal*, 13 *Wkly. Notes Cas.*, 303.

The plaintiff's trade-mark consists, not of the word "Astral" alone, nor yet of the two words "Astral Oil." The prefix "Pratt's" is the distinguishing word in the plaintiff's combination, and, in truth, is indispensable; for, according to the averment of the bill, it is by the name "Pratt's Astral Oil" that the plaintiff's product is known in the markets of the world. Is it credible that purchasers possessing ordinary intelligence, and observing reasonable care, would confound "Standard White Astral Oil" with "Pratt's Astral Oil?" Moreover, the plaintiff's packages of refined petroleum are designated by a peculiar brand of which the said name forms a part. Now, the brand used by the defendants' is not in imitation of the plaintiff's, but essentially differs therefrom. Indeed, it seems to me to be quite impossible that any purchaser would mistake one for the other. The brand of the defendant company, so far from tending to mislead buyers, points directly and unequivocally to the origin of the contents of the packages.

There is not a particle of proof that the defendants have attempted to practice deception upon the public, or to perpetrate any fraud upon the plaintiff; but, on the contrary, the defendants' entire good faith is affirmatively shown. There is, then, no ground whatever for granting relief to the plaintiff. That the bill must be dismissed, is a conclusion in consonance with well-considered and authoritative decisions. *Desmond's Appeal*, *supra*; *Gilman v. Hunnewell*, 122 *Mass.*, 139; *Manufacturing Co. v. Trainer*, 101 *U. S.*, 51.

Let a decree be drawn dismissing the bill, with costs.

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CIRCUIT COURT UNITED STATES, DISTRICT
OF MASSACHUSETTS. IN EQUITY.

DAVIS

vs.

DAVIS, AND OTHERS.

DECIDED 5 MAY, 1886.

REPORTED 27 FEDERAL REP., 490.

“Red and Yellow Soap Label” Case.

1. TRADE-MARKS—INFRINGEMENT.—Soap packed in a box, with alternate red and yellow wrappers, so as to produce a representation of a trade-mark of the same combination of colors, is not an infringement of that trade-mark.
2. WHAT WILL BE PROTECTED.—A peculiar method of arranging soap in a box is not a trade-mark which can be legally registered.

MOTION FOR PRELIMINARY INJUNCTION.

W. B. H. Dowse and *E. B. Hale*, for complainants.

T. L. Wakefield, for defendants.

CARPENTER, J.:

This bill is brought to enjoin certain alleged infringements of the trade-mark of the complainants, registered June 2, 1885, and numbered 12,279. It appears that the trade-mark of the complainants, and also the alleged infringements thereof, are used in commerce with the Dominion of Canada. The trade-mark is described as follows in the statement annexed to the certificate of registry :

“Our trade-mark consists of a label bearing a representation of the device or design produced by the means and arrangement used by us in packing our cakes or bars of soap in boxes. We fold each cake or bar of soap in either a red or a yellow wrapper, and pack the cakes or bars thus folded in a box, so that the red and yellow wrappers alternate. * * * As the label is a re-production of the appearance which the soap presents when packed, as described, in a box, it is obvious that bars or cakes of soap simply wrapped and arranged in a box, as described, is one method of producing our trade-mark, * * * the essential feature of which is the device produced by the combination and alternate arrangement of red and yellow spaces, substantially as described.”

This trade-mark, although, in the words of the statement, it “consists of a label,” is not attached in any way to the soap sold by complainants. In practice the label is made of the same size as the box of soap, measuring on the inside, and is placed in the box on the upper layer of bars of soap, and is by the retail tradesman taken out, and used as a show card.

The complainants allege that the respondents infringe this trade-mark in two ways : First, they give to their customers a shallow box containing cakes of the same length and breadth as those sold by them, but much thinner, and inclosed in red and yellow wrappers, and arranged alternately by colors, as in the drawing of the trade-mark. This shallow box is exposed to view by the retail tradesman, and serves the purpose of a show-card advertisement. The trade-mark of the complainants, therefore, is a representation, or, if the word may be allowed, a picture, of the top of an open box of soap. It seems entirely clear to me that such a trade-mark cannot be infringed by the use of a real box of soap, of

whatever size or shape, or whatever may be the color or arrangement of the wrappers. It seems to me to be impossible to say that any physical object can be, in the nature of things, a colorable imitation of a picture or representation of that object. Still further, it is to be observed that there is a very great difference in appearance between a box of soap, and a printed label representing the upper layer of soap therein contained. The most careless observer could not confound one with the other. I therefore conclude that there is no infringement by the use of the advertising box, unless, indeed, it be an infringement of the rights of the complainants to sell soap wrapped in red and yellow wrappers, arranged alternately in the box in which it is packed.

But the complainants claim, in the second place, that their trade-mark is infringed by the sale of soap wrapped and arranged in boxes in the same manner used by them. Undoubtedly the terms of the statement are broad enough to cover the boxes of soap sold by respondents. The statement expressly says that "bars or cakes of soap simply wrapped and arranged in a box, as described, is one method of producing our trade-mark." But I am of opinion that the registration, in so far as it can be interpreted to cover the sale of boxes of soap, is entirely void, for the reason that the object or thing thus included in the description is not such a thing as can lawfully be registered as a trade-mark. A trade-mark is some arbitrary or representative device attached to or sold with merchandise and serving to designate the origin or manufacture of that merchandise. I do not think that the merchandise itself, or any method of arranging the various packages, can be registered as a trade-mark. In the very nature of the case, as it seems to me, the trade-mark must be something other than, and separate from, the merchandise. It is not, of course, claimed that the colors used in the wrappers can be in themselves the subject of a trade-mark registration; nor is it claimed that the wrappers themselves constitute the trade-mark. The claim is that the trade-mark consists in the arrangement of the colors in the wrappers. This seems to me to be no less than a patent for an idea, under the guise of the registration of a trade-mark. I do not think that, in any possible view, the claim can be sustained.

There is evidence, also, which makes it most probable that the method of packing soap in alternate red and yellow wrappers was adopted by B. T. Babbitt, of New York, at about the same time it was adopted by the complainants. Taking that view of the evidence which is most favorable for the complainants, it appears that for about four years before their application for registration Babbitt had used the alleged trade-mark without objection or interference. The complainants, indeed, produce samples of the boxes of soap sold by themselves and by Babbitt, and they point out that the colors used by Babbitt are of widely different quality and shade from those used by themselves. Undoubtedly the colors used by Babbitt are pale and dull, and those used by complainants are strong and bright. But Babbitt uses red and yellow, and the statement of the trade-mark specifies no particular shade or quality of color. It would be, I think, difficult to say on this evidence that complainants had the exclusive right to use their alleged trade-mark at the time they made application for registration.

The motion for preliminary injunction will be denied.

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CIRCUIT COURT UNITED STATES, EASTERN
DISTRICT OF LOUISIANA. IN EQUITY.

GAIL, ET AL.

vs.

WACKERBARTH, ET AL.

DECIDED 16 JUNE, 1886.

REPORTED 37 O. G., 894.

“*Navy Tobacco*” Case.

TRADE-MARKS—IMITATIONS OF OTHER GOODS—INJUNCTION.

Parties will be restrained by injunction from using packages made in imitation of others in the trade, and calculated to deceive the buying public and to defraud the original users of such packages; but such imitation must be sufficiently close to have that effect or the injunction will be refused.

ON MOTION for injunction *pendente lite*.

Mr. Joseph P. Horner, for the complainant.

Mr. J. R. Beckwith, for defendant.

PARDEE, J.:

There is no one characteristic or mark common to the packages of tobacco of complainants and defendants that either one can

have exclusive right to. There remains, then, but the question whether the defendants' packages, in form, size, color, lettering, and marks combined, are made in imitation of complainants' packages, and are calculated to deceive the buying public, and thus defraud the complainants of their rights. The form and size or shape of the defendants' packages are identical with complainants'; but this shape is the common one and of long standing for all manufacturers of the article, and seems to be required to meet the stamp Act of the Government and for convenient handling by consumers, the shape being oblong, about five and a half inches by two and a half inches, and one and a quarter inch thick, a package easily placed in the pocket. The common color is blue; but they are of decidedly different shades, and if color is an object to the purchaser the defendants' packages could not be easily passed off to a purchaser who desired complainants' goods. The only common lettering is the word "Navy," and in this there is a great similarity. The size of the letters and the circular form are very similar. There are no common or similar marks, except that each has a black border or fringe on the face, but similar only in general appearance. Both packages show lead-foil at the ends as an outside wrapper. The packages of each have a distinct and prominent trade-mark on the face of the package; but there is no similarity, the defendants' mark being a naked muscular arm holding a heavy hammer poised for striking, while the complainants' mark is the letter "G," inclosing a tomahawk in a diamond background, with the words "Trade-mark" under the letter "G." Over the defendants' trade-mark is the word "Union" in plain, prominent letters, while over the complainants' mark are the words "Smoke" and "Chew" in a sort of script. By inspection of the packages in evidence I can see no improper imitation, unless it is in the color and in the shape given to the word "Navy." The showing made by the answer and exhibits clearly meets the complainants' bill and affidavits as to intended imitation and fraud and as to effect on trade.

As the case stands at present, I am compelled to refuse the injunction prayed for.

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COURT OF COMMON PLEAS FOR THE CITY
AND COUNTY OF NEW YORK.. IN EQUITY.

SCHUMACHER & ETTLINGER

vs.

SCHWENKE, JR., ET AL.

DECIDED 26 JUNE, 1885.

REPORTED 36 O. G., 457.

“Henry Lee Cigar” Case.

1. The fact that a label has been registered as a trade-mark under the United States Act of March 3, 1881, does not abridge the powers of the State Courts at common law to determine whether or not the matter on such label can be considered a trade-mark.
2. A manufacturer of labels may impress them with a uniform device to indicate them as of his manufacture, but the labels themselves cannot constitute his trade-mark.
3. The office of a trade-mark is to authenticate the article on which it is borne as the product of the owner of the trade-mark, and is a representative or substitute for the owner's signature.
4. Labels sold to cigar manufacturers and used upon their merchandise become the brand or pretended trade-mark of the cigar manufacturer, and not of the lithographer. It is impossible that the same label can be the trade-mark of both.

5. By the use which a merchant makes of a label in applying it to a package containing the product of his manufacture it may become for him a trade-mark, for it may be a distinctive mark, without being the object of his commerce; but as to the printer of such label, it can be nothing but the special object of his industry.
6. When a printer publishes a label intended to convey to the public the impression that it covers cigars of superior excellence, and sells such label to anybody to cover just such cigars as the manufacturer chooses to apply it to, the label is no guarantee of excellence, or even of any certain brand of cigars, and the publisher is chargeable with facilitating others in making false representations.
7. When the owner of a trade-mark applies for injunction to restrain another from injuring his property by making false representations to the public, it is essential that the plaintiff should not in his trade-mark, or in the business connected with it, be himself guilty of any false or misleading representations; for if the plaintiff makes any material false statement in connection with the property he seeks to protect, he loses his right to claim the assistance of a Court of equity.
8. The fact that the plaintiff's marks are themselves a close imitation of those of a third party will be good ground for withholding the aid of a Court of Equity.

THIS is a motion for a preliminary injunction in an action to restrain the defendants from using or causing to be used the name "Henry Lee" upon any labels or advertising-prints offered for sale as such, and from preparing, putting up, selling or offering for sale any labels or prints with these words upon them.

Messrs. Briesen & Steele, for the plaintiffs.

Messrs. Goepel & Raeger, for the defendants.

BOKKSTAVEN, J.:

The plaintiffs are a corporation, and both the plaintiffs and defendants are engaged in the lithographing business, and have produced many different designs intended to be used as labels or tickets, to be attached to articles of merchandise.

In September, 1881, the plaintiffs, or their predecessors in business, claim to have registered, under the Act of March 3d, 1881, the words "Henry Lee" as a trade-mark to designate certain labels manufactured or sold by them, and claim that they are entitled to the exclusive use of said name as a trade-mark upon these labels.

They also claim that by their care and efforts these labels bearing the name "Henry Lee" have been well and favorably known all over the United States and in foreign countries. They claim, further, that the defendants have produced and sold labels bearing the words "Henry Lee" in violation of their rights.

A comparison of the labels manufactured by the plaintiffs and defendants clearly shows that the one is a close imitation of the other, and the defendants do not deny this, although they deny that the labels made by them were ever sold as labels produced by plaintiffs, and aver that they have always sold them as their own labels. The labels of both parties are in two parts, intended one for outside and the other for inside use. Plaintiffs' outside label has over the words "Henry Lee" the words "Vuelta Abajo," and beneath "Fabrica de Tabacos Esquisitos Tobacos hechos espresamente para personas de Gusto," and the inside label has on the left side of the words "Henry Lee" the words "Esquisitos Tabacos hechos," and on the right "para Personas de Gusto." Defendants' outside label has above the words "Henry Lee" the words "Vuelta Abajo," and beneath "Fabrica de Tabacos de la Vuelta Abajo, Grand General y Diplomator de los Estados Unidos." The inside label has on one side of the words "Henry Lee" "Fabrica de Tabacos," and on the other "De Vuelta Abajo." Both plaintiffs' and defendants' inside labels have a medallion purporting to be a likeness of the revolutionary hero, Henry Lee, and is ornamented by various medals intended to give the impression that they had been awarded to manufacturers of cigars of superior merit.

It is apparent from an inspection of both labels that they are designed to be used by cigar-box makers and manufacturers of cigars, and that they are valueless for any other purpose and could not be used by or sold to the public generally.

Plaintiffs do not seek to stop a cigar dealer or the public from using the name "Henry Lee," but ask that they be protected against interference with their trade by rival manufacturers of labels, and claim that labels are an article of merchandise. This presents the question whether tickets or labels composed and sold by lithographic printers, not to the public generally, but to any

one engaged in a special branch of business, to be used by such persons as labels on goods made by them, can be the subject of a trade-mark. As far as I have been able to ascertain, this precise question has never been decided in this country nor in England.

In *Scoville v. Toland, et al.*, (6 *West. L. I.*, 84), it was decided that labels to be used on bottles containing a medicated preparation were not the subject of a copyright, and in the opinion the Court says:

“Like other labels, it was intended for no other use than to be pasted on the vials or bottles containing the medicine; as a composition, distinct from the medicine, it can be of no value. * * * This is not the case with other compositions intended to instruct or amuse the reader. * * * It is the application made of the label, and not its republication, which constitutes the injury. As a label, without the application, it could be of no value to the defendant, as no one will purchase it. * * * In fact, the medicine is so inseparably connected with the label that the latter is only valuable to identify the former.”

1. The fact that plaintiffs' label was registered as a trade-mark under the Act of March 3, 1881, only amounts to *prima facie* evidence of plaintiffs' right and title to use the words “Henry Lee” as a trade-mark on labels, and does not, as I conceive, abridge the powers of the State Courts at common law to determine whether or not the words so used on labels can be considered a trade-mark.

5. The plaintiffs' business is manufacturing labels, and the labels so manufactured are the special object of their commerce, and it seems to me that the article of merchandise cannot itself be a trade-mark.

2. A device or design uniformly impressed upon labels manufactured by plaintiffs, indicating that they were the manufacturers of them, would properly be a trade-mark, but the labels themselves cannot be. The plaintiffs have, as I understand, manufactured and sold many different designs or labels. It cannot be possible that if they were to impress a different name on each variety of labels manufactured by them, they could thereby claim a trade-mark in each variety of label, for if they might have a

thousand different trade-marks for their one business of lithographing, which, I think, cannot be tolerated.

4. As before remarked, it is manifest that these labels are designed to be used by cigar-box makers and the manufacturers of cigars. When thus used, it is apparent that the labels, including the words "Henry Lee," &c., are intended to convey to the public the impression that the cigars covered by them are of a particular brand or make—i. e., the labels then become the brand or pretended trade-mark, not of the lithographer, but of the cigar manufacturer. Now it is impossible that one and the same label can be the trade-mark of both the lithographer printing it and the cigar manufacturer using it. It will be remembered that these labels are not sold to any particular manufacturer, nor are the plaintiffs careful that they should be used only on cigars of a certain quality, but are sold to cigar manufacturers generally, and are used by them to cover cigars of any quality or manufacture, and are when thus used the guarantee of nothing, and are in fact, calculated to deceive the public. To uphold the plaintiffs' contention would, I think, tend to destroy all value in trade-marks as an authentication of the goods covered by them.

3. The office of a trade-mark is to point out distinctively the origin or ownership of the article to which it is affixed, or on which it is impressed, and to give notice who was the producer—in other words, to authenticate the article to which it is affixed, or on which it is impressed, as the product of the owner of the trade-mark, and is a representative of or substitute for the owner's signature. From the nature of the case, these labels cannot in any way perform that office. Although this question has not been decided in this country, it was directly passed upon in France in the case of *Lalande, et al. v. Appel, et al.*, (*Annales de la Prop.*, &c., tome 5, p. 248). In that case the plaintiffs, who were lithographers, complained that the defendants had counterfeited the designs upon tickets or labels intended to be sold to vendors of liquors and cosmetics, to be placed by them upon flasks or bottles. In deciding the case the Court held that the plaintiffs' claim was ill-founded, because the tickets in question were the special ob-

jects of their commerce, and therefore could not be regarded as trade-marks; that the trade-mark regulated by the law of the 25th of June, 1857, is the characteristic sign by means of which the public distinguishes the products of commerce or objects of commerce; that the mark itself cannot be an object of commerce; that by the use which a merchant makes of a ticket in applying to a vase containing the product of his manufacture, it is possible that the ticket may become for him a trade-mark, subject to the fulfilment of all legal formalities, for it may be then, as to him, a sign or distinctive seal of his products, without being the very object of his commerce; but as to the plaintiffs, the tickets can be nothing but the special objects of their industry.

5. I therefore conclude that labels such as these cannot be the subject of a trade-mark.

6. There is a second reason why the present motion should not be granted. Good faith and fairness of dealing is exacted before an action of this description can be maintained. The labels published by the plaintiffs are obviously intended to convey the impression to the public that they cover cigars of a superior manufacture, or from tobacco grown in that part of the Island of Cuba, having the highest reputation for excellence, whereas, in truth and in fact, they sell them to anybody and cover just such cigars as the manufacturer chooses to put in them, and are no guarantee of excellence, or even of any certain brand of cigars, and thus they are chargeable with facilitating others in making false representations.

7. When the owner of a trade-mark applies for an injunction to restrain the defendant from injuring his property by making false representations to the public, it is essential that the plaintiff should not in his trade-mark, or in the business connected with it, be himself guilty of any false or misleading representations; for if the plaintiff makes any material false statement in connection with the property he seeks to protect he loses, and very justly, his right to claim the assistance of a "Court of Equity." (*Manhattan Medicine Co. v. Wood*, 108 U. S., 218, 224). The rule is well settled that the party claiming protection against the

fraudulent conduct of another must himself be free from the imputation of fraud. *N. Y. Card Co. v. Union Card Co.*, (39 *Hun*, 611), and cases there cited.

8. There is a third reason why this motion should not be granted. A comparison of plaintiffs' label with that used on the brand of cigars known as the "Henry Clay" cigar will make it plain that plaintiffs' label is as close an imitation of the "Henry Clay" label as the defendants' is of plaintiffs'.

For these reasons, and others that might be adduced, the motion for an injunction is denied, with ten dollars costs.

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SUPREME COURT, STATE OF RHODE ISLAND.
IN EQUITY.

AMERICAN SOLID LEATHER BUTTON COMPANY*vs.*ANTHONY, COWELL & CO., ET AL.

DECIDED 3 JULY, 1886.

REPORTED 2 NEW ENG. REP., 630.

“American Solid Leather Button” Case.

1. Where marks—such as arbitrary combinations of figures—indicating style or quality also indicate origin, they may be a subject of trade-mark and their use as such protected.
2. The sight of a familiar symbol inducing one to purchase goods to which the symbol does not properly belong, to the injury of him who devised it to mark his own goods, is the gravamen of the law of trade-marks.
3. A complainant in a suit to restrain the use of a trade-mark, cannot maintain an exclusive right to the use of certain numbers which had been used by a third person, and become known to the trade as applied to the same styles of goods before complainant used them.

BILL in equity for an injunction and account.

The suit was brought to restrain the use by defendants, in labels on goods manufactured by them, of certain numbers, which had been adopted and used by the complainant in labels on similar goods manufactured by it.

The label used by the complainant is as follows: "1000 Solid Leather Upholstery Nails, Patented October 18, 1881. Style No. —. Shade No. —. Manufactured by the American Solid Leather Button Company, Providence, R. I."

The label used by the defendants is as follows:

"1000 Solid Leather Upholstery Nails. Style No. —. Shade No. —. Manufactured for Anthony, Cowell & Co., Providence, R. I."

The facts are further stated in the opinion.

Messrs. W. W. & S. T. Douglas, for complainant.

The use of the complainant's numbers, arbitrarily selected, in connection with the name, to indicate the origin of the goods, although such numbers also indicate, without expressing, the style of the goods, makes these numbers, together with the name, a good trade-mark.

Lawrence v. Lowell, 129 Mass., 325; *Meriden Britannia Co. v. Parker*, 39 Conn., 450; *Ransome v. Bentall*, 3 L. J., (N. S.), Ch., 161; *Gillott v. Esterbrook*, 48 N. Y., 374; *Boardman v. Meriden Britannia Co.*, 35 Conn., 402; *Kinney v. Allen*, 1 Hughes, 106. See also *Shaw Stocking Co. v. Mack*, 21 Blatchf., 1.

The imitation of the complainant's label, if it be considered that the name and numbers of the complainant cannot be called a trade-mark at common law, is a fraud upon the public and calls for the interposition of the Court.

Burke v. Cassin, 45 Cal., 467, and cases cited; *Edlesten v. Vick*, 23 Eng. L. & Eq., 51; *Alexander v. Morse*, 14 R. I., 156.

The defendants argue that their labels have not, as a matter of fact, deceived their customers, being accompanied by declarations that the goods were not made by the complainant, but this is no defence. Where the Court is of opinion that the use of the mark or device is likely to deceive, it will not require evidence of

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actual deception or of actual fraudulent intent. *Davis v. Kendall*, 2 R. I., 566, approved in *Barrows v. Knight*, 6 R. I., 438; *Glenny v. Smith*, 2 *Drew & Sm.*, 476; *Curtis v. Bryan*, 2 *Daly*, 312.

In *Filley v. Fassett*, 44 *Mo.*, 168, *p.* 178, by the Court: "If the name, as used by the defendants, was calculated to mislead, the intention to mislead is to be inferred therefrom;" citing—*Fetridge v. Merchant*, 4 *Abb. Pr.*, 159; *Crawshay v. Thompson*, 4 *Man. & G.*, 385.

"Nor is it necessary to show that any one has in fact been deceived, or that the party complained of made the goods;" citing—*Amoskeag Mfg. Co. v. Spear*, 2 *Sandf. S. C.*, 607; *Clark v. Clark*, 25 *Barb.*, 79.

"Nor is it necessary to prove intentional fraud. 'If the Court sees that the complainant's trade-marks are simulated in such a manner as probably to deceive customers or patrons of his trade or business, the piracy should be checked at once by injunction.' " *Coffeen v. Brunton*, 4 *McLean*, 516, 519; *Partridge v. Menck*, 2 *Barb. Ch.*, 101.

In *Coats v. Holbrook*, 2 *Sandf. Ch.*, 596, the identical defence which the defendants make here was set up. At page 597 the Court says: "But it is said that upon their sale to the jobber, by whom it was to be again sold to the retailer, the defendants told the jobber that it was an imitation of Coats' thread; in short, that they sold it as a spurious article. But what then? Did they imagine that the jobber would be equally frank and communicative to the retail merchants and shop-keepers, and that every one of the latter would carefully inform every customer who bought a spool that the thread was an imitation of Coats' made in New Jersey, and only three cord instead of six? The idea is preposterous. Trade-marks, names, labels, etc., are not forged, counterfeited or imitated with any such honest design or expectation."

The same principles are held in the French Courts. *Coddington*, *Trade-Mark Dig.*, 461, 462. See also *Edelsten v. Edelsten*. 1 *DeG., J. & S.*, 185; *Edelsten v. Vick*, 11 *Hare*, 78.

The degree of imitation need not be such as to deceive an expert or a person comparing the two marks or labels, but only such as would be likely to mislead an ordinary purchaser.

Seixo v. Provezende, L. R., 1 Ch. App. Cas., 192; *Lockwood v. Bostwick*, 2 Daly, 521.

It is much closer than was shown in *Alexander v. Morse*, *supra*.

Mr. W. R. Perce, for defendants.

The words "1000 Solid Leather Upholstery Nails" are descriptive only, and by the well-known rule cannot, therefore, be exclusively used by the plaintiff. The words "Patented October 18, 1881" are not contained in the label used by defendants. The words "Shade No. ——" are not claimed as the plaintiff's mark, but are the well-known trade-mark of a third party. The words "by the American Solid Leather Button Company" are not found in the label used by defendants. The words "Providence, R. I.," indicating the place of manufacture are descriptive only. The defendants' (Anthony, Cowell & Co's) name and address appear on the label by them used. The only matter, therefore, which is common to both labels and which can possibly be regarded as a trade-mark, is the words "Style No. ——" With reference to them the law is well settled.

In *Corwin v. Daly*, 7 Bosw., 222, it was held that no dealer in any commodity has a right to be protected by injunction in the exclusive use simply of a name by which to designate it, which does not express its origin and ownership, but merely its quality, kind, texture, composition, utility, destined use or class of consumers.

In *Stokes v. Landgraff*, 17 Barb., 608, it was decided that no exclusive right to the use of words, marks or devices which do not denote the goods or property or particular place of business of a person, but only the nature, kind or quality of the article in question in which he deals, can be sustained.

In *Amoskeag Mfg. Co. v. Spear*, 2 Sandf. S. C., 599, it is said that there is no exclusive right in the use of marks, symbols or letters which indicate the appropriate name, mode or process of manufacture, or the peculiar or relative quality of the fabric manu-

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factured, as distinguished from those marks which indicate the true origin or ownership.

In *Filley v. Fassett*, 44 Mo., 173, the Court holds that the mark must point out the source and origin of the goods, and not be merely descriptive of the style, quality or character of the goods themselves.

In *Falkinburg v. Lucy*, 35 Cal., 52, it is said that the owner of the trade-mark will be protected by the Courts in its exclusive use, but only so far as it serves to indicate origin and ownership of the goods to which it is attached, to the exclusion of such symbols, figures and combinations of words which may be interblended with it, indicating their name, kind or quality.

In *Boardman v. Meriden Britannia Co.*, 35 Conn., 402, it was decided that if the numbers are used solely to indicate the different patterns, styles or sizes, the defendant ought not to be restrained from their use.

In the case at bar there can be no doubt as to the meaning and purpose of the use of the numeral. The words themselves fully state the intent. The number is a style number and nothing else. It is expressly so called. The bill of complaint states that said numbers indicate the style of the goods. The words and numerals do not indicate origin or ownership of the goods, but simply designate a nail of a peculiar style, pattern, size, color or quality, as distinguished from other nails of other styles, patterns, sizes, colors or qualities. There is no pretence that the style or pattern belongs exclusively to the plaintiff. These words and figures are incapable of exclusive appropriation.

Mfg. Co. v. Trainer, 101 U. S., 51, (Bk. 25, L. Ed., 993); *Ainsworth v. Walmesley*, 35 L. J. Ch., 352; *Cox Am. Trade-Mark Cas.*, 678; *Carmichel v. Latimer*, 11 R. I., 395, 407; *Candee v. Deere*, 54 Ill., 439. See also *Ferguson v. Davol Mills*, 2 Brews., 314; *Faber v. Faber*, 49 Barb., 357.

2. It is the essence of the wrong in trade-mark cases that the defendant, by means of a simulated trade-mark, is selling his goods as those of the plaintiff's manufacture; and it is only to the extent that this false representation is directly or indirectly made that relief is granted in equity.

Davis v. Kendall, 2 R. I., 566; *Osgood v. Allen*, 1 Holmes, 185; *Barrows v. Knight*, 6 R. I., 434; *Popham v. Cole*, 66 N. Y., 69; *Burgess v. Burgess*, 3 DeG., M. & G., 896; *Carmichel v. Latimer*, 11 R. I., 407; *Singer Mfg. Co. v. Wilson*, 24 W. R., 1023; *Candee v. Deere*, 54 Ill., 439; *Amoskeag Mfg. Co. v. Spear*, 2 Sandf. S. C., 599; *N. Haven Rolling Spring Bed Co. v. Farren*, 19 Rep., 456; *Cope v. Evans*, L. R., 18 Eq., 138. See Rep., 456; *Cope v. Evans*, L. R., 5 Eng. & I. App., 508; *Partridge v. Menck*, 2 Sandf. Ch., 622; *Blackwell v. Wright*, 73 N. C., 310; *Rowley v. Houghton*, 2 Brews., 303; *Swift v. Dey*, 4 Robt., 611; *Calladay v. Baird*, 4 Phila., 139.

If the defendants' nails were not sold as the wares of the plaintiff, nor went into the general market, nor were ever resold, but the defendants' customers actually knew that the nails were not made by the plaintiff and were not deceived in this respect, the plaintiff has no right to complain.

Edelsten v. Edelsten, 1 DeG., J. & S., 185; *Woollam v. Ratcliff*, 1 Hem. & M., 259, 263; *Cope v. Evans*, *supra*.

The labels in controversy differ so much that a person with reasonable care and observation would not be misled by the defendants' label into a belief that defendants' goods were made by the plaintiff.

Leather Cloth Co. v. American Cloth Co., 11 H. L. Cas., 523; *Davis v. Kendall*, 2 R. I., 566; *Partridge v. Menck*, 2 Sandf. Ch., 622. See particularly the report of this case in *How. App. Cas.*, 553, where the trade-marks are illustrated and compared; *Popham v. Cole*, *Rowley v. Houghton*, *Swift v. Dey*, *Blackwell v. Wright* and *Colladay v. Baird*, *supra*.

There is nothing in the plaintiff's label to indicate that it is claimed as a trade-mark, and even if all the preceding points are overruled, the defendants submit that the plaintiff is not entitled to relief, because it has not in any manner notified the defendants of its claim of trade-mark, although knowing their use of such label, but have allowed the defendants to use the same for a long time, in ignorance of its claim. Such laches defeats the right to an injunction or to an account.

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Beard v. Turner, 13 L. T. N. S., 747; *Cox, Am. Trade-Mark Cas.*, 717; *Estcourt v. Estcourt Hop Essence Co.*, 32 L. T. Rep., 80.

In this case the plaintiff delayed bringing his suit for only ten months.

Holt v. Mendes, 23 Fed. Rep., 869; *Amoskeag Mfg. Co. v. Garner*, 6 Abb. Pr. N. S., 265; *Amoskeag Mfg. Co. v. Spear*, 2 Sandf. S. C., 599; *High, Inj.*, 681.

STINESS, J., delivered the opinion of the Court.

The complainant is a manufacturer of buttons and nails with solid leather heads. In order to distinguish the different styles which it manufactures, it has assigned certain numerals, arbitrarily chosen, *e. g.* 30, 40, 60, 70, 111, etc., to designate each style of head, on its advertising cards and packing boxes. The several styles made by the complainant have become associated with and known by these numerals in the trade, and the numerals are commonly made use of in orders and other designations of a style desired to be referred to.

The defendants Anthony, Cowell & Co., have procured from other parties, nails of different styles, similar to those made by the complainant, and have designated them by the same numerals adopted by the complainant to designate the corresponding styles of its manufacture; whereupon the complainant, claiming the several numerals adopted by it as its trade-mark, brings this bill for an injunction and account.

1. The first question presented for our decision is, whether the use of an arbitrary combination of figures to designate the styles of goods which a person makes is entitled to protection. The defendants claim that no protection can be given, because such figures, by denoting the style or quality simply, and not origin of the goods, deceive nobody, and hence the rights of the complainant are not infringed. There is some diversity in decisions upon this point, arising mainly from different assumptions of fact by the Courts. Undoubtedly, if it be assumed that a given mark indicates quality only, and not origin, it will follow that purchasers of goods so marked have not been mislead thereby into

the supposition that they were buying complainant's goods, and hence he would show no case for relief. All of the cases cited by the defendants in support of their claim that numbers indicating style or quality cannot be protected are based upon such an assumption.

Where the premises are true, no fault can be found with the conclusion. But it by no means follows, as a rule of law, that marks indicating style or quality may not also indicate origin, and thus be a subject of trade-mark. A person has the right to affix to his goods any device, symbol or name, which he may invent, to distinguish such goods from those made by other people. When the symbol becomes known in connection with his name, it serves as a sign and pledge of the origin of the goods. People do not often stop to read all that may be printed on a label; nor do they always know the changes that are made in firms or business names.

2. Hence it is that the sight of a familiar symbol inducing one to purchase goods to which the symbol does not properly belong, to the injury of him who devised it to mark his own goods, is the *gravamen* of the law of trade-marks.

Within limits, which are well defined, a combination of letters or figures, arranged for convenience or to attract attention, may serve the purpose of a trade-mark, as well as a device invented or arbitrarily selected. So a person may have different symbols for different grades of goods, which in the same way, will indicate both quality and origin, with respect to the goods so marked.

A manufacturer may adopt such symbols, not simply to mark a style or quality, but his style and his quality as well. He is entitled to have his style and his quality protected from misrepresentation, and to have the benefit of any favorable reputation they may have gained. The doctrine applicable to cases of this character is clearly set forth in *Shaw Stocking Co. v. Mack*, 21 *Blatchf.*, 1, 6, as follows:

"It is very clear that no manufacturer would have the right exclusively to appropriate the figures 1, 2, 3, and 4, or the letters A, B, C, and D, to distinguish the first, second, third and fourth quality of his goods, respectively. Why? Because the

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general signification and common use of these letters and figures are such that no man is permitted to assign a personal and private meaning to that which has, by long usage and universal acceptance, acquired a public and generic meaning. It is equally clear, however, that if, for a long period of time, he had used the same figures in combination, as '3214' to distinguish his own goods from those of others, so that the public had come to know them by these numerals, he would be protected. The Courts of last resort in Connecticut, in Massachusetts and in New York have distinctly held this doctrine, *Boardman v. Meriden Britannia Co.* 35 Conn., 402; *Lawrence Co. v. Lowell Mills*, 129 Mass., 325; *Gillott v. Esterbrook*, 48 N. Y., 374, the numerals sustained being respectively, '2340,' '523,' and '303.'

In this case the numerals "830" had been adopted to mark a style of hose made by the complainant, viz: a mottled drab, and although the label used by the defendants bore their own and not the complainant's name, an injunction was granted against their use of the numerals, upon the ground "that the complainant had used these numerals long enough to convey to any one versed in the nomenclature of the trade a precise understanding of what goods were intended when the numerals were used alone disconnected from any intrinsic information." The defendants in the case last quoted, as in the case before us, were dealers and not manufacturers.

In *Mfg. Co. v. Trainer*, 101 U. S., 51, (*Bk. 25, L. Ed.*, 993), strongly relied upon by the defendants, the Court based its decision upon the fact that the letters "A. C. A." denoted quality simply, and not origin. Judge Clifford dissented from this conclusion of facts. If, as stated in that case, indication of origin is "entirely overborne by the patent fact that the label discloses the name in full of the manufacturers," we do not see why any trade-mark, coupled with the the name of the real manufacturers, might not be used; for, according to the language of the opinion, the indication of origin by the use of the trade-mark would be "overborne" by the discloser of the maker's name. We do not think the Court meant that the case should go to this extent. It simply found that the letters in that case did not indicate origin, and hence dismissed the bill.

Applying the rule which we have here recognized, we come to the questions of fact in this case. It appears from the testimony that the numbers "60" and "70" were used by T. F. N. Finch, and had become known to the trade as applied to the same styles, before the complainant used them. If this be so, the complainant cannot appropriate these numbers to its exclusive use. The only other numbers proved to have been used by the defendants, Anthony, Cowell & Co. are "30" and "111." We think these numbers indicate origin as well as style. The fact that orders for goods refer to numbers, which have become associated with a particular style of nail only by the complainant's association of the number with the style, raises a natural inference that persons ordering by that number suppose they are ordering goods of a style made by the complainant. We therefore think that in the use of these numbers as against the defendants, Anthony, Cowell & Co., the complainant is entitled to protection according to the prayer of the bill. As to the other defendants, in the absence of testimony to show their use of any numbers claimed by the complainant other than "60" and "70," this bill must be dismissed.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

PORTUONDO

vs.

MONNE, AND OTHERS.

DECIDED 14 JULY, 1886.

REPORTED 28 FEDERAL REP., 16.

TRADE-MARK—PRELIMINARY INJUNCTION.

Preliminary injunction denied where affidavits of defendants make it doubtful whether the plaintiff has so had exclusive use of symbols sought to be restrained, as to make their use by defendants likely to pass their wares as his.

Franklin Swayne, for orator.

Wingate & Cullen, for defendants.

WHEELER, J.

The plaintiff shows that he has used the symbols mentioned in his bill of complaint to designate cigars made by him, and that the defendants make use of the same. But the affidavits of defendants show that the same symbols were used by others upon

cigar boxes before, or about the time, the plaintiff began to use them. These affidavits make it doubtful whether the plaintiff has so had the exclusive use of the symbols that the use of them by the defendants serves to pass their cigars as those of the plaintiff. This question cannot safely be determined upon the affidavits, but should be established by evidence regularly taken in due course. The plaintiff does not appear to be entitled to a preliminary injunction. Motion denied.

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CIRCUIT COURT UNITED STATES, NORTHERN
DISTRICT OF ILLINOIS. IN EQUITY.

LORILLARD, ET AL.*vs.*PRIDE.

DECIDED 26 JULY, 1886.

REPORTED 36 O. G., 1150.

“Tin Tag” Case.

1. TRADE-MARKS AS AFFECTED BY COMMON RIGHTS.—Tin being one of the common metals in use by the public for a very large variety of purposes, and being easily stamped or impressed with letters, figures or characters, or cut into various shapes, and taking readily different colors or shades besides its natural metallic luster, and like paper, becoming readily the vehicle or material for receiving whatever impression or color may be stamped upon it. HELD:
That the attempt of complainants to appropriate tin to their exclusive use in marking plug-tobacco, without regard to its color, shape or the characters or letters it bears, is not within the scope and purpose of the law of trade-marks.
2. TRADE-MARKS NOT AVAILABLE TO PERPETUATE RIGHTS SECURED BY PATENTS.—Complainants having attempted to secure to themselves by

means of a patent, the exclusive use of tin as a badge for their plug-tobacco, and their goods having acquired the name of "Tin Tag" goods while they were acting under their patent. **HELD:**

That when the patent was declared void the right to so indicate or mark such goods became public, and complainants cannot perpetuate or continue this right by claiming it as a trade-mark.

3. AN ARBITRARY TERM DISTINGUISHED FROM THE THING SIGNIFIED THEREBY.—The use of arbitrary terms, such as "Tin Tag" or "Wood Tag," by a manufacturer to indicate goods produced or sold by him, might be allowed if the person so using the name or words branded them upon his goods, or in any way gave the goods the name; but that would give no right to the exclusive use of the tin or wood as a material to designate the goods.

Messrs. Banning & Banning, Messrs. Tillotson & Kent, and Mr. Rowland Cox, for the complainants.

Mr. H. S. Oakley, Messrs. S. A. & R. H. Duncan, and Mr. B. F. Thurston, for the defendant.

BLODGETT, J.:

The bill in this case avers that complainants are the most extensive manufacturers of tobacco in the United States; that they have been engaged in said business for many years; that their goods are sold throughout the United States and in foreign countries; that during the year 1874 they adopted as a trade-mark for their plug-tobacco a tag or piece of tin, and called their tobacco "Tin Tag Tobacco;" and that they have been successful in establishing the tin tag as a badge of identification or mark of their goods, and the term "Tin Tag Tobacco" is a designation by which their goods bearing that mark are bought and sold; that the adoption of the tin tag as a trade-mark for their goods was original with them; that prior to such adoption it had never been used as a mark for plug-tobacco; that they have now, and have had since the year 1874, the right to its exclusive use as a trade-mark for their plug-tobacco; that the same is now, and has been since 1874, known to the public as their trade-mark, and whenever and wherever a piece of tin is seen affixed to a plug of tobacco, it means the tobacco of complainants; that the use of their trade-mark—to wit, a piece or tag of tin—has been continu-

ous from the date of its adoption as aforesaid. Complainants aver that they have the exclusive right to employ a tin tag, whatever its appearance, color, or shape, and state that they bring this bill for the purpose of establishing and maintaining their exclusive right to the use of the piece of tin of any shape as a trade-mark for plug-tobacco, and to prevent the use upon plug-tobacco not made by them of pieces of tin which would cause said tobacco to be sold in the market as "Tin Tag Tobacco" or "Tin Tag Plug."

The bill further charges that the defendant, in fraud of complainants' right, has, since the adoption of complainants' said trade-mark, sold large numbers of plugs or pieces of chewing tobacco not made by complainants, to which have been affixed pieces of tin of various shapes—such as star-shaped or circular and rectangular pieces of tin—and that by so placing on the market and selling plug-tobacco with pieces of tin affixed thereto defendant has fraudulently violated and infringed upon complainants' trade-mark, intending by so marking such plug-tobacco with a piece of tin to make the public believe that the tobacco so sold by him was the manufacture of complainants. The bill prays an accounting by the defendant of the profits made by him upon the sale of tobacco marked with pieces of tin or tin tags, and that the defendant be forever enjoined and restrained from in any manner using the tin tags in connection with the sale of plug-tobacco not made by complainants to be sold as and for "Tin Tag Tobacco."

The answer of the defendant in substance admits that complainants in 1874, and from that time to the commencement of the suit, had practiced the marking of their plug-tobacco, but avers that said tags carried also letters or marks impressed or embossed upon the same—such as "Lorillard & Co.," "Climax," "Bullion," &c.—and that it is by means of these names that complainants' tobacco is known and sold in the market, and not by the exclusive and single designation of "Tin Tag Tobacco," and that the piece of tin alone does not constitute complainants' trade-mark or designate their goods.

The answer further denies that complainants have, or ever had, the exclusive right to the use of a piece of tin irrespective of its appearance, color, or shape as a trade-mark or badge of identification upon their tobacco, and charges that long prior to the adoption by complainants of their tin tags, Neudecker Bros., of Richmond, Virginia, had adopted a piece of tin carrying the words "Patent Process," as a mark to distinguish it as a peculiar kind of plug tobacco manufactured by them.

Defendant further charges that the tobacco sold by him was manufactured by the firm of Liggett & Myers, of St. Louis, Missouri, and bore upon its tin tags evidence that it was so manufactured by Liggett & Myers, and that it in no way deceived, or tended to deceive, the public as to the origin or manufacture of said tobacco, but that, on the contrary, the purchasers and the public well knew that said firm was in the habit of stamping or making their tobacco with tin tags of peculiar shape, indicating that they were the manufacturers thereof.

It appears from the proof that sometime in the year 1874, Mr. Charles Siedler, one of the complainants' firm, invented a mode of marking or distinguishing plug-tobacco by embedding into the surface of the plugs a metal tag or label, and that he obtained a patent for said process on or about January 22, 1875; that this patent became the exclusive property of the complainants, and for several years the complainants insisted upon the validity of this patent, and asserted their exclusive right by virtue of this patent to mark their tobacco with tin tags, and thereby indicate its origin, and that the use of the tin tag and the designation of complainants' goods by the words "Tin Tag" originated from the attempt of complainants to enforce their exclusive right to the use of a metal tag under this patent, and not to the adoption of tin or the words "Tin Tag" as a trade-mark.

It further appears that in June, 1876, complainants registered in the Office of the Commissioner of Patents a trade-mark consisting of a bright metallic tag, preferably of a circular form, firmly affixed to one of the sides or faces of plugs of tobacco, and that in September, 1876, the firm of Liggett & Myers, of St. Louis, whose tobacco is sold by the defendant, also registered in

the Patent Office of the United States a trade-mark for plug-tobacco, consisting of a bright metallic tag or label of circular outline, having a lustrous or metallic appearance, and provided at its centre with a circular aperture; and that they also at the same time registered as a trade-mark for plug tobacco a bright metallic tag or label in the form of a five-pointed star, with a circular aperture at its centre; that said Liggett & Myers, also, in November, 1876, registered in the Patent Office, as a trade-mark for plug tobacco, a bright metallic tag with rectangular outline and a rectangular opening at its centre, and also that in December, 1876, complainants registered as trade-marks for plug-tobacco the fanciful or arbitrary words "Tin Tag Plug," and also the words "Tin Tag Tobacco."

It also appears that from the time complainants began to mark their tobacco plugs with tin tags, under and in pursuance of the Siedler patent, various other manufacturers, including Liggett & Myers, commenced the marking or labeling of their plug-tobacco with tin tags of various forms, and that there is now, and has been for many years, upon the market brands of tobacco made by different manufacturers, marked or indicated by tin tags of very many different forms and colors, each of these colors or forms usually indicating the name of the manufacturer.

It will thus be seen that complainants' claim to the exclusive right of using tin as a mark or indicia of their goods has not been acquiesced in by the public, but that other manufacturers have used tin in some form for the purpose of indicating tobacco of their manufacture.

1. The bill asserts broadly the complainants' exclusive right to employ a tin tag, whatever its appearance, color, or shape, as a trade-mark for their tobacco, and insists that no other person has a right to use tin for the purpose of marking their tobacco, and the case has been argued by complainants' counsel, and the proofs taken solely for the purpose of asserting before the Court this right so put forward in the bill.

I think there can be no doubt from the proof that the complainants were the first to attempt the use of tin as a special mark to indicate and designate their manufactured goods; and I think

there can be no doubt that from the time they began to mark their goods with tin tags in pursuance of the Siedler patent, their goods began to be known, and finally came to be widely known, as "Tin Tag Tobacco;" and did the case turn upon the right of the complainants to the use of the arbitrary words "Tin Tag" or "Tin Tag Tobacco," as required in some of their registered trade-marks, there would be but little difficulty perhaps in the case, because the popular designation which their tobacco obtained by reason of its bearing a tin tag upon it in pursuance of the patent was this short and expressive description "Tin Tag."

But the frame of this bill is that no person other than complainants has a right to use upon plug-tobacco a piece of tin of any shape or color, or with any legend or mark or sign upon it, as a manufacturer's or dealer's mark or designation of the origin of the goods.

1. Tin is one of the common metals in use by the public for a very large variety of purposes; it is easily stamped or impressed with letters, figures, or characters, or cut into various shapes, and takes readily different colors or shades besides its natural metallic luster, and, like paper, becomes the vehicle or material for receiving whatever impression or color may be stamped upon it. It seems to me it would be as reasonable to assume that the complainants could have adopted paper, or wood, or a piece of cloth or leather, as a badge or indicia of their goods, as that they could have taken a piece of tin. That they had a right to appropriate to their exclusive use a piece of tin without regard to its color, shape, or the characters or letters it bears, does not seem to me to be within the scope and purpose of the law of the trade-marks.

2. It also appears that complainants' first effort was to secure to themselves the exclusive right of tin as a badge for their goods by means of the Siedler patent, and that their goods acquired the name of "Tin Tag" goods, while they were acting under their patent, and that it was not until after their patent had been held void, that they fell back upon their right to use tin as a trade-mark. Having adopted this use of tin and given to their goods the name of "Tin Tag Tobacco," while they were claiming the rights given them by the patent, it seems to me that they have no right now to perpetuate a monopoly which the Courts decided

they could not have by falling back upon the popular name given their goods in pursuance of the patent. If their goods properly became known and designated in the market as "Tin Tag" goods, by virtue of their marking them or tagging them in pursuance of their patent, the right to so indicate or mark the goods became public when the patent expired or was declared void, and they cannot perpetuate or continue this right by claiming it as a trade-mark.

3. I have no doubt from the proof in this case that the designation of plug-tobacco as "Tin Tag" or "Tin Tag Tobacco" was first applied to tobacco manufactured by complainants, but complainants did not brand or mark their goods with the words "Tin Tag," but the term or name of "Tin Tag" was popularly applied to the goods by dealers and buyers by reason of the tin tag put on them under the claims of the patent. If complainants had from the outset marked their goods with this fanciful or arbitrary designation of "Tin Tag Plug" or "Tin Tag Tobacco" as a trade-mark, their exclusive right to its use might be sustained; but complainants did not brand or mark these words upon their goods. The public gave the name of "Tin Tag" to the goods because the plugs had tin tags affixed to them.

It also appears from the proofs that the firm of Liggett & Myers, whose agent defendant is, have never marked their goods with the words "Tin Tag." Liggett & Meyers and other manufacturers have also, from the time complainants' goods first began to be known to the trade by the name "Tin Tag," denied and resisted complainants' exclusive right to the use of a piece of tin without regard to its color, shape, or devices, as a trade-mark, and have persistently marked their own goods with pieces of tin of various shapes, colors, and letterings; and, naturally enough, all goods so marked with tin labels or tags are designated in the trade by the term "Tin Tag" goods. I think it may be taken as established by the proof that the words "Tin Tag" do not now designate complainants' goods or goods manufactured by complainants upon the market or to the trade, and that plug-tobacco made by other manufacturers is now designated and sold by the name of "Tin Tag" tobacco, although not labeled or branded with such name, because they bear a tin label or tag of some form.

But if the public has been imposed upon, or the goods of others have been sold as the goods of complainants to the damage of complainants, it is because complainants were unfortunate in the selection of a designation for their goods, and made their claim to the use of tin as their trade-mark more broadly than the law will permit, and if goods of other manufacturers are now known and sold by the name of "Tin Tag," it is not because they are so branded, named, or designated, but as a short and popular mode of describing all goods marked with tin tags. If other dealers have the right to use tin as a material from which to make a tag or label, they cannot be held to violate complainants' rights because the public designate all goods marked with a tin label as "Tin Tag" goods.

3. If complainants had put upon the market goods with paper, wood, or leather tags, and such goods had come to be popularly known and designated in the trade as "Paper Tag," "Wood Tag," or "Leather Tag," complainants could not by such use acquire the right to prevent all other persons from putting a paper, wooden or leather tag upon similar goods, because the use of such materials is a right common to all and cannot be exclusively appropriated by any one.

The use of arbitrary terms—such as "Tin Tag" or "Wood Tag"—by a manufacturer to indicate goods produced or sold by him might be allowed if the person so using the name or words branded them upon his goods, or in any way gave the goods the name; but that would give no right to the exclusive use of the tin or wood as a material to designate the goods. A person may appropriate any word, figure, or emblem as a trade-mark; but that does not give an exclusive right to the use of the well-known material substances upon which the word, figure, or emblem may be impressed or engraved.

I am therefore of opinion; that this bill should be dismissed for want of equity; but this disposition of the case is made without prejudice to the complainants' right to sue upon any of its specific trade-marks depending upon the coloring, design, shape, or lettering on the tin label.

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COURT OF CHANCERY, NEW JERSEY.
IN EQUITY.

FAY'S ADMINISTRATORS

*vs.*FAY.

DECIDED 12 OCTOBER, 1886.

REPORTED 4 CENTRAL REP., 241.

"Fay's Patent Roofing" Case.

1. The use of words (here, "patent roofing") merely designating the kind of business one is engaged in, cannot be protected as a trade-mark.
2. To recover for the "good will" of a business transmitted from one person to another it must appear affirmatively that there was a "good will" connected with the business, of some value in itself. Proof merely that the business is profitable is not enough.
3. Administrators cannot maintain a bill to have their co-administrator account for the "good will" of their intestate's business continued by their co-administrator with their consent, all the administrators being equally in the wrong for not turning such good will into cash as an asset of the estate.
4. Payment for the "good will" of a business must be claimed at the time of the transfer of the business.

ON bill for relief. Dismissal advised.

The facts are stated in the conclusions of the Vice-Chancellor.

Mr. J. J. Crandall, for complainants.

Mr. B. D. Shreve, for defendant.

BIRD, V. C., filed the following conclusions:

This bill is filed by two of three administrators against the third, to compel him to account for the profits of business which they allege he carried on in continuation of the same as carried on by the intestate in his life-time under a patent right called "patent roofing." Briefly, the insistent is that the intestate, by means of his patent, carried on and established a profitable business under such patent and by the name of "patent roofing," which name, from long use, became a trade-mark of great value; and that the defendant having appropriated it to his own use, by advertising "patent roofing" and using bill-heads with the same phrase on, became responsible to the complainants as administrators for the value of such business conducted under this so-called trade-mark, "patent roofing."

First, it is proved to a demonstration that the alleged patent was worthless, so that there does not seem to be the slightest foundation for a claim on that score.

1. Second, can a valuable right, such as the law protects, arise to any citizens under such circumstances? Was the phrase "patent roofing" adopted as a trade-mark? Did the intestate adopt that sign in order to distinguish his business from all his fellows in the market? Or did he use that phrase as expressive of his rights under the license issued by the Government? I am constrained to believe the latter. I can pick up no bit of evidence that he intended to use the phrase in the former sense and to protect it as a trade-mark. To my mind the testimony is most clear that the intestate used the phrase, "patent roofing," not so much for the purpose of carrying on business under that mark, but simply to designate to the world the kind of business he was engaged in. It seems to me that this was done in the same sense in which

hundreds of other dealers make known the special branch of business they may be engaged in. Under this category come dealers in boots and shoes, in dry goods, and groceries, and the like.

It strikes me that if the bill in this case can be sustained, then every person beginning either of the above vocations in dangerous proximity to one already in the field, could be proceeded against. The law does not foster and protect monopolies in trade on any such general principles.

2. Third: but it is said by the complainants that the intestate, in his life-time and at the time of his death, enjoyed what is termed a "good-will," in the legal sense and that it was transmitted to them as his representatives. That the good-will contemplated in the law is transmitted thus I have no doubt. It is a subject of barter as any other right or thing is. But the good-will must be shown to have some value in that sense, as distinguished from other dealers. Nothing in this direction has been presented. It does not appear that there was anything so special about the business or the mode of conducting it, or the place, as to give it peculiar prominence and profit in the estimation of business men, or to secure to the owner advantages above all others which the law ought to protect him in. It seems to me that it would be quite dangerous for the Courts to hold that every man who has a vocation has a good-will in connection therewith which the law sustains; hence, I conclude that before the Courts can aid in such cases it must appear affirmatively that there is a good-will of some value, independent of every other consideration. The complainants urge that they have shown that this business was profitable to the intestate in his life-time; but this is so far successfully assailed as to render their position too uncertain to found a decree upon. But they say the same business was continued by them for several months after the death of the intestate, at a profit of \$100 per month; and this they press as the true standard of value. Everyone will see that the greatest injustice might be committed by basing a decree upon the many contingencies arising or intervening in every such case; for example, the condition of the market, the activity of business generally, the skill or industry of the managers and the like.

3. Fourth, if the complainants' showing be sound, then instead of charging their co-administrator with the estimated value of the good-will, I would charge them with great neglect of duty in not selling such good-will, as was most plainly their duty in the very beginning, rather than carry on a venture at the risk of loss. With this neglect upon them, they are before the Court without any claims upon its favor, unless :

Fifth, it is because their co-administrator is the defendant, and the person charged. Considering that when the Court finds both parties in the wrong it leaves them there and will aid neither, the fact that the co-administrator now has the trade and is carrying on the business will not justify them in filing their bill. All three are alike accountable to the estate. All were alike bound to turn this good-will into cash and available asset, if any one could be found to pay cash for it.

Sixth, I cannot conclude that the defendant is liable under the circumstances, if I am in error in all of the foregoing conclusions. The complainants and defendant, as administrators, carried on the business of selling patent roofing for the estate, at the same place where the intestate had, from the month of May until October, when all parties interested agreed to sell all the office furniture and the machine, which it is claimed was patented, to the defendant for \$50, and to rent the establishment to him for \$10 per month.

4. If there existed any such thing as good-will, it passed by fair implication, to the defendant. If it did not pass it still subsists or exists, and they have the right of power and it is their duty to sell it for the benefit of the estate. They had no right to make the sale of the office furniture to the defendant and allow him to proceed, under their own eyes, with the business until it has become of some value, and now to come to this Court and ask for him to account.

4. If they intended to make this claim, they should have done so at once, not allowing him to proceed as if by plain right.

I will advise that the bill be dismissed, with costs.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

SYMONDS

vs.

GREENE, AND OTHERS.

DECIDED 15 OCTOBER, 1886.

REPORTED 28 FEDERAL REP., 834.

“Eureka Packing” Case.

1. TRADE-MARK--INFRINGEMENT--PRELIMINARY INJUNCTION--“EUREKA”
FORMER DECREES.—A preliminary injunction should be granted to protect the use of the word “Eureka,” used by plaintiff to designate a kind of steam-packing made by him, upon a showing that the plaintiff had used the name since 1875, although another firm used it to a limited extent for another kind of packing from 1872 to 1874, especially when plaintiff has had two decrees establishing his right to the name as a trade-mark in the locality where the former use thereof occurred.
2. UNITED STATES CIRCUIT COURT—JURISDICTION—AMOUNT IN DISPUTE
INFRINGEMENT OF TRADE-MARK—PROFITS.—In a suit to restrain the infringement of a trade-mark, the amount in dispute, as determining the jurisdiction, does not depend on the profits sought to be recovered.

MOTION for preliminary injunction to restrain the use of the word “Eureka.”

Sanford H. Steele, for plaintiff.

W. H. L. Lee, for defendants.

WHEELER, J.:

1. This is a motion for a preliminary injunction to restrain the use of the word "Eureka," in trade, in connection with steam and hydraulic packing. There is no question but that the orator commenced using that name for packing made by him in 1875, and has continued that use since that time, nor but that the defendants use that name in connection with that kind of packing, not of the orator's make in trade; nor but that a firm known as Sellers Bros. gave that name to a kind of steam-packing patented by William Beschke in 1872, at Philadelphia, and used it in connection with that packing until early in 1874; nor but that the profits on the sales of defendants are much less than \$500.

The defendants insist that the motion should be denied for want of jurisdiction of the cause in this Court; because of the use of the name by Sellers Bros.; and because the name indicates a class of those goods, instead of representing them to be the orator's.

2. As jurisdiction is not given to this Court in this class of cases, except where the matter in dispute exceeds the sum of \$500, there would be difficulty in maintaining the jurisdiction if the profits to be recovered were the measures of the orator's rights involved; but that is not so understood. An injunction may be of much greater value to the orator than any amount he may show himself entitled to, and it cannot be said now that such value may not exceed the limit required.

The use of that name by Sellers Bros. was so long ago, and so limited, that it cannot fairly be considered to now have any effect upon the indication by it of source of the goods to which it has for so many years since been applied. When the orator first began to use it, it might have indicated that the goods were Sellers Bros., and might not, but now it would not indicate to any one in the trade that the goods were Sellers Bros., nor would the fact of their former use of it now confuse its signification. It is not applied to the kind which Beschke patented,—to indicate that

kind of goods,—and does not appear to be a name which any class of goods has acquired, and does not appear to be the trade name of the plaintiff's goods. Still, if the plaintiff adopted the name on account of value which it had acquired from its use by Sellers Bros., he would not appear to have any just right to it now which a Court of equity ought to protect. But Sellers Bros. terminated their contract with the patentee apparently on account of its unprofitableness. The plaintiff did not take up that manufacture, but commenced making a different kind, and there is not enough in the case to show that he appropriated the name wrongfully when he took it.

The plaintiff has had two decrees in the Courts of Pennsylvania establishing his right to this name as a trade-mark, as against others, for his packing; and these cases were instituted at Philadelphia, where that use of the name by Sellers Bros. was principally had, and where the defence could have been made if available.

On the whole case as it now stands, the orator appears to be entitled to the injunction asked. Motion granted.

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CIRCUIT COURT UNITED STATES, SOUTHERN
DISTRICT OF NEW YORK. IN EQUITY.

ESTES, AND OTHERS,

vs.

LESLIE, AND OTHERS.

DECIDED 24 NOVEMBER, 1886.

REPORTED 29 FEDERAL REP., 91.

Chatter-box vs. Chatter-book.

TRADE-MARKS—INFRINGEMENT—"CHATTERBOOK"—
"CHATTERBOX."

The name "Chatter-book," printed upon the cover of the defendants' books of the juvenile character of the general appearance of the complainants' books, being in the opinion of the Court an imitation of the name "Chatter-box," which by association, when used upon books of a juvenile character, points "distinctly to the origin or ownership" of the books to which it is applied, an injunction *pendente lite* is granted against its use.

MOTION for Preliminary Injunction.

G. G. Frelinghuysen, for complainants.

Fullerton & Rushmore, for defendants.

SHIPMAN, J.:

The name "Chatter-book," as printed upon the cover of the defendants' books, is in my opinion, an imitation of the name "Chatter-box," which, by association, when used upon books of a juvenile character, points "distinctively to the origin or ownership" of the books to which it is applied and used by the defendants, of the name "Chatter-box" upon the books which are represented by the exhibits in the case, the same being books of a juvenile character, of the general appearance, style, and manner of cover of complainants' books, should be enjoined *pendente lite*.

DIGEST.

Numbers refer to paragraph, case and page.

ABANDONMENT.

Permission to one who is merely a dealer to place his name on articles bearing the *trade-mark* of the manufacturer, especially if such permission was in accordance with the custom of the trade, is no indication of an abandonment of the trade-mark by the manufacturer. 4—33—201—203.

A trade-mark consisting of a word and symbol arbitrarily assumed, may be lost by non-use by its owners, especially if the disuse continues as long as eight years. 6—10—51.

A person cannot appropriate a trade-mark belonging to another without his consent and afterward acquire a good title by the abandonment thereof by the first proprietor, but if the trade-mark has been long abandoned and disused by one party, another may by adoption and use acquire property rights in it. 2—162—1047.

The right to use a trade-mark is forfeited by non-user for a period of eight years, and cannot be resumed in prejudice of one who had used it exclusively during the period of abandonment. 3—10—48—50.

The plaintiff having acquiesced for a long time in the manufacture and sale by defendant, of cooking-stoves containing certain improvements patented by plaintiff, and to which the name "Charter Oak" had been applied as a trade-mark, and the patent having expired, defendant cannot be prevented from calling such stoves by the name of "Charter Oak," so long as he does not represent them as being made by the plaintiff, or induce others to believe that they are made by the plaintiff. 1—23—122.

Abandonment of a trade-mark is not made out by showing numerous infringements in which the owners of such trade-mark have not acquiesced. 1—30—174.

Property in a trade-mark may be abandoned and thereby lost, but a complaint for infringement, which shows non-user for a year, does not disclose an intention to abandon; and without such intention there is no abandonment by mere non-user. Such non-user might possibly imply a gratuitous license to others to use the mark for the time being, and thereby preclude the recovery of damages for the time; but this license is revocable, and does not preclude the remedy by injunction for the future. 3—91—572.

See also, 1—181—1130.

ACCOUNTING.

K., who was engaged largely in the business of packing blues, on his own account and for others in the trade, put up the blues covered by the infringing trade-mark for the firm of B. & Co., who sold them, paying K. for the work and labor of packing them. K. was adjudged an infringer, an injunction issued against him, and the decree directed an accounting. On motion to strike from the decree the clauses directing an accounting, HELD:

That the complainant was entitled to an accounting to enable him to ascertain what profits were made by K. by his work and labor, and what damages resulted therefrom. 1—90—565.

ADMINISTRATORS.

Administrators cannot maintain a bill to have their co-administrator account for the "good will" of their intestate's business continued by their co-administrator with their consent, all the administrators being equally in the wrong for not turning such good will into cash as an asset of the estate. 3—180—1128.

ALBANY BEEF.

The fact that the applicant has devised for the first time a practicable method of canning sturgeon would not entitle him to the exclusive use of the words "Albany Beef," as a trade-mark for such canned sturgeon, it appearing that such words have gone into use as a name for sturgeon. 1—111—723.

AFFIDAVITS.

4—56—356.

ALIENS.

The fact that one is an alien does not affect his right of property in a trade-mark; but that fact is a necessary allegation to establish the requisite diversity of citizenship to confer jurisdiction upon a Federal Court. The Acts of Congress fortify the common law right to a trade-mark by conferring a statutory title upon the owner, but "property in trade-marks does not derive its existence from an Act of Congress." 100 U. S., 82. By the express terms of section 10 of the present Act of Congress the common law right in trade-marks is preserved intact. 1—113—732.

AMENDMENT.

In a meritorious cause of action, properly brought in the firm-name for violation of firm-rights, leave will be given before final decree, to join a member of the firm who had been omitted as a party to the suit. 1—9—32—35—37.

ANSWER.

The former practice of the Courts of Chancery in England of dissolving an injunction upon the filing of an answer denying the equity of the bill, was abolished by the Statute 15 and 16 *Vict.*, *ch.* 86, *sec.* 59, which enacted, that thereafter the answer should be regarded merely as an affidavit, and that affidavits may be recorded and read in opposition thereto. 6—70—425.

It is the settled doctrine of the Courts of England, as well as America, that a special injunction will be dissolved upon the coming in of an answer or affidavits denying the equities of the bill. 4—67—408.

APPEAL.

An appeal lies from an order of Court which so modifies and changes an injunction, as to effectually extinguish it to the extent of its operation. 1—169—1073.

APOLLINARIS.

The use, on labels and bottles, of the word *Apollinis*, in connection with the representation of a bow and arrow or anchor, was restrained by preliminary injunction, on account of the similarity between them and the word *Apollinaris*, and the representation of an anchor, as before used by the plaintiff, as being calculated and designed to induce the supposition, by users and dealers, that the waters of the defendant, so marked, were the waters of the plaintiff; but the plaintiff was ordered to give a bond to pay all damages to the defendant, if it should be finally determined that the plaintiff was not entitled to the injunction. 1—11—62.

ARBITRARY WORDS.

Where a manufacturer has invented a new name, consisting either of a new word or a word or words in common use, which he has applied for the first time to his own manufacture, or to an article manufactured for him, to distinguish it from those manufactured and sold by others, and the name so adopted is not generic or descriptive of the article, and is not used merely to denote grade or quality, but is arbitrary or fanciful, he is entitled to be protected in the use of that name as a trade-mark, and this, although it has become so generally known that it has been adopted by the public as the ordinary appellation of the article. 2—124—830—836.

Plaintiffs invented a name for certain puzzles or games, and applied thereto the names of "sliced animals," "sliced birds," and "sliced objects." **HELD:**

Upon motion to continue injunction, that these names were arbitrary fancy names and the proper subject of a trade-mark. 1—106—698.

Plaintiffs were manufacturers of certain games or puzzles for children, which consisted of pictures of animals, birds or objects on paste-board, cut into strips or pieces, and the puzzle consisted of putting the pieces together so as to form the original picture. To distinguish these manufactures plaintiffs had given to them the names "Sliced Animals," "Sliced Birds," or "Sliced Objects," according to the character of the picture, which names were placed upon the boxes containing the puzzles and upon the outside of the packages in which they were put up for sale, and the said articles had become well known by the names thus given them. In an action to restrain defendants from using said names in connection with similar articles manufactured for and sold by them **HELD:**

That the names so given were capable of being appropriated as trade-marks, and plaintiffs, having so appropriated them, were entitled to be protected in their use as such. 3—124—832.

See also, 1—25—136.

ASSETS.

For a trade-mark to pass under a bill of sale, it is not necessary that it should be specifically mentioned. If a trade-mark is an asset, as it is, there is no reason why it should not pass under the term "assets," in an instrument which conveys the entire partnership property. 2—133—880.

See also, 3—180—1128.

ASSIGNEE.

Where the assignee of the naked right to use a trade-name, claims the exclusive right to sell goods bearing this name, he must show that the name was originally used to designate goods of a certain quality or description, and is being used by him to designate, substantially, goods of the same quality or description, and that the use of the name does not operate to deceive the public into the belief that the goods are made by the man whose name they bear. 5—77—472.

An assignee or purchaser of a trade-mark from the original proprietor must in the use thereof indicate that he is assignee or purchaser, or he will not be entitled to protection in the use of the mark assigned. 2—152—969.

The publisher of "Chatterbox" in England, having assigned the exclusive right to use and protect that name in this country, the assignee may maintain his action against any other person who undertakes to publish books under that name in the United States. 1—139—915.

ASSIGNMENT.

A trade-mark, indicative of origin or ownership in the proprietor of a certain business, may be sold or assigned by him as an appurtenance

of such business, and the assignee may become entitled to the exclusive use of such mark, even as against such proprietor himself. 3—103—672—677.

As an abstract right, apart from the article manufactured, a trade-mark cannot be sold, the reason being that such transfer would be productive of fraud upon the public, but in connection with the article produced, it may be bought and sold like other property. 1—133—880.

The assignment by one partner of all his interest in a firm to his co-partners carries with it, if not expressly reserved, the right to the exclusive use of a trade-mark of the firm. 4—10—51.

A trade-mark cannot be assigned as a mere abstract right and independent of or disconnected from the business in which it is used. 1—153—970.

The proprietary right which a man has acquired in a trade-mark, or in the use of his name, or in any name, general or otherwise, which designates a particular business established and carried on by him, involving what is known as the "good-will" of the business, is in the nature of property, and transmissible by assignment or bequest, and will pass with the sale of the business to which the name or trade-mark is attached, or under a general assignment for the benefit of creditors, which, by its terms, transfers all the insolvent's property for the payment of his debts, although it may not be specified in the schedule annexed to the assignment, or in the one which, under the General Assignment Act of this State, is subsequently made out and filed. 2—53—329.

See also, 5—77—472.

2—152—969.

2—91—574.

4—77—467.

2—133—880.

AUTHORSHIP.

An author may restrain the publication of literary matter purporting to have been written by him, but which in fact he never did write; and this rule applies in favor of persons known to the public under an assumed name. Astral Oil, 1—173—1089.

BAND OF RIBBON.

A band of ribbon of such shape and so attached to the wares of a manufacturer as to enable them to be readily distinguished in the market, may properly be allowed registration as a trade-mark. 1—60—367.

BAYARD CIGAR.

The name "Bayard" and portrait of a United States Senator by that name held to be proper matter for a trade-mark in chewing tobacco. 1—37—217.

BUSINESS SIGNS.

The object of a trade-mark is to indicate by its own meaning, or by association, the origin or ownership of the article to which it is applied. A sign placed over a man's place of business with a row of beer barrels painted on it, and the letters "P. B." stamped on the head of the barrels, and the words "Depot of the Celebrated" placed above, and the words "Philadelphia Beer," placed below the barrels, would relate only to the description of the beverage dealt in by him, and cannot be protected as a trade-mark. 1—121—810.

See also, 1—17—97.

BILL OF SALE.

2—133—880.

CAUSE OF ACTION.

A declaration charging defendants with fraudulently and falsely selling goods of his own fabrication, as the manufacture of the plaintiff, by which the plaintiff was deprived of sales in the market, sets forth an actionable injury. 1—108—705.

See also, 2—177—1112.

CHERRY PECTORAL.

Plaintiffs invented and prepared a medicine for chest diseases, to which they gave the name of "Cherry Pectoral," and which was extensively known and sold as "Ayers' Cherry Pectoral;" one of the ingredients was extract of wild cherry, and the word "pectoral" had been, before the invention of plaintiffs' medicine, applied to medicines for chest diseases. HELD:

That the plaintiffs could not claim the exclusive use of the words "Cherry Pectoral," as a trade-mark. 2—4—18.

CLASS OF MECHANDISE.

Different persons may apply the same mark to different kinds of goods in the same class, provided their nature and resemblance are not so nearly the same as that the identity of the trade-mark would deceive the public as to origin or ownership. 3—38—222.

Where the dominating characteristic of a trade-mark is a name by which the manufacturer's goods have become familiarly known to the public, another manufacturer has no right to designate his goods by that name, even though he accompanies it with a different device. 1—56—356.

Although the revenue laws distinguish between cigarettes and smoking tobacco, there is no such substantial difference as will justify a manufacturer of cigarettes in applying to them a name which has become the well recognized designation of another manufacturer's smoking tobacco. 2—56—356.

Prior to 1834, S. W. Collins, D. C. Collins, and another, copartners as Collins & Co., made edge-tools, using as a trade-mark "Collins & Co." In 1834, they assigned to the Collins Manufacturing Company, a corporation, the right to such trade-mark. In 1843, the right to make all articles of metal was conferred on the corporation, and its name was changed to the Collins Company, the plaintiff. It always stamped "Collins & Co." on its productions. In 1856, the firm of Oliver Ames & Sons began to put the stamp and label "Collins & Co." on shovels made by it, and sent to Australia. The plaintiff had not up to that time made shovels, but it had a market in Australia for the articles it made and stamped "Collins & Co." The object of Oliver Ames & Sons in putting the stamp "Collins & Co." on the shovels, was to avail themselves of the credit and reputation and market which the plaintiff had established for itself for articles stamped "Collins & Co." The plaintiff, at the time of bringing this suit, had not sent or sold any shovels to Australia. The defendant, in succession to Oliver Ames & Sons, continued to do what the latter so began to do in 1856. **HELD:**

That the acts of Oliver Ames & Sons, and of the defendant, were always unlawful. The plaintiff having had, from 1843, the right to make all articles of metal, and having gone on from that time, both before and after 1856, extending its manufacture beyond edge-tools into digging tools, such as picks and hoes, and having always put the mark "Collins & Co." on its best quality of articles, the fact that it did not, before 1856, make a digging tool such as the shovel on which, in 1856, Ames & Sons put the mark "Collins & Co.," does not warrant the conclusion that that mark was not, in 1856, the mark of the plaintiff's trade in respect to such shovels. 1-104-680.

CLASS OF PURCHASERS.

The class of persons who would naturally be sent to a grocery store to buy this class of goods, would be such as might be imposed upon readily by the similarity of these two names. 3-66-403.

CLEAN HANDS.

8-176-1106.

COLLOCATION OF WORDS.

The appearance of the word "Astral," in a combination of words constituting a trade-mark, does not preclude its use in all other combinations formed for the like purpose. **HELD**, therefore,

That the plaintiff's trade-mark, "Pratt's Astral Oil," applied to refined petroleum, was not infringed by the use of the words "Standard White Astral Oil," to designate the defendants' refined petroleum. 1-173-1089.

See also, 2-119-798.

COLOR.

- Neither the color alone nor the form alone of a package, nor the color of an article of commerce can constitute a trade-mark. 1—135—891.
- The doctrine of the United States Courts, so far as it goes, is in entire consonance with that of the Courts of Great Britain and France, that color alone cannot constitute a valid trade-mark. 2—135—893.
- Colored fabrics being commonly on sale and in use, there can be no legal restriction upon their use by any person for any lawful purpose that suits his convenience. 4—135—893.
- The color of a label, apart from a name or device, cannot be the subject-matter of a trade-mark. 1—158—993.

COMMON LAW.

- The decision of the Supreme Court of the United States holding the trade-mark legislation of Congress to be unconstitutional and void, does not affect the validity or impair the force of a decree enjoining the use by defendant of a certain label or trade-mark, it appearing that the injunction suit wherein said decree was rendered was not a statutory but a common law proceeding. 1—45—279.
- The right of the proprietor of a trade-mark to the exclusive use of the same, and to protect and enforce his exclusive right by proceedings in Chancery, exists by virtue of the common law, and independently of the statute. 2—45—280.
- Property in trade-marks has long been recognized and protected by the common law and by the statutes of the several States, and does not derive its existence from the Act of Congress providing for the registration of them in the Patent Office. 1—40—247—254.
- Courts of Common Law and of Equity will, in the absence of any statute upon the subject, protect the proprietor of a trade-mark in its exclusive use. 1—65—396.
- See also, 1—140—919.
- 1—176—1101.

COMMON MATERIAL.

- Tin being one of the common metals in use by the public for a very large variety of purposes, and being easily stamped or impressed with letters, figures or characters, or cut into various shapes, and taking readily different colors or shades besides its natural metallic luster, and like paper, becoming readily the vehicle or material for receiving whatever impression or color may be stamped upon it. **HELD:**
- That the attempt of complainants to appropriate tin to their exclusive use in marking plug-tobacco, without regard to its color, shape or the characters or letters it bears, is not within the scope and purpose of the law of trade-marks. 1—179—1121—1122.

As words, characters and symbols descriptive in their application to any merchandise, cannot be appropriated by any one to his exclusive use, for the same reason ordinary materials sold in the market and adapted for manifold uses, cannot be appropriated to any particular one of these uses by any person to the exclusion of the public from the same employment of them. 3—135—893.

COMPOUND TRADE-MARKS.

Proposed trade-marks consisting in part of marks already registered by others, are objectionable when it appears that they would be liable to deceive the general purchaser. 4—80—490—491.

Numbers constitute a lawful trade-mark when they indicate origin or proprietorship, and are used in combination with words and other numerals. 1—109—714.

The words "homeopathic specifics," standing alone, cannot be appropriated as a trade-mark; but can be when used in connection with serial numbers. 2—109—714.

COMMERCIAL REPUTATION.

A man cannot openly appropriate and sell in the market, the commercial reputation which another has acquired by his industry and skill. 4—70—425.

COMPETITION UNLAWFUL.

Though the particular combinations of letters and figures used by appellees were not entitled to protection as part of appellants' trade-mark, yet it appearing that appellees copied those combinations, not for the purpose of indicating the size and quality of their plows, but for the purpose of misleading the public into the belief that appellees' plows were of a kind made by appellants, having an established reputation and large sale, HELD:

That appellees are liable to appellants for damages resulting from loss of trade in consequence of such copying and to an injunction restraining the further sale of such plows. 11—117—781.

Where the reading matter of defendants' publication was different from the complainants', but the name, style and arrangement were the same, and it was clear that the latter had been adopted for the advantage they gave. HELD:

That taking this advantage was injurious and illegal. 3—147—950.

It is unnecessary for present purposes, to consider whether the complainant has a valid trade-mark or can have a technical trade-mark in the name "St. Louis." It is sufficient that it was lawful for the complainant to use the name to designate its property, that by doing so it has acquired a trade which is valuable to it, and that the defendants' acts

are fraudulent and create a dishonest competition detrimental to the complainant. 4—148—954.

COPYRIGHT.

United States Courts have exclusive jurisdiction of actions for an infringement of a copyright. An author's property in his manuscript is lost by its publication. What combination of words will be protected as a trade-mark. What degree of similarity must be shown to justify an injunction restraining the use of another's trade-mark. 1—62—378.

A person becoming an author can secure to himself the exclusive right to his productions only by a copyright under the laws of the United States; and if he publishes anything without so protecting it, it becomes public property, and any person may republish it, and state the name of the author in such form in the book as he may choose, either upon the title-page or otherwise, as to show who was the author. 2—114—736.

CONSTITUTIONAL LAW.

The legislation of Congress upon the subject of trade-marks, of July 8, 1870, is unconstitutional. 1—20—111.

It cannot be sustained under the powers to legislate, in favor of authors and inventors, nor under the power to regulate commerce. 2—20—115.

See also, 5—40—258.

CORPORATIONS.

Plaintiffs alleged that they were co-partners trading as the Galaxy Publishing Company.

There was no corporation, merely a co-partnership. **Held:**

That the name which they adopted with their manner of using it, was a fraud on the public. 1—2—7.

A company claiming to have been incorporated under the laws of another State, commenced doing business in this State under its assumed corporate name. Subsequently, another company became incorporated by the same corporate name as the former, under the laws of this State, and commenced business in the same city in which the former company was already established. The company organized under the laws of this State, sought to restrain the persons composing the other company from continuing to do business under the corporate name, alleging that the defendants' pretended corporation no longer existed, but it was held that was not sufficient ground for the relief sought. If the defendants were no longer incorporated, or if their original organization as a corporation was illegal, they still had a right to prosecute their business as partners, and under any name they might adopt. 1—57—359.

- A corporation is entitled to have its trade-mark as well as a private individual, and may sue for its infringement. 2—79—483.
- For a tort committed by a foreign corporation within the State of Pennsylvania, such corporation is liable to be sued therein if found in the State in the person of an officer or agent upon whom process may be served. 3—120—808.
- A corporation may acquire a property right to the use of a name other than its original corporate name as a trade-mark, or as incidental to the good-will of a business, as well as an individual; and when it has acquired such a right, it cannot be deprived thereof by the assumption of such name subsequently by another corporation, whether the latter selects its name by the act of incorporators who organize under the general laws of the State, or the name is selected for it in a special Act by a legislative body. 1—141—921.
- A United States Circuit Court cannot interfere by injunction, at the instance of a corporation organized under the laws of another State, and prevent any necessary step from being taken, under the Statute of the State in which such Court is located, in the creation of a corporation bearing the same name as the foreign corporation. 1—155—985.
- Whether relief could be granted after the creation of the corporation, and use of the name of the foreign corporation in fraud of its rights, is not determined. 2—155—985.
- See also, 2—32—189.

COSTS.

- In trade-mark cases, the ordinary rule is that a decree for an infringement and an injunction carries costs; and this rule applies, though no demand was made before suit, that the defendant should cease to use the infringing trade-mark. 3—90—566.

DAMAGES.

- Specific damages need not be shown in such a case, but the jury may assess such damages as they may on the whole evidence, be satisfied has been sustained. 6—52—324.
- The measure of damages is limited by the extent to which the unlawful use of the design by the defendant, has interfered with the sale of plaintiff's commodity. 3—137—906.
- That damages will be given only for such sales as have taken place after the commencement of the action, where it is shown that the plaintiffs knew of the infringement, but took no steps to arrest it. 3—26—147—149.
- As the complainant here is in laches in bringing suit, (eleven years after knowledge of the infringement,) and as the circumstances justified the defendant in believing that he was licensed by silence, the relief granted must be limited to an injunction. 4—156—989.

Where a party has made profits by the sale of goods in violation of the rights of another in a trade-mark, the owner of the trade-mark is entitled to them, whether the same profits would have been made by him or not, and not to any more if they would, for the same profit could not be made by both. 1—167—1063.

See also, 11—117—781.

1—91—574.*

DECEIT, ACTION OF.

Where a label adopted by a merchant to designate goods purchased by him, and for which he had built up a large trade, has been simulated by another merchant, placed upon inferior goods, and put upon the market, an action in the nature of an action for deceit will lie, at the suit of the former. 5—52—323.

DECEPTION OF PUBLIC.

The sight of a familiar symbol inducing one to purchase goods to which the symbol does not properly belong, to the injury of him who devised it to mark his own goods, is the gravamen of the law of trade-marks. 2—177—1112.

If the marks are so different that the ordinary buyer cannot be deceived no wrong is done to the public. 2—52—321.

The use of a trade name to designate a business, so like that of another person in the same business, as to raise a strong probability of misleading and deceiving the public or to show a design to so mislead and deceive will be restrained. 1—164—1041.

Complainants claimed the right to use the name "Dr. J. Hostetter's Stomach Bitters," in connection with certain labels, bottles and other devices which designated the preparation as of their own manufacture and indicated its origin, and in their bill they averred that defendants were selling to the trade an extract out of which it was claimed Hostetter's Bitters could be made, with directions how to make such bitters, and that the retail dealers were making these bitters and refilling complainants' bottles, with their labels and devices thereon, and thus selling them— HELD:

That defendants had the right to sell their extract as charged as no purchaser could suppose that he was purchasing the preparation made by complainants; that they could not be held responsible for the acts of third parties, and that an injunction would not be granted. 4—122—816.

It is not sufficient that traders may not be misled by the resemblance which a proposed trade-mark bears to another, but the distinction must be sufficient to prevent the deception of ordinary purchasers or consumers. 1—21—117.

The use, by another, of a trade-mark used to indicate the quality of an article sold, though placed on articles of equally good quality, and without

any intention to defraud either the proprietor or the public, will be restrained by a Court of Chancery, and this, although it is not copied with the fullest accuracy, if the copy is calculated to deceive and may be taken for the original. 3—65—398.

The resemblance need not be such as would deceive persons seeing the two trade-marks placed side by side, or as would deceive experts. 3—136—901.

That where it is proven that the public, asking for the genuine article in buying from retail grocers, are supplied with an article in the simulated wrapping, and take it without detecting the simulation, it is sufficiently proven that the public have been fraudulently deceived. 2—26—147.

That the injunction was properly issued if it appeared that persons, desiring to purchase the plaintiffs' publication, might well accept that of the defendants, supposing and believing it to be the plaintiffs, even though persons engaged in the trade of buying the books with an intention to re-sell them, might not be misled by the resemblance, and though the difference could be readily detected by a comparison of one book with the other. 4—62—381.

An injunction should be granted if the defendants adopt the brand for the purpose of selling their goods as and for the goods of the complainant, or for the purpose of enabling others to do so, and the complainant has been injured or is likely to be injured thereby. In such case it will not be sufficient for the defendants to show that no deception is in fact practiced on those with whom they deal personally; but an injunction will be granted if consumers to whom the goods are intended to be resold are or may be deceived. 2—159—998.

See also, 4—80—490.

11—117—781.

DEFENCES.

The infringer cannot justify his wrongful act by showing that the plaintiff has violated some general law of the State, not affecting his right to have a trade-mark, but on a different subject. 3—79—483.

The unauthorized use by other parties of plaintiff's trade-mark, is no justification of defendant's acts of infringement; but, on the contrary, such circumstance is, under the authorities, one of aggravation. 2—95—601.

It is no answer for the defendant, where the complainant asks for protection, to say that it has no exclusive right to designate its products in the manner it has, although this might very properly be asserted by a competitor selling beer made at St. Louis, or who by reason of any circumstance, might be entitled to represent his product as originating there. 2—148—954.

DELAY.

An injunction will be dissolved where the plaintiff has slept upon his rights for more than a year after it was granted, and has not prosecuted the case further. 1—67—407.

DEMURRER.

A bill filed to restrain an alleged infringement of a trade-mark based upon labels or wrappers, which does not aver a similarity or imitation in the appearance of the labels or wrappers, is insufficient and will be held bad on demurrer. 1—119—798.

In an action to restrain defendant from using a trade-mark alleged to have been devised by him in imitation of that of plaintiffs, and to be in fact deceptive to purchasers, etc., if *fac similes* of the two trade-marks are annexed to the complaint, it will not be held, *on demurrer*, that the one is not sufficiently similar to the other to mislead, and to constitute an infringement, unless the dissimilarity is so marked as to leave no doubt in the mind of the Court; but the question of infringement will be reserved until the coming in of the proofs. 1—71—431.

Where the demurrer was to the whole bill, and the bill was in itself sufficient, aside from the allegations contained in it, upon which the demurrer was taken, the demurrer was overruled. 2—113—732.

Differences between the original and the simulated trade-mark, which, in the absence of fraud, may be sufficient to repel the charge of infringement, will not be regarded upon demurrer. 1—31—178.

To demur is to confess the allegations of fraud and of deceptive intent, in the use of the imitation mark charged by the bill, and upon overruling the demurrer, an injunction will be allowed, and defendant ordered to answer on the merits. 2—31—178.

DESIGN PATENT.

The Office, after having adjudicated certain subject-matter patentable as a design, and granted a patent therefor, thereby giving the patentee the exclusive right to use the same for the term of years mentioned therein, cannot register as a trade-mark substantially the same design, and give to another and different party the right to use it as a trade-mark. 1—127—845.

DESCRIPTIVE NAMES.

Words in common use as descriptive of medicines for particular diseases, or which merely indicate by its common name, an ingredient of a medicine, cannot be appropriated by a manufacturer of such medicines as a trade-mark, nor can a combination of such words be so appropriated. *Caswell v. Davis*, 58 N. Y., 223, followed as controlling. 1—4—18.

The word "Parabola," registered June 27, 1871, by Robert J. Roberts, of New York, as a trade-mark for needles, held not to be descriptive, but an arbitrary term adopted by complainant to distinguish his needles from those of other manufactures, and his right to so select and apply it affirmed. 1—25—136.

Trade-mark words "Rye and Rock" are descriptive and cannot be appropriated as a trade-mark. 1—51—314.

The law is well settled that words merely descriptively used, are not proper subjects for trade-mark registration. *Canal Co. v. Clark*, 13 Wall., 311. 1—58—362.

The use of descriptive words objectionable, for two reasons, first, because the public will be apt to understand the words as merely descriptive, and will not therefore associate them with origin or ownership, and second, because others can employ a merely descriptive word upon their wares with equal truth and consequently with equal right. 2—58—362.

The term "straight cut," as applied to cigarettes, is a term descriptive of the ingredients and character of the article used, and cannot be appropriated as a trade-mark, so as to preclude another from advertising cigarettes made of straight cut tobacco. 1—105—695.

A name alone is not a trade-mark when it is understood to signify not the particular manufacture of a certain proprietor, but the kind or description of thing which is manufactured. 3—122—814.

A word merely descriptive of an article of trade, of its qualities, ingredients or characteristics, cannot become a lawful trade-mark by virtue of a change in its orthography to that of a foreign language in which it possesses the same meaning. 1—125—838.

A word that is descriptive of the nature and quality of a compound, cannot be claimed and allowed as an exclusive trade-mark. 1—111—1035.

See also, 1—111—723.

1—121—810.

2— 4— 18.

1— 89—561.

"DEVICE."

The word "device" is used in respect to trade-marks in a sense totally different from that in which it is employed in connection with mechanical contrivances. It does not signify an expedient or scheme for any purpose but an emblematic figure, mark or sign capable of being imprinted or otherwise displayed upon merchandise. 5—135—894.

DIRECTIONS FOR USE.

Where the alleged imitation by the defendants, of the plaintiffs' trade-mark consisted, among other things, in the directions for the use of the article, which directions were identical with those printed on the plaintiffs' label. HELD:

That this did not constitute an infringement of the plaintiffs' trade-mark. 2—18—105.

DIVISION MARKS.

Every manufacturer has the right to indicate points or lines of division by marks upon his goods or packages. 3—16—93.

A registration trade-mark for plug-tobacco, consisting of one longitudinal line dividing the plug into equal parts, and a series of transverse lines crossing the plug at right angles with the longitudinal line, and at equal distances from each other, will not prevent the use of a trade-mark for tobacco, consisting of a series of seven Greek crosses stamped on the centre of the surface of the plug at equal distances from each other, and a series of half crosses on the margin opposite the full crosses, as guides for cutting the plug into pieces. 2—16—93.

DRESS OF GOODS.

The doctrine of relief in equity, against infringement of trade-marks, rests upon the principle, that no one should be permitted so to dress his goods for sale, as to enable him to induce purchasers to believe that they are the goods of another. 1—12—67.

DUTY OF COMPETITOR IN BUSINESS.

Requiring defendant to refrain from selling any Singer Sewing Machine, without indicating in some distinct manner, that said machines were not manufactured by the Singer Sewing Machine Company. 4—13—75.

EQUITY JURISDICTION.

A bill in equity lies in this Court only on account of its preventive relief, and perhaps to save multiplicity of suits, as in case of the infringement of a patent. *Root v. Railway Co.*, 105 U. S., 189. 2—147—950.

ESTABLISHED 1780.

The words "Established 1780," or "Established A. D. 1780," which have been conspicuously displayed and used upon the signs, labels, bill-heads, &c., of a drug house for a great number of years, may strictly and rightly be denominated a trade-mark, and the right to the exclusive use of such words will be protected by a Court of Equity. 1—17—97—98—100.

ESTOPPEL.

In order for one suit to constitute an estoppel upon any party to another suit, four conditions must co-exist, viz:

- 1st. There must be an identity of the cause of action.
- 2nd. There must be an identity of parties to the suit.

3rd. There must be an identity in the character or quality of the respective parties, and

4th. There must be an identity of the thing in question. 1—10—46.

EVIDENCE.

2—26—147.

3—110—720.

See also, 3—136—901.

10—117—776.

EXPERTS.

It is enough that such similitude exists as would lead an ordinary purchaser to suppose that he was buying the genuine article and not the imitation; and it is not necessary that the resemblance should be such as would mislead an expert, or such as would not be easily detected if the original and spurious were seen together.

And HELD that, for the purpose of proving the defendants' packages with their labels so closely resembled those of the plaintiffs as to mislead an ordinary purchaser, wholesale dealers in hair-pins might testify as experts. 5—102—661.

4—101—645.

EXPIRED PATENT.

Right to use of Name. If a sewing machine has acquired a name which designates a mechanism or a peculiar construction, parts of which are protected by patents, other persons, after the expiration of the patents, have the right to construct the machine and call it by that name, because the name only expresses the kind and quality of the machine. 1—13—73.

The validity of a common law trade-mark is not affected by the fact that the owner of the trade-mark is also the owner of a patent covering the article to which the trade-mark is applied. The expiration of the patent does not terminate the existence of the trade-mark. 3—35—211.

Where a word indicates a patented machine of peculiar mechanism, such word cannot be protected as a trade-mark upon the expiration of the patent. 1—75—452.

Where a patentee uses his name and marks to designate his invention, and also the product of it, as manufactured by himself, so that the public cannot separate the one from the other, he cannot acquire any right to the exclusive use of the name and marks after the patent has expired. 1—98—616.

While no one has the right to make and sell his own wares as the wares of another, every one has the right to make and sell any wares not protected by patents; and a manufacturer of a patented article, after the expiration of the patent, has a right to represent that it was made

according to the patent, and to use the name of the patentee for that purpose. 1—126—843.

Where frames for sewing machines in the form of the letter G, have been so extensively manufactured and sold by the inventor during the time they were protected by patents, that the machine containing this feature has come to be known in the trade thereby, after the expiration of the patents, the patentee cannot, by claiming such form or shape of frame as a trade-mark, prevent others from using such frames in sewing machines manufactured and sold by them. 2—126—844.

Semle, that after the expiration of a patent, no manufacturer of the patented article can appropriate the name or the principal part of the name of the patent as a trade-mark. 2—145—941.

Complainants having attempted to secure to themselves by means of a patent, the exclusive use of tin as a badge for their plug-tobacco, and their goods having acquired the name of "Tin Tag" goods while they were acting under their patent. **HELD:**

That when the patent was declared void the right to so indicate or mark such goods became public, and complainants cannot perpetuate or continue this right by claiming it as a trade-mark. 2—179—1122.

FAIRBANKS' SCALES.

The words "Fairbanks' patent" were cast in the scales made by both parties. All the patents which Fairbanks & Co. had, had expired. Fairbanks & Co. applied for an injunction to restrain Jacobus from using the words "Fairbanks' patent" on his scales, and from making or selling an imitation of Fairbanks & Co's scales. **HELD:**

That the application must be denied; that the words "Fairbanks' patent" were not a trade-mark; and that Jacobus did not represent his scales to be of the make of Fairbanks & Co. 4—5—23.

FOREIGN COMMERCE.

Laws of the United States now in force, relate only to trade-marks specially used in connection with foreign nations or with Indian tribes. 2—140—919.

Under section 3, of the present Act, the applicant will be required to specify some particular foreign nation or Indian tribe with which he has commercial relations. 4—80—492.

See also, 3—140—919.

FOREIGN LANGUAGE.

1—125—838.

FRAUD.

Rule laid down by Judge VAN BRUNT in *Kiminy v. Basch*, 16 *Law Reg.*, N. S., 596, approved and quoted as follows: "If the use of any word,

numerals or symbols is adopted for the purpose of defrauding the public, the Courts will interfere to protect the public from such fraudulent intent even though the person asking the intervention of the Court may not have the exclusive right to use the words, numerals or symbols." 3—41—264.

It is not necessary, under the rules of law as they now prevail in this State in regard to trade-marks, to determine whether there was an intent to do wrong or not; it is sufficient that the proprietary right of the complainant and its actual infringement is shown. 3—86—551.

See also, 2— 68—413.

3—159—998.

10—117—776.

2— 21—117.

4—136—901.

3— 24—131.

3—150—963.

GENERIC NAME.

"Worcestershire Sauce" is a Generic Term. The term "Worcestershire Sauce," has become generic as applied to a certain kind of table sauce, and cannot be exclusively appropriated by the complainants, simply because they reside in Worcestershire, England. 1—22—119.

While the fact that a term has become generic is fatal to its subsequent adoption as a trade-mark, it is not fatal to its continued use, nor to its registration by the lawful assignee of those whose use rendered it generic any more than to its continued use or registration by the assignors themselves. 5—35—211.

The commercial name of an article which every man has a right to make and sell, cannot be appropriated as a trade-mark. 1—70—424.

But when coupled with other distinctive features, the whole may be so appropriated. 2—70—424.

Words which have acquired a significance in the market as expressive only of the name or quality of an article cannot be appropriated as a trade-mark. But if the primary object of the trade-mark be to indicate origin or ownership, the mere fact that the article has obtained such a wide sale that the mark has also become indicative of quality, is not of itself sufficient to debar the owners of protection, or make it the common property of the trade. To hold otherwise would be to deprive the owner of the exclusive use of his trade-mark just at the time when it had become most valuable to him, and stood most in need of protection. But if the name be suffered to come into general use without objection from the proprietor, it may become merely generic, or indicative of quality. 2—103—672—676.

A name alone is not a trade-mark when it is applied to designate, not the article of a particular maker or seller, but the kind or description of thing sold. 2—157—991.

See also, 2—124—830.

1—13—73.

1—122—814.

1—157—991.

1—103—672.

1—142—930.

3—13—75.

GEOGRAPHICAL NAME.

Defendants do business in Richmond, Va., and advertise and sell, as Durham smoking tobacco, tobacco which they put up in Richmond, and which they obtain from any source available to them other than Durham. Such a practice necessarily deceives every purchaser who, in purchasing this Durham smoking tobacco, believes that he is purchasing the fine tobacco put up in the place of that name in North Carolina. 2—10—48—49.

A geographical name, although also the name of an historical personage, is not a proper subject for trade-mark registration. The word "Raleigh" refused. 1—59—364.

As a rule geographical names cannot be allowed registration as trade-marks. 1—68—410—417.

Undoubtedly Courts of Equity have granted injunctions to restrain the fraudulent use of words of this character; but the grounds of such decisions have been invariably, I think, the fraud of the defendants, and not any exclusive right of the plaintiff. Examples quoted, *C. D.* 1872, p. 128; *Newman v. Alword*, 49 *Barb.*, 588; *Brooklyn White Lead Co. v. Masaury*, 25 *Barb.*, 416. 2—68—413—417.

The plaintiff, who first applied the word "Vienna" to baked bread and other articles, having been engaged in the manufacture, in the City of New York, of an article known as "Vienna Bread," and which he has for many years past sold with a label thereon containing the words "Vienna Model Bakery," can maintain an action restraining the use by other parties, of a label in imitation of his own, and in particular, from applying the word "Vienna" to baked articles. 1—85—542.

Where manufacturers at one place falsely mark or brand their goods as manufactured at another, for the purpose of inducing trade which would otherwise go to manufacturers at such other place, such false marking will be considered as fraudulent, and a "resort to a palpable trick," and, the complainant being injured thereby, the infringing manufacturers will be enjoined from thus using the name of the place where the complainant carries on its business. 3—159—998.

See also, 1—22—119.

GOOD-WILL.

Payment for the "good-will" of a business must be claimed at the time of the transfer of the business. 4—180—1128.

To recover for the "good-will" of a business transmitted from one person to another it must appear affirmatively that there was a "good-will" connected with the business, of some value in itself. Proof merely that the business is profitable is not enough. 2—180—1127.

See also, 2—53—329.

IDEM SONANS.

Action brought to restrain defendant from using the word "Loyal" to denote a brand of "Baking Powder." HELD:

That the word "Loyal" was substantially *idem sonans* with the word "Royal," and when rapidly spoken by people not accustomed to the nice distinction of speech, they might be taken for the same word. 1—66—402.

The adoption of a label which in colors, in its design and collocation of the letters, and even of the vignette and in all the characters which strike the eye, is so identical with that of the plaintiff, that it confirms the impression which would be created by the use of the general name, or generic term, that there was an intention on the part of the manufacturer of defendant's goods, to avail himself of the reputation of the plaintiff. 2—66—402.

IMITATION.

To sustain an action in a State Court for an injunction against an infringement or imitation of trade-mark or labels, plaintiff, although his label contains a registered trade-mark, need not prove an imitation of that mark. It is enough if the general effect of the defendant's wrapper and label, constitute a wrongful imitation of those of plaintiff, although defendant may have replaced the symbol or "trade-mark," with a clearly different device. 2—12—70.

Upon principle, no man should be allowed to sell his goods as the goods of another, nor should he be permitted to so dress his goods as to enable him to induce purchasers to believe that they are the goods of another. 4—12—67.

Courts will interfere where it is apparent that there is an imitation of plaintiff's label, whether as to color, shape, or inscription, which imitation is calculated and intended to deceive the general public. 6—12—70.

Parties will be protected from the imitation of their packages so far as they are peculiarly designed and shaped for the purpose of distinguishing their goods, and from the imitation in color, design, style and lettering combined of the labels used to mark said packages. 2—161—1036.

Parties will be restrained by injunction from using packages made in imitation of others in the trade, and calculated to deceive the buying public and to defraud the original users of such packages; but such imitation must be sufficiently close to have that effect or the injunction will be refused. 1—175—1096.

See also, 1— 11— 62.

1—119—798.

6—101—645.

INDICIA.

Long-continued use of a particular form of package and of particular colors for its wrappers, papers of directions and labels, having served to distinguish the complainants' article in the trade, the appropriation of such peculiarities in form and color by another dealer for packages of the same article will be restrained. 2—9—33-37.

It is not important to determine whether the device simulated is technically to be called a trade-mark or a label * * * The entire device simulated was that which had been adopted by a merchant to designate goods manufactured for him, and under his direction, and sold by him * * * he had introduced his goods extensively under the designation he had adopted, and was entitled to its exclusive use as a trade-mark. 3—52—321.

The injury done was not in calling the beer sold by defendant Budweiser beer, but in affixing to the bottles a mark calculated to deceive the ordinary purchaser into the notion that the bottled beer of Uhrig was the article so carefully prepared by Conrad, by whatever name it might be called. 4—52—322.

That the label bears a name the use of which could not in equity be protected as a trade-mark, will not prevent a recovery, where the label is imitated in size, shape, color, device and general appearance. 7—52—323.

The plaintiffs' mark of trade is the entire style of their bottle and label, of which the name of their article forms a part, and the other details of design and lettering. 2—96—611.

A word used as a trade-mark is addressed to the eye as well as to the ear, and cannot be disassociated from its surroundings when the inquiry is whether it is a colorable imitation. 3—149—961.

Defendants use cans of precisely the same size and shape of those of plaintiff, to which are affixed labels of same colors and general design, with the words Coral Baking Powder thereon. **HELD:**

That the words "Coral Baking Powder" is not in itself an infringement of plaintiff's trade-mark, "Royal Baking Powder," but the general arrangement of the words being the same, the devices upon the can being very much alike, and the labels of the same color and general appearance, purchasers might be easily deceived into buying the one for the other. 1—162—1041.

INFRINGEMENT.

In a suit to restrain the use of trade-marks alleged to be simulated, if it appears by the testimony that the marks used by the defendants, though resembling those of the plaintiffs in some respects, have not

deceived and are not likely to deceive the ordinary mass of purchasers paying the attention which such persons usually do in buying the article in question, an injunction will not be granted. 1—18—105.

The plaintiffs were the manufacturers and vendors of a new article of soap, put up in the form of a pressed cake, wrapped in silver-foil paper, encircled with an ultramarine blue colored paper band, printed in gold letters. The defendants manufactured a similar article, and introduced it to the market in an ordinary envelope. It did not sell well, and they therefore enveloped their soap in a wrapping substantially the same as the plaintiffs, though having minute variations. **HELD:**

That an injunction will be granted, where the differences between the trade-mark and an infringement can be detected upon a brief, though careful comparison, if it be apparent that the object in putting up the infringing articles, was simply to gain custom by general resemblance to the genuine article. 1—26—146.

The manner in which defendants printed their name upon the labels in question, was likely to draw attention, from the difference between it and plaintiff's name, and lead the ordinary reader to believe it to be plaintiff's name. **HELD:**

That in such case, the intent being evident, the plaintiff is responsible for the effect produced, *though the name used was its proper corporate name.* 2—32—189.

The defendant had no right to imitate the trade-mark of the plaintiff, by using in his label or trade-mark any of the prominent or distinguishing words of said plaintiff's trade-mark. 3—45—280.

A Court of Equity will restrain the fraudulent imitation of a package and label, although they do not technically constitute a trade-mark, where the public are thereby misled into purchasing the goods of the imitator as those of the original manufacturer. 1—49—294.

Action by "Royal Baking Powder Company" against defendants to restrain them from the use of the word "Royalty" in connection with the manufacture and sale of baking powder.

The defendants are engaged in the same line of business. Their manufacture is put up in round tin boxes of the same forms, sizes and shapes as those used by plaintiff, having red and yellow labels on each box, containing similar large letters on curved lines on the red label and the words "Royalty Baking Powder" with a different ornament or device in centre from that in the centre of the plaintiffs' red label, and at the upper part of the yellow label in similar type and placed upon the label in the same form the words "Royalty Baking Powder," followed by printed directions in English and in German on each side of the centre of the label with the names of the manufacturer at the foot. **HELD:**

That the general appearance of the boxes and labels is so nearly identical as to be well calculated to deceive ordinary observers. 1—50—312.

The plaintiff had a right of trade-mark in a symbol which consisted of an eagle with outstretched wings, perched on a mortar, in which rested a pestle, which device was used upon labels for medicinal purposes and other articles. **HELD:**

That the use of this symbol by the defendant, as a prominent feature of labels for similar preparations and articles, was an infringement of the plaintiff's rights, although another name appeared conspicuously upon such labels instead of the name of the plaintiff, and notwithstanding the fact that symbols of a similar nature were shown to be in general use by druggists and apothecaries for purposes of ornament. 1—64—391.

Trade-marks may consist of pictures, symbols, or a peculiar form or fashion of label, or they may consist simply of a word or words. 1—73—442.

Where the trade-mark is of the first kind, to constitute an infringement, there must be such an imitation as to amount to a false representation, liable to deceive the public. 2—73—442.

Where, however, the trade-mark consists of a word, it continues to be the distinguishing mark of the manufacture to which it is applied, in whatever form it is printed or represented, and its use by another, in any form, applied to similar articles, is unlawful and may be restrained. 3—73—443.

The use of the word by another is not justified, although used in connection with different words from those in connection with which it is used by the party who has appropriated it as a trade-mark. 4—73—444.

Where the special features of complainant's trade-mark have been for many years used upon labels of the same character by persons engaged in the same trade, and the appearance of said labels apart from the names, is such as results from an ordinary and rightful use in an appropriate manner, without intention of making by such use, a definite effect of the whole taken together, and these particulars are not so employed by complainants that an original design or combination has resulted which can be perceived by itself apart from its components, and the labels of defendants could be mistaken for those of plaintiffs only on account of a resemblance in these particulars used in an ordinary and rightful manner, and the name of defendant appearing prominently on his labels and is conspicuously different from the firm-name upon plaintiff's labels. **HELD:**

That defendant was entitled to a dismissal of the complaint on the merit. 1—76—456.

Where, in an action to restrain the infringement of a trade-mark, it is shown that defendant has in his store, and offers for sale, a spurious article, with an imitation of plaintiffs' trade-mark thereon, although but a single sale is proved, it is sufficient to sustain an injunction against a continuance of the wrong. 1—110—719.

An action for such injunction will not be defeated solely on the ground that on the day it was brought defendant happened not to have any of the article on hand. 2—110—720.

Declarations of the clerk, made at the time of the sale and in connection therewith, are competent evidence. 3—110—720.

When plaintiff shows that he has adopted a legal trade-mark, that it has been infringed, and that actual probable or possible damages have or may result from its infringement, he is entitled to relief usually in the form of an injunction and an account of profits. 4—117—760.

As to what facts constitute infringement of a trade-mark or trade reputation, no rule can be formulated that will embrace every act of infringement, and the original and alleged imitation are of primary importance. The resemblances need not be such as would mislead an expert or could not be easily detected if the original and the spurious were seen together. It is enough if such resemblances exist as would lead an ordinary purchaser to suppose he was buying the genuine article and not an imitation. If the differences are only colorable, and there is no reason for the resemblances except the purpose of deceiving the purchaser of one article into the belief of its being the manufacture of another, the Court will presume a fraud was intended. 10—117—776.

In a case where it is claimed that a trade-mark has been infringed, to constitute an infringement it is not necessary that the device complained of should be a *fac simile* of the device of complainants. There may be an infringement without exact similarity. 1—136—899.

No manufacturer will be permitted to stamp upon or attach to his goods, the name of another manufacturer. 1—145—941.

Printing and selling labels in imitation of a trade-mark, with the purpose of enabling the parties to whom the labels are sold to palm off their goods upon the public as the goods of the owner of the trade-mark, is a violation of the rights of such owner. 1—151—965.

The complainant in a trade-mark suit is entitled to relief, if the marks or brands used by the defendants sufficiently resemble the complainants' marks or brands to be mistaken for them. 1—159—998.

Soap packed in a box, with alternate red and yellow wrappers, so as to produce a representation of a trade-mark of the same combination of colors, is not an infringement of that trade-mark. 1—174—1093.

The fact that the plaintiff's marks are themselves a close imitation of those of a third party will be good ground for withholding the aid of a Court of Equity. 8—176—1106.

INJUNCTION.

It is the settled doctrine of the Courts of England as well as America, that a special injunction will be dissolved upon the coming in of an answer or affidavits denying the equities of the bill. 4—67—408.

Property in the use of a word as a trade-mark, to designate manufactured goods, such as the word "Hoosier," to distinguish a grain drill, may be acquired by adoption and exclusive use, and when acquired, the unauthorized use by another of the mark, to designate similar goods, is a wrong which may be compensated by damages and prevented by injunction. 1—92—570.

In order to justify an injunction restraining a party from using a trade-mark, name or other device descriptive of his goods, it should appear that he is in fact so using it as to represent, or induce the belief that the goods which he manufactures or sells are the goods of the plaintiff, and that there is danger that the plaintiff will in that manner be defrauded. 1—129—856.

See also, 6—70—425.

1—169—1073.

4—155—989.

2—31—178.

4—44—277.

INTENTION.

Where a trade-mark is calculated to mislead, even if no one has been actually deceived an intention to deceive will be presumed. 2—21—117.

In this case the following facts appeared:

The labels used by defendants in their business, were in undoubted imitation of those used by plaintiff, and the greater part of the details were so like the corresponding details of plaintiff's labels, that it was plainly defendants' intention to represent that the goods upon which the same were to be placed, were made by plaintiff. **Held:**

That the plaintiff was entitled to protection against this. 1—32—188.

Although a man may not intend to injure another, yet he will not be allowed to adopt the marks by which the goods of such other person are designated, if the effect of adopting them would injure such other person. 3—33—201.

Even if the resemblance between the plaintiff's wrappers and those used by the defendants was accidental, the plaintiff would be entitled to protection against its injurious results to his trade. 5—70—425.

To entitle a party to restrain another from continuing the unlawful use of his trade-mark, it is not essential to show an actual intent to defraud. 5—73—444.

In Georgia, to have a word or words claimed as a trade-mark, protected by injunction from use by another, it should appear the defendant's use of them was with intent to deceive or mislead the public. 2—89—563.

The defendants were not excused for the use of the label and device, by the fact that they acted in good faith, and believed that they were

not infringing the rights of the plaintiffs. The injury to the plaintiffs remained the same. 3—102—660.

The purpose to be effected by an injunction in such a case, is not primarily to protect the purchaser, but to secure to the manufacturer the profit to be derived from the sale of his goods to all who may desire and intend to purchase them. 4—102—659.

There may be an infringement without a specific intent to deceive the public. If the effect of the device, when considered alone or in connection with the shape, size, character and appearance of the article upon which it is placed, is to deceive, the party adopting it must be held to have intended deception, as every man is held to have intended the necessary, natural and probable consequences of his own acts. 4—136—901.

See also, 3—86—551.

INTERFERENCE.

The Commissioner of Patents has authority under the statute and rules of the Patent Office to institute an interference between opposing claimants for registration of the same trade-mark for the purpose of determining the ownership of the same. 1—44—274.

The successful party in such an interference is entitled to a provisional injunction against the licensees of the unsuccessful party when on doubt exists as to the infringement. 4—44—277.

INSURANCE OIL.

The words "Insurance Oil" are a legal trade-mark. 5—79—484.

JOINT TRADE-MARK.

Where two persons, associated in business for the manufacture and sale of a commodity, jointly adopted a trade-mark for it, they are equally entitled to its use after the dissolution of their connection; and if one of the parties obtain letters of registration in his own name, he may be compelled to transfer an equal interest to his associate. 1—36—213.

JUDICIAL NOTICE.

Where the records of this Office disclose that certain parties registered a trade-mark under the law of 1870, that such trade-mark was their property, that they had been using it in this country for ten years next preceding the date of their application for registration, and there is no evidence that they have ever abandoned such trade-mark, HELD:

That section 3, of the Act of 1881, and the spirit of the whole statute, authorize the Patent Office to take notice of the facts recited in said records, in determining "the presumptive lawfulness of claims to the alleged trade-mark" by subsequent applicants for registration, and the Examiner was justified in re-

jecting the application for registration on the facts disclosed in said record. 3—138—914.

JURISDICTION.

In such cases the Court has power to interfere, and should exercise the power. 5—12—67.

Courts of United States have not jurisdiction between citizens of same State, unless the trade-mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe. 3—140—919.

In a suit to restrain the infringement of a trade-mark, the amount in dispute, as determining the jurisdiction, does not depend on the profits sought to be recovered. 2—181—1130.

LABEL.

The proper test in distinguishing between trade-marks that savor of description and labels that imperfectly describe, is to consider whether the public will on the whole regard the mark as an arbitrary symbol denoting only the origin and ownership of the goods, or as an advertisement of some desirable quality of the goods themselves. 1—78—475.

The several Acts of Congress regarding the registration of prints, designed to be used as labels, do not exclude from registration a label containing matter which might be registered as a trade-mark; nor does the fact that a label bears such distinguishing marks as entitle it to registration as a trade-mark, exclude it from registration as a label, if the owner desires it to be registered as such. Whether the Commissioner of Patents is to regard it as the one or other wholly depends upon the will of its proprietor. 1—93—590.

Congress intended to devolve upon the Commissioner of Patents, the duty of determining the character of the subject-matter offered for registration under the label and trade-mark law. 1—143—932.

The proper construction of the statute is that the subject-matter of an application for label, shall be that which may be properly claimed as a label, and not be merely subject-matter for a trade-mark. 2—143—933—935.

But the statute does not mean to imply that if certain subject-matter is found to be incapable of registration as a trade-mark, it can nevertheless be registered as a label, for it may not be descriptive of the quality or nature of the goods, and therefore fail to constitute a label. 3—143—936.

In the case at bar the Examiner properly refused to register as a label, matter which, gauged by the established rules, constitutes only subject-matter for a trade-mark. 4—143—937.

Complainant, a brewer in St. Louis, Missouri, made and exported to Panama and South American ports, beer in bottles, with a label

bearing the words "St. Louis Lager Beer." Defendant, a shipper of beer from New York City, and a competitor of complainant in trade in Panama and South America, labeled his bottles "St. Louis Lager Beer." **HELD:**

That although complainant could not have an exclusive property in the words "St. Louis" as a trade-mark, or the exclusive right to designate his beer by the name of "St. Louis Lager Beer," yet, as his beer had always been made at that city, his use of the designation upon his labels was legitimate; and that defendant, whose beer was made in New York, should be enjoined from diverting his trade by simulating his labels, or representing in any other way, his products as those of complainant. 1—148—953.

Although the name applied by a complainant to his goods may not afford protection as a trade-mark, where others are guilty of imitating the labels used by him in making sales thereof, they will be enjoined. 3—157—992.

Where a manufacturer has applied a peculiar and distinctive label to designate his goods, and has so used it that his goods are identified by it, a Court of Equity will restrain another party from adopting and using one so similar that its use is likely to lead to confusion by purchasers exercising the ordinary degree of caution which purchasers are in the habit of exercising with respect to such goods. 1—165—1052.

A label bearing six distinct points of resemblance to a label used by another person in the same business whose goods had acquired a market reputation, is such an imitation of the latter label as should be enjoined, where it appears that at least two persons were deceived thereby, and where the defendant's sales have increased, without other cause being shown, since the adoption of the label by the defendant. 1—166—1061.

The Act of June 18, 1874, providing for the registration of labels in the Patent Office, did not intend to provide for such registration of a label which was in fact a trade-mark. Where a label which "bears such distinguishing marks as entitle it to registration as a trade-mark" is proposed for registration, the "function of the Commissioner" is not "merely ministerial," and he is at liberty to refuse such registration. 1—171—1082.

A manufacturer of labels may impress them with a uniform device to indicate them as of his manufacture, but the labels themselves cannot constitute his trade-mark. 2—176—1101.

See also, 1—11—62.

2—66—402.

2—12—70.

6—12—70.

2—161—1036.

7—52—323.

LACHES.

In England the rule is stringent in trade-mark cases, that lack of diligence in suing, deprives complainant in equity, of the right to an injunction or an account. Our Courts are more liberal in this respect. A long lapse of time will not deprive the owner of a trade-mark of an injunction against an infringer, but a reasonable diligence is required of a complainant in asserting his rights, if he would hold a wrong-doer to an account for profits and damages. This rule, however, applies only to those cases where there has been an acquiescence after a knowledge of the infringement is brought home to the complainant. 2—90—566.

Acquiescence by any person in the wrongful use of his name, will not estop him from asserting his rights in equity, unless he has notice during such acquiescence of the facts rendering the use of his name wrongful. 2—130—863.

Where the extensive use of a trade-mark by others, with the implied acquiescence of the owner, has contributed to give a reputation and create a demand for the article to which it has been applied, which it would not otherwise have acquired, equity should not by any stringent intervention assist the owner to secure these fruits. 2—150—963.

Laches of the plaintiff will not avail as a defence in a proceeding to restrain the use of a trade name where the defendant adopted the name with a fraudulent intent. 2—164—1052.

See also, 3—26—147.

4—156—989.

LICENSE.

The owner of a trade-mark which is affixed to articles manufactured at his establishment may, in selling the latter, lawfully transfer therewith to the purchaser the right to use the trade-mark. 1—42—258.

See also, 4—33—201.

3—91—572.

4—156—989.

1—130—862.

LOCAL TRADE-MARK.

The right of exclusively using the word Durham in labels on smoking tobacco, belongs to the manufacturers of the article in the town of Durham, North Carolina. 5—10—51-57.

A trade-mark may be appropriated by a manufacturing company as well as an individual, and pass with the property to their successors. 2—137—905.

MISREPRESENTATIONS.

Even if no actual fraud was intended, it does not help their case, a Court of Equity will assist no one in carrying on such a scheme as this. 2—2—7.

Where a person who claimed property in a trade-mark, had acquired it, if at all, by the use, in circulars, of fraudulent and deceptive and untrue language as to the origin and qualities of the article in respect of which the trade-mark was claimed. **HELD:**

That he had lost his right to claim the assistance of a Court of Equity to protect his trade-mark. 1—8—29.

Where the words in a label adopted as a trade-mark are substantially true, and contain nothing calculated to deceive the public; although not literally true, **HELD:** to be a distinction without a difference. 8—52—322.

If a person can have a trade-mark in the words "East Indian," in connection with the word "remedy," upon bottles of medicine, (which is at least doubtful), yet if he has falsely adopted and used these words to denote and to indicate to the public that the medicines were used in the East Indies, and that the formula for them was obtained there, he cannot maintain a bill in equity to restrain an infringement of such trade-mark. 1—54—347.

Words calculated to deceive the public as to the place of manufacture, should not be allowed registration. 5—68—416.

The use of a term by complainant in a manner calculated to mislead the public in reference to the components or nature of the article to which it is applied, will not be tolerated. 2—105—696.

A Court of Equity will extend no aid to sustain a claim to a trade-mark of an article which is put forth with a misrepresentation to the public as to the manufacturer of the article, and as to the place where it is manufactured, both being originally circumstances to guide the purchaser of the medicine. 1—118—787.

When it is the object of a trade-mark to indicate the origin of manufactured goods, and a person affixes to goods of his own manufacture a trade-mark which declares that they are goods of the manufacture of some other person, it is a fraud upon the public which no Court of Equity will countenance. 1—118—788.

The plaintiff claimed to be the owner of a patent medicine and of a trade-mark to distinguish it. The medicine was manufactured by the plaintiff in New York; the trade-mark declared that it was manufactured by another party in Massachusetts. **HELD:**

That he was entitled to no relief against a person using the same trade-mark in Maine. 3—118—793.

Where a trade-mark contains a material misleading representation, a Court of Equity will not protect it. 1—131—865.

There are however other distinctive features of the trade-marks, labels and circulars, which are not subject to the objection urged to the use of the word "Trommer," which the Court below protected by their decrees in this case. Some of these devices the plaintiffs in error wrongfully made use of, and in rendering judgment which the District Court should have rendered, we make our decree the same as that of

the Court below, except wherein it protects the defendants in error in the use of the word "Trommer." 2—131—866.

A Court of Equity will not interpose by injunction to protect a claim to a trade-mark or label, where either contains a misrepresentation. 1—132—874.

When a printer publishes a label intended to convey to the public the impression that it covers cigars of superior excellence, and sells such label to anybody to cover just such cigars as the manufacturer chooses to apply it to, the label is no guarantee of excellence, or even of any certain brand of cigars, and the publisher is chargeable with facilitating others in making false representations. 6—176—1104.

When the owner of a trade-mark applies for injunction to restrain another from injuring his property by making false representations to the public, it is essential that the plaintiff should not in his trade-mark, or in the business connected with it, be himself guilty of any false or misleading representations; for if the plaintiff makes any material false statement in connection with the property he seeks to protect, he loses his right to claim the assistance of a Court of equity. 7—176—1105.

See also, 2—2—7.

2—10—48.

4—79—484.

MONOPOLY.

The use of words (here, "patent roofing") merely designating the kind of business one is engaged in, cannot be protected as a trade-mark. 1—180—1126.

MOTIVE BAD.

If one, with a bad motive, exercises his rights in a lawful and proper way and injury results, there is damage without legal injury; but if with a bad motive he exercises his rights in an unlawful manner, there is both damage and legal injury. 9—117—771.

NAME.

A person may legally name himself, or change his name, or acquire a name by reputation, general usage and habit. 1—14—77—82.

NAME OF SYMBOL.

The use of arbitrary terms, such as "Tin Tag" or "Wood Tag," by a manufacturer to indicate goods produced or sold by him, might be allowed if the person so using the name or words branded them upon his goods, or in any way gave the goods the name; but that would give no right to the exclusive use of the tin or wood as a material to designate the goods. 3—179—1123—1124.

See also, 3—176—1102.

1—6—25.

NEW ARTICLE.

When a new article is made a name must be given to it, and this name becomes, by common acceptance, the appropriate descriptive term by which it is known and therefore becomes public property, so that all who have the right to manufacture and sell the preparation have the right to designate and sell it by the name by which alone it is known, provided care is observed to sell the preparation as the manufacture of the seller, and not the preparation made by another. 1—122—814.

When an article is made that was theretofore unknown, it must be christened with a name by which it can be recognized and dealt in; and the name thus given to it becomes public property, and all who deal in the article have the right to designate it by the name by which alone it is recognizable. 1—157—991.

NOM DE PLUME.

An author or writer has no better or higher right in a *nom de plume* or assumed name, than he has in his baptismal name. 1—114—736.

An author cannot acquire a right to the protection of his writings under an assumed name as a trade name or trade-mark, and no pseudonym, however ingenious, novel or quaint, can give one any more rights than he would have under his own name, or defeat the policy of the law that the publication of literary matter without protection by copyright has dedicated such matter to the public. Notice to quit, 3—90—566.

NUMERALS.

As to the use of the numbers "2," "101" and "32," the principles of *Gillott v. Esterbrook*, (48 N. Y., 375), apply. In that case, and this, the numbers were selected arbitrarily, and were used to distinguish one pattern or character of goods from another, and the plaintiff is entitled to protection in his use of the same. 4—32—191.

Letters or figures affixed to merchandise by a manufacturer, for the purpose of denoting its quality only, cannot be appropriated by him to his exclusive use as a trade-mark. 1—39—228.

An injunction will not be granted at his suit to restrain another manufacturer from using a label bearing no resemblance to the complainants, except that certain letters, which alone convey no meaning, are inserted in the centre of each, the dissimilarity of the labels being such that no one will be misled as to the true origin or ownership of the merchandise. 2—39—229.

In this case the labels do not contain the name of the plaintiffs as makers but the evidence satisfies me beyond a doubt that the figures "35" were known and recognized by dealers, when employed, on *carte de visite* mounts, as referring to the particular kind of card which was manufactured by the plaintiffs, HELD:

That the plaintiffs have a trade-mark in those figures and are entitled to be protected in a Court of Equity. 2—41—264.

Numerals, arbitrarily selected, and used on goods in combination with other devices to denote the origin of the goods, and not their quality, are a valid trade-mark, and a person who uses them in combination with other devices which he has a right to use, may be restrained by a bill in equity from so using them, if he does so for the purpose of imitating the trade-mark, and his use is calculated to deceive, and does deceive persons buying his goods. 1—69—418.

Where numerals constituted one of the most prominent features in plaintiff's design, and the same numerals were used in a similar design by defendants, such use, when adopted to designate the same kind of articles, is calculated to aid in deceiving the public, and is an infringement of plaintiff's trade-mark. 3—101—644.

The right to a trade-mark is a right depending on use; and where complainant had used certain numerals long enough to convey to any one versed in the nomenclature of the trade a precise understanding of what goods were intended, when such numerals were used alone, disconnected from any extrinsic information, its right to their exclusive use as a trade-mark must be upheld. 5—101—645.

An injunction will be granted to restrain the defendants from using the numerals appropriated by plaintiff, to designate the same kind of goods sold by the defendants and not made by the plaintiff, and from using on their labels a word printed in script, with a flourish underneath, in imitation of a word used by the plaintiff on its labels. 6—101—645.

See also, 1—109—714.

ORIGIN AND OWNERSHIP.

Any one may make anything in any form and may copy with exactness that which another has produced, without inflicting any legal injury, unless he attributes to that which he has made a false origin, by claiming it to be the manufacture of another person. 3—5—22.

The principle is well settled that a manufacturer may, by priority of appropriation of names, letters, marks or symbols of any kind to distinguish his manufacture, acquire a property therein as a trade-mark, but said mark must indicate the "true origin or ownership" of the goods to which the mark is applied. 1—33—197—202.

It is not essential to property in a trade-mark that it should indicate any particular person as the maker of the article to which it is attached; it may represent to the purchaser, the quality of the things offered for sale, and in that case is of value to any person interested in putting the commodity to which it is applied, upon the market, and he is entitled to protection in its use. 1—63—387.

HELD, that a trade-mark, to be valid, must indicate the *true origin or ownership* of the goods on which it is used, and that a mere device of a "drum," without more to identify it with its proprietor, does not

- confer on plaintiffs the exclusive right of appropriation, and the bill will be dismissed for want of equity; following *Davol Mills*, 7 *Phila.*, 253, and *Dixon v. Guggenheim*, 7 *Phila.*, 408. The doctrine of *Shepard v. Stewart*, 13 *Phila.*, 117, dissented from. 3—67—408.
- A trade-mark is not necessarily defective because it does not indicate the origin or ownership of the article. 6—79—485.
- A trade-mark, to be protected from infringement, must designate the origin or ownership of the article to which it is applied. A mere general description by words in common use of a kind of article, or its nature and qualities, cannot of itself become a trade-mark.
- “Snowflake,” as applied to bread or crackers, is a mere description of whiteness, lightness and purity.
- An arbitrary word, not descriptive of the character or quality of the article to be sold, may be used to designate particular goods, and become a trade-mark. 1—89—561—562.
- The difficulty is in distinguishing cases where the property has acquired a generic name as indicating the quality of the article rather than its origin and ownership.
- The only satisfactory rule we have been able to gather from the authorities is that each case is matter for the Court to determine, not alone from the mark itself, but from the testimony, whether the words have become so well known as to stand in the public eye as denoting the character and quality of the article and not its origin or ownership.
- Mere words may become valid trade-marks, when they are merely arbitrary or are indicative of origin or ownership in the original proprietor. 1—103—672—674.
- A trade-mark is a sign or symbol primarily confined exclusively to the indication of the origin or ownership of the goods to which it is attached, and it may be composed of any name, device, line, figure, mark, word, letter, numeral or combination or arrangement of any or all of these which will serve the sole purpose of a trade-mark, and which no other person can adopt or use with equal truth. 1—117—758.
- A trade-mark must either by itself or by association, point to the origin or ownership of the article to which it is applied. *Canal Co. v. Clark*, 13 *Wal.*, 311. It imports that the article is made by the original proprietor, not only as matter of justice, but to prevent imposition on the public. *Manhattan Medicine Co. v. Wood*, 108 *U. S.*, 218. 1—152—969.
- The name “Chatter-book,” printed upon the cover of the defendants’ books of the juvenile character of the general appearance of the complainants’ books, being in the opinion of the Court an imitation of the name “Chatter-box,” which by association, when used upon books of a juvenile character, points “distinctly to the origin or ownership” of the books to which it is applied, an injunction *pendente lite* is granted against its use. 1—182—1132.

See also, 2—103— 672.

1— 41— 264.

1—177—1111.

2— 5— 22.

2— 24— 129.

2— 23— 200.

OXIDE OF ZINC.

The right of A. to a trade-mark in connection with the dry, white oxide of zinc, is not infringed by the sale of a paint composed of a white oxide of zinc, ground in oil, and untruly represented as containing white oxide of zinc made by A., such trade-mark never having been applied by A. to that article ground in oil. 1—7—27.

PACKING CASE.

A "representation of a barrel consisting of light and dark wood, the staves being alternately composed of each color," cannot be registered as a trade-mark for flour packed in barrels similar to that represented in the picture, because in such application it is descriptive, not, indeed, of the quality of the flour itself separated from its package, and, therefore, not in marketable form, but of the marketable commodity, the barrel of flour. But when applied to sacks of flour, or to barrels of flour having staves all of one color, it is an arbitrary symbol, and is registrable as a trade-mark. 1—34—207.

See also, 3— 67— 408.

1—175—1096.

PARTIES TO ACTION.

A suit brought in the name of a corporation without designation of any officer, will stand when, on trial of the exception taken on that point, it is shown that the action was instituted by the President with the approval of the Board of Directors. 1—79—483.

The infringement of a trade-mark is a trespass upon the rights of the owner, by using it as a false representation that the wares of the infringer are those of the owner, for which an action of trespass on the case would lie at common law, in which all participating would be principals and proper defendants. 1—147—950.

PARTNERSHIP.

Where a trade-mark adopted and applied to an article by a firm is continued to be applied unopposed, to the same article after dissolution, by the remaining partner, the title thereto belongs to the latter against a former partner, who subsequently applies the mark to an article similar in appearance, but different in quality. 1—19—108.

- Proof having been adduced on this point in an interference proceeding and not considered, a rehearing granted for that purpose. 2—19—108.
- The exclusive right to use the trade-mark of a firm does not pass to any member of the firm by mere implication; but such member may use it, provided he do so in a manner not to deceive the public. 1—27—150.
- Upon the dissolution of a copartnership terminable at the pleasure of either partner, neither is entitled to the exclusive use or to the registration of its trade-mark, unless by virtue of special stipulations. 1—29—169.
- Under a partnership agreement which provides that a firm may be dissolved at the pleasure of either partner, and that one of the partners shall retain his exclusive knowledge of the formula for the manufacture of the article sold by the firm, neither partner is entitled, upon a dissolution, to the exclusive use of a trade-mark adopted and used by the firm. 2—29—169.
- While such an agreement does secure to the possessor of the formula, the secret which was his own property and not the property of the firm, it does not confer upon him the trade-mark, which was the property of the firm, and not his own. 3—29—169.
- In such case, neither party can, after the dissolution of the firm, separately register its trade-mark. 5—29—170.
- The fact that an illegal registration has been granted to one of the copartners, will not justify a grant of a second illegal registration to the other. 6—29—170.
- A partnership which is suffered by any one to use his name as a part of the firm style and title, though it may acquire by such license an exclusive right to the use of the name so long as the partnership continues intact, cannot, upon its dissolution, confer the same privilege upon its successor. 1—130—862.
- A junior partner retiring from a firm is held to have retained no interest in a trade-mark used by the firm and originated by its senior member, particularly when the weight of evidence indicates that he released all right to their brands. 1—156—987.
- See also, 4—10—51.
1—57—359.

PATENT.

- A person has no right to mark his goods with any words or terms indicating that they are manufactured under a patent which he does not own and has no right to use. 1—43—271.
- A defendant, having so marked his goods, will not be allowed to defend himself by denying the validity of such patent. 2—43—272.
- An injunction will be issued to restrain a false and fraudulent libel upon the title of the complainant's patent. 3—43—272.
- In the United States, trade-marks may be patented, and when the word *patented* is put on the label of the article sold, though the merchandise

itself is not patented but the word is used in reference to the trade-mark and not for the purpose of deceiving the public, the owner of the trade-mark will not be disentitled. 4—79—484.

A trade-mark used to designate goods manufactured under letters-patent, is assignable with the letters-patent, and the right to damages accrued for infringement is also assignable. 2—91—574—575.

See also, 1—35—211.

PRELIMINARY INJUNCTION.

In trade-mark cases, it is by no means of course to grant preliminary injunctions even where the plaintiffs' case seems to be made out. 5—5—24.

On appeal from an interlocutory order granting an injunction, the Court in determining whether the order shall be affirmed or reversed, is confined to the case made by the bill and exhibits, without reference to the averments of the answer which appears in the record. 1—28—158.

Where affidavits have been prepared and printed without seeing the witnesses, and sent over the country to be signed by those who might be found willing to do so, the statements therein are not regarded with confidence by the Court. 4—56—356.

While, where a complaint shows no cause of action, the granting of a preliminary injunction is an error in law, which may be reviewed in this Court on appeal, the case must be very clear to justify the Court in deciding the merits of the controversy on a mere motion; and where a doubtful question of law arises on the complaint, the decision thereof should be deferred until a hearing of the case upon its merits. 1—124—829.

Where it is very doubtful whether the name claimed as a trade-mark does not describe the articles themselves and the kind of them, and indicate that they are made according to the patent known by the name claimed rather than that the patentee made them, a preliminary injunction should not be granted. 1—142—930.

When delay of the owner of a trade-mark to prosecute infringers has been of a tendency to mislead the public, or the defendant sought to be enjoined, into a false security, and a sudden injunction would result injuriously, it ought not to be granted summarily, but the complainant should be left to his relief at final hearing. 1—150—963.

A complainant who has refused to recognize the rights of the original foreign proprietor of a trade-mark until he thought it would be more profitable to purchase his rights in this country, and thus obtain a monopoly, reserving the right to annul the contract at his discretion, will not be entitled to a preliminary injunction against alleged infringers of the trade-mark, but be left to his rights at final hearing. 3—150—963.

Preliminary injunction restraining the use of plaintiff's trade-mark will not be dissolved. Where plaintiff's legal title is clear and the infringement is manifest. 2—154—981.

Preliminary injunction denied where affidavits of defendants make it doubtful whether the plaintiff has so had exclusive use of symbols sought to be restrained, as to make their use by defendants likely to pass their wares as his. 1—178—1115.

A preliminary injunction should be granted to protect the use of the word "Eureka," used by plaintiff to designate a kind of steam-packing made by him, upon a showing that the plaintiff had used the name since 1875, although another firm used it to a limited extent for another kind of packing from 1872 to 1874, especially when plaintiff has had two decrees establishing his right to the name as a trade-mark in the locality where the former use thereof occurred. 1—181—1130.

See also, 1—71—431.

PRINCIPLE OF LAW.

The ground upon which actions for the infringement of a trade-mark are maintained is, that the law will not allow one person to sell his own goods as and for the goods of another. 3—82—505.

PROFITS.

In such an action, plaintiff may without accounting for any misjoinder, ask as to profits and for damages. 2—71—432.

See also, 1—90—565.

1—167—1063.

4—117—760.

2—181—1130.

PROPER NAME.

A person has a right to use his own name as a trade-mark to designate an article which he produces and sells, although another person of the same name, has previously produced and sold the like article with the same designation, and has made the use of the designation valuable. 2—14—78—84.

Where, however, the later use of the designation in such a case is made for the purpose of *leading* the public to believe that the articles so designated are those of the prior user of the designation, and thus depriving such prior user of his gains, the Court will restrain such dishonest use. 3—14—78.

The test is, whether he used the name honestly and fairly in the ordinary prosecution of his business, or dishonestly to palm off his own commodity as the production of another. 3—14—79.

Any proper word or phrase, whether the name of a person, firm or corporation, or a geographical term; may be registered as a trade-mark unless the same is descriptive of the quality of the goods, or is the name of the applicant or manufacturer, or place of manufacture, or is deceptive. 2—37—217.

- A man who voluntarily parts with the right to use his own name as a trade-mark, cannot voluntarily recall it by marrying or carrying on business in his wife's name; nor can she, by marrying him, acquire any higher right to use his name as a trade-mark than he himself had. 3—77—466.
- A trade-mark which consists of the name of a third person, is not such a species of property as can be disconnected from the business with which such person was formerly connected, and sold from man to man. 4—77—467-471-473.
- The proper name of the manufacturer of an article, cannot be made a trade-mark so as to prevent any other manufacturer of the same name from affixing such name to a similar article made and sold by him; where no unfair means are used to mislead purchasers into a belief that such article is manufactured by the person who first sold and continues to sell a like article under that name. 5—82—510.
- The Act of March 3, 1881, does not define what shall constitute a legal trade-mark, but it does declare what shall be registered as such, among its prohibitions is "merely the name of an applicant." 1—84—539.
- “Merely the name of an applicant,” held to mean the name of the applicant, separate and alone. 2—84—539.
- The mere name of a person does not form a proper subject for a trade-mark registration, although it appears that such name, by long association with a certain line of goods, has come to be applied as a name or title to such goods. 3—84—540.
- HELD, that the prohibition of the statute was intended to prevent any person from using his name in any trade as a trade-mark, to the exclusion of other persons of the same name in the same or other avenues of trade. 4—84—540.
- The long use of the name of a particular person with a particular class of goods manufactured by that person, or in his name, serves to identify those goods as particularly as any other characters, device or collection of words. 2—87—556.
- The name of a person in connection with other marks, may form proper subject-matter for trade-mark registration by the business successors of such person. 3—87—556.
- It is the opinion of the ablest jurists, that a person's name cannot be an essential element of his trade-mark, and such is the settled practice of the Patent Office. 1—92—579.
- It is deducible both from the Act of 1870, and from the present law, that others may use with impunity the name of the registrant, either by itself or in connection with other arbitrary symbols than those secured by the registration, but that the symbol itself cannot be used by others in any connection. This distinction may be expressed by the words “material” and “immaterial,” or “essential” and “non-essential,” according to the phraseology preferred. 2—92—579.

The name of the person, firm or corporation, does not acquire an arbitrary significance by association with an otherwise valid trade-mark, and cannot therefore be included as an essential feature of such trade-mark. 3—92—580.

Any one has a right to the use of his own name in business, but he may be restrained from its use if he uses it in such a way as to appropriate the good-will of a business already established by others of that name, nor can he, by the use of his name, appropriate the reputation of another by fraud, either actual or constructive. 2—99—626.

Any one who rightfully uses a name of established reputation as part of a trade-mark in a particular business may enjoy its interfering use by others. 3—99—627.

The sale by a person engaged in manufacturing certain goods, of the right to use his name as a trade-mark, will be valid provided the trade-mark is not used to deceive the public, and a sale of the right to use such trade-mark by the vendee to another person, will not be affected by any contract between the original parties of which the second vendee had no notice. 1—123—818.

While a party cannot be enjoined from honestly using his own name in advertising his goods and putting them on the market, where another person, bearing the same surname, has previously used the name in connection with his goods in such manner and for such length of time as to make it a guaranty that the goods bearing the name emanate from him, he will be protected against the use of that name, even by a person bearing the same name in such form as to constitute a false representation of the origin of the goods, and thereby inducing purchasers to believe that they are purchasing the goods of such other person. 1—146—944.

Where, in a suit by persons using "Rogers & Bro. A 1," as a trade-mark, to restrain the use of "C. Rogers & Bros. A 1," by others, the *finding* of the Court below was that the word "Rogers" is the only misleading character, and that the manner of using the marks is that employed in the trade generally, the Appellate Court, being controlled as to the facts, by the findings, cannot say, as matter of law, that the use of the mark sought to be enjoined is misleading. 1—160—1008.

The fair and honest use of one's own name, in the ordinary course of business, in the manner in which other manufacturers of similar goods are accustomed to use their names, in the preparation for sale, or sale of goods, cannot be enjoined; although a possibility may exist that the goods of one will be purchased to some extent by persons who knew no distinction, or even supposed them to be the goods of another. 2—160—1008.

See also, 1—37—217.

PROPERTY IN TRADE-MARK.

The language of Lord Justice Gifford, in *Lee v. Haly*, (39 *Law Journal*, 380), approved: "the principle upon which the cases go, is not that

there is a property in the word, but that it is a *fraud* upon a person who has established a trade," &c., &c. 3—24—131.

An author has the right to restrain the publication of any of his literary work which he has never published or dedicated to the public. 3—114—736.

See also, 2—53—329.

PUBLICATION.

A publisher or author has either in the title of his work, or in the application of his name to the work, or in the particular marks which designate it, a species of property similar to that which a trader has in his trade-mark, and may, like a trader, claim the protection of a Court of Equity against such a use or imitation of the name, marks, or designation, as is likely in the opinion of the Court, to be a cause of damage to him in respect of that property. This doctrine, in cases where the facts are sufficient to sustain it, has been held applicable to such periodical publications as newspapers, magazines and almanacs. To entitle a complainant to relief, he must clearly show a property right in himself, and a fraudulent or colorable imitation by the defendant. 2—28—158.

One may publish the fact of the pendency of proceedings in Court, if no reference is made to any discussion of the question involved or to anything tending in any way to anticipate or hinder the administration of justice at the hearing, and an injunction restraining such publication of legal proceedings, may be modified so as to permit the publication within this limit. 2—169—1074.

QUALITY.

Anything descriptive of the properties, style or quality of an article merely, is open to all. 3—126—844.

Letters or figures which, by the custom of traders or the declaration of the manufacturers, are used only to denote quality or grade, are incapable of exclusive appropriation as trade-marks.

Plaintiff manufactured three grades of flavoring extracts; to designate the best grade the firm, to whose business plaintiff succeeded, adopted the word "Royal," the use of which was continued by plaintiff. Prior to such use defendants' predecessors manufactured mustard, to designate which they used the words "Royal Standard." Defendants continued the manufacture and the use of the words. They also began the manufacture of flavoring extracts which they designated as "Royal" Standard" extracts. In an action to restrain such use of the word "Royal." 1—128—850.

HELD, that plaintiffs were not entitled to the exclusive use thereof as it denoted quality or grade. and that a refusal to dismiss the complaint was error. 2—128—852.

Where marks—such as arbitrary combinations of figures—indicating style or quality also indicate origin, they may be a subject of trade-mark and their use as such protected. 1—177—1111.

See also, 1—39—228.

REGISTRATION.

The name of a patented article which was a valid common law trade-mark in 1870, cannot be registered for a period to extend beyond the expiration of the patent in favor of an applicant who is not the owner of the trade-mark or the patent. 1—35—211.

The trade-mark statute (Rev. Stat., secs. 4937, 4938,) did not constitute a contract binding the government to protect a party in the exclusive use of his trade-mark. 1—46—286.

Where a person paid the prescribed fee for the registration of his trade-mark, he cannot recover it back on the statute relating to trade-marks being pronounced unconstitutional. 2—46—287.

It is the duty of the Commissioner of Patents to refuse to register alleged trade-marks which, under the decisions of the Courts, are clearly not valid. 2—125—839.

The Office, has no right, by accepting and registering words or symbols which are clearly not valid trade-marks, to mislead applicants or the public. 3—125—839.

No applicant may register a trade-mark unless he can establish, first, that he has the right to use it, and no one else has; second, that it is not identical with the registered or known trade-mark of another person, and beyond this he must show that he is using the trade-mark which he so owns, in commerce with foreign nations or Indian tribes. 1—138—911-912.

Registration of a trade-mark is only *prima facie* evidence of ownership, and the validity of the title so evidenced is always open to judicial inquiry. 4—149—961.

RES ADJUDICATA.

Former Decree in England. A decree rendered by the Master of the Rolls in England, refusing an injunction and dismissing a bill in equity to restrain the infringement of an alleged trade-mark, and which was not appealed from, is a complete bar to a suit brought in this country for the same purpose by the same complainants, against the agent of the defendant in the English suit. 2—22—119.

The decision of the Examiner of Interferences, not appealed from, in such an interference is conclusive upon the parties and their privies, and cannot be questioned in any other tribunal. 3—44—277.

RESEMBLANCE.

It is impossible to lay down any general rule as to what degree of resemblance between the symbols, marks and devices used on one

publication and those on another, is necessary to constitute a fraudulent or colorable imitation. All that can be done is to ascertain in every case as it occurs, whether there is such a resemblance as that ordinary purchasers, purchasing with ordinary caution, are likely to be misled. 3—28—159.

If the resemblance is such as not only to plainly suggest an intention to deceive, but is calculated to mislead the public, who are purchasers of the article, and thus to injure the sale of the goods of the proprietor of the original device, the injured party is entitled to redress. 5—109—715.

Two trade-marks are substantially the same in legal contemplation, if the resemblance is such as to deceive an ordinary purchaser, giving such attention to the same as such a purchase usually gives, and to cause him to purchase the one supposing it to be the other. 2—136—900.

To entitle to relief, it is not necessary that the imitation should be so close as to deceive persons seeing the two marks side by side. It is sufficient if there is such a degree of resemblance as would deceive ordinary purchasers using ordinary caution. 2—149—960.

There must be a general resemblance, similarity of form, color, design, identity and arrangement of words, so as to mislead persons who exercise ordinary caution in purchasing articles on which such label is placed. 1—168—1067.

See also, 1—62—378.

1—21—117.

3—65—398.

3—136—901.

4—101—645.

RETAIL DEALER.

The seller is as much entitled to protection in his trade-mark when his goods are manufactured by others under his orders and directions, as when he is himself the manufacturer. 7—79—486.

The use of a trade-mark for flour by one who selects and sells flours manufactured by others is a valid use. 3—156—988.

See also, 1—24—128.

RISING SUN.

Plaintiff's trade-mark was "The Rising Sun" Stove Polish, with vignette of the sun.

Held, on motion for preliminary injunction, that defendants would not be restrained from using the words "Rising Moon," with vignette of the moon. 1—3—14.

ROYAL.

Plaintiffs by adoption and use of the term "Royal," connected with "Baking Powder," have acquired a right of property in the use of said word "Royal" as a trade-mark. 1—15—88.

That defendants commenced the manufacture and vending of a leavening compound, to which they gave the name of "Royal Dry Hop Yeast," for the purpose of leavening bread, cake, or for other culinary purposes, and put up in boxes, cans and other packages, with the term aforesaid displayed thereon. **Held:**

That the use of the word "Royal" by defendants, was and is a violation and infringement of the rights of complainants to the use of the word "Royal" in connection with leavening compounds. 2—15—88.

SAMARITAN.

The appropriation as a trade-mark of the word "Samaritan" in one combination of words, does not prevent its being used as a trade-mark in any other combination. 2—119—798.

SECRET.

A defendant to a bill to enjoin the use of a trade-mark, cannot by alleging injurious qualities in the plaintiff's goods, compel him to disclose the ingredients of which they are composed. 1—94—592.

SERVICE.

3—120—808.

SINGER SEWING MACHINE.

While any one, not connected with the Singer Manufacturing Company, has the right to construct a "Singer Sewing Machine," yet he cannot be permitted to do any act, the necessary effect of which, will make people believe that the machine he constructs and sells, is manufactured by the Singer Manufacturing Company. 3—13—75.

There can be no trade-mark in the name "Singer Sewing Machine." 2—13—74.

See also, 4—13—75.

STATE LAW.

The rights and remedies concerning trade-marks generally depend upon the laws of the States, common or statutory, and not upon the laws of the United States. 1—140—919.

The fact that a label has been registered as a trade-mark under the United States Act of March 3, 1881, does not abridge the powers of the State Courts at common law to determine whether or not the matter on such label can be considered a trade-mark. 1—176—1101.

SUCCESSORS IN BUSINESS.

As the right to use the words "Established 1780," or "Established A. D. 1780," when the partnership between the plaintiffs and the defend-

ant ended, belonged to the business, it passed to the successors of the firm. 3—17—101.

If the successor to the business of the manufacturer of one compound or of one article, has a right to the continued and sole use of the name or mark by which the public recognizes its genuineness, so the successors in the business to those who placed upon the market many compounds, all marked and designated by certain well-known words, are entitled to the continued and sole use of such words which distinguished the preparations. And what is true in regard to articles manufactured by predecessors in business and continued by successors, is also true in regard to new compounds. 4—17—98.

Where one partner retires from a firm, and the other members of the firm, with the consent of the retiring member, continue the business under the old firm-name, as they may do under the statute (*Laws of 1854, chapter 400*), they will be held to have succeeded to the business of the old firm. 2—17—99-100.

See also, 3—87—556.

SUGGESTIVE NAMES.

If the descriptive character that might attach to a word is so very remote as to be but secondary, so that the word will be understood by the public not as a descriptive but as a fanciful term, it may then constitute a valid trade-mark. 3—58—363.

The words "anti-washboard," as applied to a manufacture of soap, are suggestive rather than descriptive, and may be lawfully claimed as a trade-mark. 1—163—1046.

TEMPORARY USE.

A casual and fortuitous use of the trade-mark by another for a short time will not impair the right of one who subsequently adopted it and gave it celebrity. 2—156—988.

See also, 1—181—1130.

TITLE.

If an equivalent trade-mark, without any knowledge of the first, be originated and devised by another person during a period of disuse, that other person may thereby acquire a right of exclusive use in the second trade-mark. 8—10—51-52.

The exclusive right to a trade-mark is acquired by its use, which the law does not require shall be continued for any prescribed length of time. 2—65—397-398.

Nor is it essential that the party shall first establish a legal right to the trade-mark, in an action at law. 6—73—443.

A defendant who has no title may take advantage of a defect of title on the part of the plaintiff. 3—162—1047.

See also, 2—162—1047.

2—133—880.

3—41—264.

1—170—1076.

TIN PAIL.

The exclusive use of a tin pail with a bail or handle to it, the tin ornamented with a geometrical pattern, and used to contain paper collars for sale, and sold with the collars, cannot be claimed as a trade-mark, either under the statute or by virtue of the general law of trade-marks. 1—6—25.

TRADE-MARK.

- A trade-mark is always something indicative of ownership, by adoption and repute, and is something different from the article itself, which the mark designates. 2—5—22.
- A trade-mark may consist of anything not already appropriated; marks, forms, symbols, which designate the true origin or ownership of the article; this, although the words adopted are in common use. It cannot however, consist of anything which merely denotes the name or quality. There can be no right to the use of mere generic words. 2—24—129.
- In cases involving the question of *trade-mark*, the evidence must show the first appropriation of the device by the claimant; its application by him to his goods or business; and that the trade or public recognize the article or business by that device as made or sold by him or belonging to him. In no other way can a mark or *device* indicate "*true origin or ownership*." 2—33—200.
- A manufacturer has the right to distinguish the goods manufactured by him by any peculiar mark or device he may select and adopt by which they may be known as his in the market, and he is entitled to protection in a Court of Equity in the exclusive use of the peculiar mark or symbol appropriated by him designating or indicating the true origin or ownership of the article to which they are affixed. 1—41—264.
- The present Act excludes from registration prospective trade-marks and those not used in foreign commerce or commerce with the Indian tribes; but there has been no such essential change in the law as to warrant the Office in registering as a trade-mark, matter which the Courts would not regard as such. 2—80—490.
- A trade-mark is an arbitrary character or characters without special meaning, adopted by persons, firms or corporations, for the purpose of identifying the goods manufactured by them or of which they have the sale. Persons have the right to adopt any device or form of words possessing these characteristics as their trade-marks, so long as public property is not violated. 1—87—555.
- Any words selected arbitrarily, not expressive of the quality or character of the article, and not previously appropriated by any other person

to designate a similar commodity, may be used as a trade-mark for such article. 1—88—559.

Where there is a simulation of trade-mark, and the intent becomes a subject of inquiry, the form, color and general appearance of the package may be material; but the party cannot appropriate an ordinary and usual form of package and fashion of label, and exclude all others from its use, or from the use of anything resembling it; to sustain an action restraining such use there must be an imitation of something that can legally be appropriated as a trade-mark. 1—100—635.

The mere idea represented by some figure, on an article sold for polishing purposes, that it will make things bright enough to be used as mirrors, cannot be appropriated as a trade-mark. 2—100—635.

An action cannot be maintained to restrain a defendant from selling his own goods in packages and with labels, he has a legal right to use, and which did not infringe upon any trade-mark of the plaintiff. 3—100—635.

A trade-mark is a mark by which the wares of the owner are known in trade; its objects being—*First*, to protect the party using it from competition with inferior manufacturers; and, *second*, to protect the public from imposition. 1—101—642.

The trade-mark may consist of a token, letter, sign, or seal. Names, ciphers, monograms, pictures, and figures may be used, and numerals united. 2—101—643.

A registration of a trade-mark effected under the law of 1874, is evidence of the fact that the persons named therein at that time claimed the right, and were allowed to register the trade-mark, and depended for its legal effect upon the provisions of the law under which it was effected. 1—112—729.

When introduced in evidence in a contested case to support an applicant's right to a registration under the new law, it should be accompanied with evidence identifying the applicant as the person therein named, and showing that the right has been maintained by the continued use of the trade-mark, and that it has not in the meantime passed by assignment or by changes in the composition of the firm to other persons. 1—112—730.

Terms which designate merely the name, quality, kind, size, number or elements of an article, or have become its proper appellation, or that merely describe it or direct the mode of its use, or purely generic or geographical terms, and the necessary and common uses in which the English language and Arabic numerals are employed by the people to express the truth, their ideas and feelings, are common property which all may use but which none can appropriate exclusively to himself as a trade-mark. 2—117—759.

A trade-mark consists of a word, mark or device adopted by a manufacturer or vendor to distinguish his production from other productions of the same article. 2—122—814.

The right to the exclusive use of a word or symbol as a trade-mark, is inseparable from the right to make and sell the commodity which it has been appropriated to designate. 1—137—905.

The owner of a spring of mineral water in Hungary, entered into a contract with complainant giving him the exclusive right to export and sell the water under its name of "Hunyadi Janos," which he adopted as a trade-mark in Great Britain and America. Defendant applied to the owner to purchase the bottled water but was refused, and purchased it from those to whom it had been sold in Germany, and sold it in the United States in bottles with the same label as that used by complainant, except that defendant's bottles, like all those sold by the owner, were stamped with the words "Caution. This bottle is not intended for export, and if exported for sale in * * * America, * * * the public is cautioned against purchasing it;" while complainant's bottles were stamped "Sole Exporters." HELD:

That complainant was not entitled to an injunction to restrain defendant from selling the water. 1—170—1076.

A peculiar method of arranging soap in a box is not a trade-mark which can be legally registered. 2—174—1094.

The office of a trade-mark is to authenticate the article on which it is borne as the product of the owner of the trade-mark, and is a representative or substitute for the owner's signature. 3—176—1102.

Labels sold to cigar manufacturers and used upon their merchandise become the brand or pretended trade-mark of the cigar manufacturer, and not of the lithographer. It is impossible that the same label can be the trade-mark of both. 4—176—1102.

By the use which a merchant makes of a label in applying it to a package containing the product of his manufacture it may become for him a trade-mark, for it may be a distinctive mark, without being the object of his commerce; but as to the printer of such label, it can be nothing but the special object of his industry. 5—176—1103.

See also, 1—153—970.

1—121—810.

1—57—359.

1—141—921.

2—155—985.

2—37—217.

1—117—758.

1—33—197.

UNPATENTED ARTICLE.

Where no patent is held by the owner of plows, any one may make plows in exact similitude, may brand the name of the manufacturer and the place of manufacture on such part of the plow as he pleases, taking care so to use the brand as not to deceive the public into the belief that the plow is the manufacture of another. 5—117—760.

U. S. TRADE-MARK LAW.

A trade-mark is neither an invention, a discovery, nor a writing, within the meaning of the eighth clause of the eighth section of the first Article of the Constitution, which confers on Congress power to secure for limited times to authors and inventors the exclusive right to their respective writings and discoveries. 2—40—248-254.

If an Act of Congress can in any case be extended, as a regulation of commerce, to trade-marks, it must be limited to their use in "commerce with foreign nations, and among the several States, and with the Indian tribes." 3—40—248-256.

The legislation of Congress in regard to trade-marks is not, in its terms or essential character, a regulation thus limited, but in its language embraces, and was intended to embrace, all commerce, including that between citizens of the same State. 4—40—249-258.

That legislation is void for want of constitutional authority, inasmuch as it is so framed that its provisions are applicable to all commerce, and cannot be confined to that which is subject to the control of Congress. 5—40—258.

USER.

Every manufacturer, and *every person for whom goods are manufactured*, has a right to distinguish the goods he manufactures *or sells*, by a peculiar mark or device, that they may be known as his in the market, and he is entitled to protection of the same, irrespective of the fact that similar goods are manufactured or sold by others. (See cases cited in opinion.)

HELD *also, by the Court below*, that this right extends to a vendor who merely sells, and has no direct relation to the manufacturers. 1—24—128.

The right to use a trade-mark is one which depends on use. 1—99—624. A trade-mark becomes the exclusive property of one only when he has, prior to any one else, appropriated and used it to indicate the origin, ownership and quality of an article to which it is attached. Its value rests on reputation and on its implied guaranty that the article is of a certain quality. The object is to prevent one person from selling his goods as those of another of established reputation to the injury of that other. 3—117—759.

See also, 5—35—211.

UTILITY.

One of the principles running through the law of trade-marks, is that there need be no utility attached to the trade-mark itself; that is, it shall have no useful purpose in connection with the goods further than to show the origin or manufacture. 1—16—92.

YANKEE SOAP.

The term "Yankee," applied as the name or label upon soap. HELD: To be a valid trade-mark. 2—30—175.

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